TRANSCRIPT OF RECORD.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1913.

No. 184.

THADDEUS DAVIDS COMPANY, PETITIONER,

vs.

CORTLANDT I. DAVIDS AND WALTER I. DAVIDS, TRADING AS DAVIDS MANUFACTURING COMPANY.

ON WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

PETITION FOR CERTIORARI FILED FEBRUARY 6, 1913.
CERTIORARI AND RETURN FILED MARCH 14, 1913.

(23,045)

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a United States Circuit Court of Appeals for the Second Circuit.

THE THADDEUS DAVIDS COMPANY, Complainant-Appellee,
vs.
CORTLANDT I. DAVIDS and WALTER I. DAVIDS, Trading as Davids Manufacturing Company, Defendants-Appellants.

TRANSCRIPT OF RECORD.

Appeal from the Circuit Court of the United States for the Southern District of New York.

Printed under the direction of the Clerk.

1 United States Circuit Court, Southern District of New York.
In Equity.

THADDEUS DAVIDS COMPANY
vs.
CORTLAND I. DAVIDS and WALTER I. DAVIDS, Trading as The Davids Manufacturing Co.

Amended Bill of Complaint.

To the Honorable the Judges of the Circuit Court of the United States in and for the Southern District of New York:

The Thaddeus Davids Company, a corporation duly organized under the laws of the State of New York, and having its principal place of business at 127 William street, in the City of New York, in said District, brings this its amended bill of complaint pursuant to an order of this Court entered March 13th, 1908, against Cortland I. Davids and Walter I. Davids, citizens of the State of New York, and doing business at 203 Front street, in the City of New York, under the name of The Davids Manufacturing Company, an dthereupon your orator complains and says:

1. That your orator is the owner of a trade-mark used in commerce among the several States of the United States of America, and is domiciled within the territory of the United States, and was such owner and was so domiciled on or before the tenth day of July, 1906, and has been such owner continuously since said date, and also been continually so domiciled, and that your orator is a manufacturer of inks, mucilage, paste, and similar articles,
2 and has been so engaged together with its predecessors in business, in the City of New York continuously ever since 1825, and all of the inks, mucilage, paste and similar articles manufactured and sold by your orator and its predecessors have borne said trademark upon a suitable label on the bottles containing the same and have been sold under said trademark and said trademark has

been used continuously by your orator and its predecessors in commerce among the several states for over eighty years now last past, and that said articles have acquired the highest reputation in the market for goods of this description, namely, inks, mucilage and paste, and said goods have become and now are very popular and well-known throughout the United States as "Davids' Inks," "Davids' Mucilage" and "Davids' Paste."

2. That so being the owner of said trademark on the tenth day of July, 1906, your orator filed in the Patent Office of the United States on said date an application for registration for such trademark; said application being in writing, addressed to the Commissioner of Patents, signed by the applicant, specifying its name, domicile, location, and citizenship; the class of merchandise and the particular description of goods comprised in such class to which said trademark was appropriated; a description of the trademark itself, and a statement of the mode in which the same was applied and affixed to goods, and the length of time during which the said trademark had been used. With this statement was filed a drawing of the trademark, signed by the applicant, or its attorney, and such number of specimens of the trademark, as actually used, as were required by the Commissioner of Patents. And your orator paid into the Treasury of the United States the sum of ten dollars and otherwise complied with the requirements of the act of Congress entitled "An Act to authorize the registration of trademarks used in commerce with foreign nations or among the several states, or with Indian tribes, and to protect the same," which act was approved February 20, 1905. Said application was accompanied by a written
3 declaration verified by an officer of the corporation applying to the effect that the applicant believed the corporation in whose behalf he made the application to be owner of the trademark sought to be registered, and that no other person, firm, corporation or association to the best of the applicant's knowledge and belief had the right to such use either in the identical form or in such near resemblance thereto as might be calculated to deceive; that such trademark was used in commerce among the several states and that the description and drawing presented truly represented the trademark sought to be registered; which said declaration was strictly in accordance with Section 2 of said act, and duly verified before a proper officer as provided in said section.

3. That thereupon said application being duly filed as aforesaid in the United States Patent Office in accordance with the law, due proceedings were thereupon ha daccording to law and it appearing upon the examination of said application in said Patent Office that said applicant, to wit, your orator, was entitled to have its trademark registered under the provisions of the above mentioned act, due publication thereof took place and no notice of opposition being filed thereto, registration of said trademark was duly granted according to law and a certificate of registration was thereafter, to wit, on the 22nd day of January, 1907, issued to your orator which certificate was numbered 59,898, pursuant to Section 11 of the aforementioned act; which said certificate of registration is still in force, and of which

your orator then was and now is the sole and exclusive owner, as by said original certificate of registration or a duly authenticated copy thereof here in Court to be produced will more fully and at large appear.

4. That the trademark so registered as above set forth was originally adopted by your orator's predecessors in business, being then the owner of the mark, to wit, about the year 1825, as a mark by which the goods of the said owner may be distinguished from
4 other goods of the same class, and said mark has been continuously used for said purpose by your orator and its predecessors in business since said date and is still so used, and as a matter of fact said mark has distinguished the goods made by your orator and its predecessors as owners of the mark from other goods of the same class, and said mark was in actual and exclusive use a trademark of the applicant or its predecessors from whom it derived title for ten years next preceding the passage of the above mentioned act of Congress, approved February 20 1905; all as provided in Section 5 of said act, and your orator is advised and believes that by reason of the fact that said trademark has been in actual and exclusive use as trademark of your orator as applicant or your orator's predecessors from whom your orators derived title for more than ten years next preceding the passage of said act, said trademark was distinctly and in terms declared by said act to be entitled to registration as a good and valid trademark in the United States Patent Office, and that the registration above mentioned was and is a valid registration and is entitled to the protection of this Court irrespective of the particular character of said mark.

5. Your orator is advised and believes and therefore shows to your Honors that it was the intent of Congress in passing said act and was the legal effect of said act as passed to regard all trademarks, irrespective of their particular character, which had actually been used exclusively by their owner for ten years or more before the passage of said act, by which the goods of said owner were in fact distinguished from other goods of the same class as vested rights which said act should not in any way take away or diminish but which said rights should, when used in interstate commerce, be endowed with all the rights of registration and protection which was afforded to any lawful trademark under said act. All of which appears by Section 1 and Section 2 of said act, and especially the fourth proviso of Clause *b* of Section 5. Your orator therefore claims the protection of this honorable Court for its said registered
5 trademark No. 59,898, dated January 22, 1907, as a vested right of over ten years standing at the date of said Act of Congress; registration of which was in terms provided for in said act.

6. That the way in which said trademark was applied to the goods of your orator and its predecessors in business was placing the same in prominent letters on the label which was pasted on the bottles containing the goods. In doing so, the word Davids' was placed at or near the top of the label and the word or words indicating the special character of the goods was placed at about the middle of the label, and the name of your orator's company, to wit, Thad-

deus Davids Company, New York, was placed at or near the bottom of the label. The other words, figures or characters were so arranged that the word Davids', the name of the article, such as Blue Ink, Carmine Ink, Scarlet Ink, Green Ink, Writing and Copying Ink, and so forth, appeared as the most prominent part of the label, so that at a distance at which the smaller type could not be read the mark stood out as, for example, Davids' Blue Ink, Thaddeus Davids Company. All of which will more fully and at large appear from the labels themselves here in Court to be produced.

7. That said trademark and the right to the exclusive use thereof is of great value to your orator, and any infringement thereof or any use of a mark so closely resembling the same as to mislead the public into believing that they are procuring your orator's goods when they are not your orator's goods is likely to cause irreparable injury to your orator, and to deprive your orator of the just reward and fruits of its well learned reputation for inks, mucilage and paste, by reason of the fact that your orator's goods have become well and very extensively known by the short designation of Davids' Ink, Davids' Mucilage, and Davids' Paste.

8. That your orator and its predecessors have made and sold under said registered trademark, and are now making and
6 selling thereunder quite a large variety of inks, mucilage and paste, such as several kinds of black ink, blue ink, green ink, carmine ink, scarlet ink, copying ink and record ink, writing fluids, stylographic pen ink, lettering ink, and several kinds of paste and mucilage, all of which have been known in the market and are called for as Davids' Inks, or Davids' Paste, or Davids' Mucilage. By reason of this fact purchasers and the public generally in the purchase of such articles have come to identify the same as of your orator's manufacture largely, if not entirely, by reason of the presence upon the label of the word Davids and the word Ink or the word Paste or the word Mucilage as the most prominent part of the label, paying little, if any attention to the color or other characteristics of the various labels, which color and characteristics are subject to change, and as before stated present quite a large variety of appearance.

9. That defendant, Cortland I. Davids, entered the employ of your orator as book-keeper about the month of June, 1905, and remained in said employ for a period of nine months; and the other defendant, Walter I. Davids, entered your orator's employ as assistant book-keeper some time in the year 1904, and remained in said employ until about the month of March, 1906; that both of said defendants while in said employment became familiar with your orator's manufacture of inks, mucilage and paste from seeing the same constantly about your orator's show rooms and office at 127 William Street, New York City, where they were employed and from their position as book-keeper and assistant book-keeper became aware of the popularity and demand for said goods, and to a large extent became familiar with the names of your orator's customers and the quantity of said goods usually purchased by said customers.

10. That somewhere about the month of March, 1906, your orator for good cause discharged the said two defendants from its said

employ, since which time there has been no business connection or employment of any sort between your orator and the de-
6a fendants or either of them, and no authority has ever been given by your orator to said defendants or either of them to use said trademark or to manufacture or sell any inks, mucilage or paste bearing in any form the word Davids' thereon, or on any label attached thereto, or to hold themselves out as having any connection with your orator or its products or process of manufacture.

11. That prior to said March 1906, neither of the defendants, so far as your orator is informed and believes had ever undertaken to make or sell or put on the market any inks or mucilage or paste in any form, nor had held themselves out in any way as being manufacturers of such articles; but that some time after their said discharge, but how long your orator cannot say, defendants associated themselves together in the business of making and selling inks, mucilage, paste, and contriving and intending to injure your orator in its business, and to divert to themselves the benefit and advantage which otherwise would have accrued to your orator from the excellence and popularity of its said goods known to the trade as Davids' Ink, Davids' Mucilage, Davids' Paste, defendants adopted as a tradename the firm name and style "Davids Manufacturing Company," and began putting on the market inks, mucilage and paste in bottles on which were pasted labels at the top of which the word Davids appeared in prominent type, at the middle of which appeared the word Ink, or the word Mucilage, or the word Paste, as the case might be, appeared in prominent type, and at the botton of which label the words Davids Manufacturing Company appeared in prominent type, and sold the same and offered the same for sale as Davids' Ink, Davids' Mucilage and Davids' Paste, by reason of which said goods so labelled were calculated to deceive the public and did actually deceive the public in many instances into the belief that in buying defendant's goods they were buying your orator's goods, whereby great confusion was created in the market as to the origin of said goods to the great damage and injury of your orator
6b and in infringement of your orator's registered trademark, as well as your orator's vested rights of trademark at common law.

12. That defendants so manufactured and sold said articles and so labelled them in infringement of your orator's registered trademark as above set forth not only within the Southern District of New York, but in commerce among the several states, and have thereby caused and are threatening to continue to cause great and irreparable injury to your orator's said business unless defendants can be restrained by order of this honorable Court.

13. That the specific act of infringement herein complained of as affecting your orator's said registered trade-mark consisted, not in the mere use of the word Davids without otherwise labeling their goods to produce confusion (your orator having no objection to the mere use of the name C. I. Davids on defendant's goods) but in setting said word Davids in prominent type at the top of the label, the word Ink, Paste or Mucilage also in prominent type near the

middle of the label, and the arbitrary adopted trade name of Davids Manufacturing Company in imitation of your orator's trade name Thaddeus Davids Company at the bottom of the label.

14. That said use of your orators' registered trademark on the part of said defendants and the putting of their goods on the market as and for your orators' goods constitute, as your orator is advised, not only an infringement of your orators' lawful trademark, but also unfair and unlawful competition on the part of defendants, which, if continued, will cause irreparable loss and injury to your orator.

Wherefore, as your orator can have no adequate relief except in the Court of Equity, may it please your Honors to grant unto your orator a writ of subpœna, issuing out of and under said seal of this Honorable Court, directed to the said defendants, Cortland I. Davids and Walter I. Davids, trading under the name of Davids' Manufacturing Company, commanding them and each of them
6c to be and appear on a certain day and under penalty in this Court then and there to answer this complaint but not under oath, the oath thereto being expressly waived, and to stand to and abide such order and decree as may be made against them, and your orator further prays that said defendants may be compelled to account for and to pay to your orator the profits by them acquired and the damage suffered by your orator from the said unlawful acts, and that said defendants, their servants, agents, and attorneys may be enjoined and restrained by the order of this Court from the use of the words Davids Manufacturing Company, and from the use of the word Davids' at the top of their labels in connection with the business of making and selling inks, mucilage or paste, and from selling or offering for sale their goods as Davids' Ink, Davids' Paste or Davids' Mucilage in such manner as is calculated to deceive the public or mislead it into the belief that any inks, mucilage or paste manufactured by defendants are of the manufacture of your orator; and from doing any other acts or things which are intended or calculated to create confusion as to the origin of your orator's goods, and from attempting to divert to defendants any part of the trade which your orator has built, in connection with its predecessors, or by means of said trade-mark and by means of your orator's well earned reputation for superiority of goods.

And your orator prays in this regard not only a preliminary injunction restraining defendants, their servants, agents or attorneys as hereinbefore prayed during the pendency of this suit, but also a perpetual injunction and for such other and further relief as your Honors may seem meet.

And your orator will ever pray, etc.

THADDEUS DAVIDS COMPANY,
By L. A. DAVIDS, *President*.

W. P. PREBLE, Jr.,
Solicitor and of Counsel for Complainant.

6d *Oath.*

STATE OF NEW YORK,
County of Westchester, ss:

On this 28th day of March, 1908, per-onally appeared the above named L. A. Davids, and made oath that she is the president of the Thaddeus Davis Company, and that she has read or heard read the foregoing amended bill of complaint by her subscribed and under-tands its contents, and that the same is true of her own knowledge except as to matters therein stated on information and belief and as to those matters she believes it to be true.

L. A. DAVIDS.

Subscribed and sworn before me this 28th day of March, 1908.
[SEAL.] FREDERICK H. SECORD,
Notary Public, Westchester Co., N. Y.

(Endorsed:) United States Circuit Court, Southern District of New York.—In Equity.—Thaddeus Davids Company vs. Cortland I. Davids and Walter I. Davids, (trading as) The Davids Manufacturing Company.—Amended Bill of Complaint.—From the office of W. P. Preble, Jr., 150 Nassau Street, New York City.—U. S. Circuit Court, Southern District of N. Y.—Filed Mar. 30, 1908.—John A. Shields, Clerk.

7 United States Circuit Court, Southern District of New York.

In Equity.

THADDEUS DAVIDS COMPANY
vs.
CORTLANDT I. DAVIDS and WALTER I. DAVIDS.

Evidence for Complainant.

Testimony on behalf of the Complainant, taken pursuant to notice under and pursuant to the 67th Rule of the Supreme Court of the United States, as amended, before John A. Shields, Esq., Examiner, at the Office of W. P. Preble, Jr., 150 Nassau Street, New York City, on Tuesday, June 28th, 1910, at eleven A. M.

Present:
W. P. Preble, Jr., Counsel for Complainant.
Emerson R. Newell, Counsel for Defendants.

Complainant's counsel offers in evidence printed Patent Office copy of United States Registered Trademark, No. 59,898 issued to Complainant company, January 22nd, 1907, for Inks and Stamp Pads, and the same is marked Complainant's Exhibit Trademark in suit.

Counsel for Defendant objects to the foregoing Exhibit as secondary evidence. And calls for the Original certificate of registration

It is conceded by Counsel for Defendants, on the assurance by Counsel for Complainant, that the same is a fact, that the complainant is, and was at the time the bill of complaint was
8 filed, a corporation of the State of New York, subject, however to proof of the contrary if errors should be discovered.

Deposition of Louis E. Williamson.

Direct examination by W. P. Preble, Jr., of Counsel for complainant, said witness having been duly sworn.

Q. 1. Please state your name, age, residence and occupation.

A. Louis E. Williamson, forty-nine years old, 165 Rutland Road, Brooklyn, New York, Sales manager of the Thaddeus Davids Co.

Q. 2. How long have you been connected with the Thaddeus Davids Co.?

A. Between twenty-four and twenty-five years.

Q. 3. Is that company the same Thaddeus Davids Co. which is complainant in this suit?

A. It is.

Q. 4. Are you familiar with the registered trade-mark of said company, a copy of which is now handed you, and if so, please state whether or not you have personal knowledge as to the use of said trade-mark in connection with the goods of said complainant company?

A. I know there was such a trade-mark registered and that we use these on our goods that we ship all over the world.

Defendant's counsel objects to the answer on the ground that it is secondary evidence. That which is actually used should be produced.

Q. 5. What class of goods?

A. On inks, mucilage, sealing wax, stamp pads, stamping ink, indelible ink and other goods of their manufacture.

Q. 6. In using this registered trade-mark in connection
9 with the manufacture and sale of ink, how is the word applied to the ink?

A. In a good many different ways, principally Davids' celebrated inks.

Q. 7. You do not quite understand me, ink being a fluid, you can hardly affix the name to the ink itself and my question was intended to ask you how you applied the word Davids' to the ink.

A. Well, we apply the word to signs, labels—printed matter of all kinds.

Q. 8. To what are the labels containing this mark attached and how?

Counsel for defendant objects to this line of evidence on the ground of its secondary character, as the labels, etc., should be produced which would show the matters inquired about.

A. To bottles and various goods manufactured we have signs on boxes and we have signs made to send to our customers all over the country reading Davids' Celebrated Inks.

Q. 9. Can you produce a specimen of the labels to which you refer?

A. Yes, sir.

Complainant's counsel offers in evidence, the label produced by the witness, same to be marked Complainant's Exhibits, Specimen of Complainant's Label.

Q. 10. This label which you have produced, seems to be provided on the back with a coating of mucilage, to what is this label to be stuck?

A. On the bottle itself. And boxes.

Q. 11. Are you personally acquainted with either or both of the defendants in this case Cortlandt I. Davids and Walter I. Davids?

A. Yes.

Q. 12. How long have you known them?

A. For a number of years.

10 Q. 13. Please state briefly, what if any, personal knowledge you have as sales-manager of the complainant company, of the presence on the market, of inks, made and sold by the defendants and to what extent, if at all, you have found them to interfere with the business of the complainant company; producing as a part of your answer specimens of such labels of defendants' goods as you have run across.

Adjourned for recess.

A. I have found people come to the office who have stated that they went into Stationery stores, and asked for a bottle of Davids' ink as they had been accustomed to, and they received ink made by the Davids' Mfg. Co., complained to us that that was not the ink they wanted, carried it back to the Stationer, and got ours.

Counsel for Defendants objects to the answer as merely hearsay evidence, and makes the same objection to any further evidence of this character.

I called on a customer of ours in Washington, D. C., the purchasing agent of the Southern R. R., he told me that he had written to the Thaddeus Davids Co. asking for quotations and I told him we had received no such letter; he said "I have a copy of the letter I sent you"; I asked him to show it to me, and when he got his book, he said, showing me the letter, that by mistake he sent it to the Davids Mfg. Co., thinking he was writing to the Thaddeus Davids Co. We repeatedly have people go to Courtland St., to the Davids Mfg. Co. thinking they are going to the office of the Thaddeus Davids Co. When they find they are mistaken, they come back and tell us so. Here are the bottles with the labels, showing the ink put

11 up by the Davids Manufacturing Co.

Counsel for Defendant objects to all of the preceding answer,

except the last sentence, on the ground of being merely secondary and hearsay evidence.

We received a letter forwarded to us by the Davids' Mfg. Co., which was an order; they wrote on the bottom, "We do not handle this kind of goods, and this was intended for you." This was a postal by the way. We wrote to the writer of the order, and he said that he supposed that it would come to us, as he did not know of any other Davids in the business.

Defendants' counsel makes the same objection on the ground of secondary evidence.

Q. 14. How long has this label which has been offered in evidence as Complainant's Exhibit Specimen of Complainant's label been used by the complainant company, in connection of the manufacture and sale of inks?

A. It has been used by them ever since I have been with the concern, and many years before.

Q. 15. Is this label the oldest form of label among those which you have brought here?

A. Yes, we have older labels than this, but this is the oldest which I have brought here.

Q. 16. Will you please look at the other labels of which you have brought here specimens, namely, Davids' Magic Black, Davids' Oriental Carmine Ink, Davids' Brilliant Scarlet Ink, Davids' Combined Writing and Copying Ink, Davids' Oriental Red Ink, Davids' Superior Unchangeable Blue Ink, Davids' Non-copying Carmine Ink, Davids' Excelsior Violet Ink, Davids' Chemical Copying Ink, Davids' U. S. Copying Ink, Davids' New York School Ink and Davids' Marking Ink, and state approximately, in turn, how long each of
12 those labels has been used by the complainant company, in the manufacture and sale of its inks?

A. In reply to that question I can only say that most of these labels had been used by the Thaddeus Davids Co. long before I have been in connection to the firm.

Q. 17. Please point out by name those which you identify as having been used by the Thaddeus Davids Co. before 1886.

A. Davids' Brilliant Scarlet Ink, Davids' Combined Writing and Copying Ink, Davids' Oriental Red Ink, Davids' Superior Unchangeable Blue Ink, Davids' Excelsior Violet Ink, Davids' Chemical Copying Ink, Davids' U. S. Copying Ink, and Davids' Marking Ink.

Counsel for Complainant offers in evidence the eight labels, just identified by the witness, the same to be marked, Complainants' Exhibit, Eight Other Labels.

Q. 18. Were either of the remaining four labels used by the Thaddeus Davids Co. in connection with its manufacture of ink, prior to the 12th day of July, 1906; if so, which?

A. Yes, Davids' Magic Black, Davids' New York School Ink, and Davids' Oriental Carmine Ink.

Q. 19. Was either of these three labels used as far back as 1896, to your knowledge?

A. Yes.
Q. 20. Which?
A. All three.

Counsel for Complainant offers for evidence, three labels identified by the witness, to be marked Complainant's Exhibit, Three More Recent Labels.

Q. 21. Has the use of any of the labels which you have produced been discontinued or are they still used?
13 A. We use them all.

Counsel for Complainant, offers in evidence, the quart bottle of Black Fluid Ink marked C. I. Davids Writing, and the one-half pint bottle of Carmine Ink, marked C. I. Davids Carmine Ink, produced by the witness, in answer to question 13, as specimen of Defendants' ink; the same to be marked Complainant's Exhibits, Specimen of Defendant's Black Ink and Specimen of Defendant's Red Ink.

Q. 22. Where did you procure the specimens of Defendants' inks, which you have produced?
A. In my rounds amongst the retail stationers in New York City, one of my customers told me if I would take these inks that he had in stock, in exchange for some of ours, of the Thaddeus Davids Co. he would never handle these inks again, and I did.

Counsel for Defendant objects to the answer as irresponsive and volunteered.

Q. 23. Have you any objection to naming the customer?
A. No.
Q. 24. Then where did you get these two bottles?
A. From a stationer on Fulton St., between William and Gold Sts., New York City. Landsberg Bros., 86 Fulton Street.

It is hereby admitted by Counsel for Defendants, that the defendants have made and sold, Writing Fluid and Carmine Ink and have put the same upon the market in bottles, having labels thereon like those upon the bottles of the two exhibits introduced in evidence following Q. 21, Subject to correction if errors should be discovered.

Cross-examination by MR. NEWELL:

X Q. 25. Have all the labels which have been introduced in evidence, as those used by the Complainant Company, been
14 identically the same in every respect, as those which have been introduced, since you first were with the complainant company?
A. No.
X Q. 26. They have been changed at different times, I presume, but at the present time, these are the labels which are now used, is that correct?
A. One or two of these labels have been changed slightly since 1886.

X Q. 27. Then these labels which have been introduced, do not in each case, show exactly what was used, in the early days, is that correct?

A. A number of these are just as they have been used since 1886.

X Q. 28. Who else now besides the Thaddeus Davids Co., uses or has used, labels like these, or any of them?

A. No one.

X Q. 29. These are not all the labels which the complainant uses at the present time, on its inks?

A. No.

X Q. 30. Will you please produce specimens of each of the other labels which the complainant company uses on inks?

A. Yes, and here they are.

The labels referred to, are herewith introduced in evidence and marked Defendants' Exhibit "Additional Labels of Complainant."

X Q. 31. Are you sure that the word "Davids," by itself at the top of the labels, has been used in that way, since 1886?

A. Yes.

X Q. 32. Was there any other firm or concern, by the name of Davids, in the ink business in New York City, between 1886 and the year 1900 and if so, who was it?

A. I don't know of any concern besides the Thaddeus Davids Co., between those years.

15 X Q. 33. The two defendants, Cortlandt I. Davids, and Walter I. Davids, are descendants of the original Thaddeus Davids, are they not?

A. I have been told so.

X Q. 34. To the best of your knowledge and belief, that is correct, is it not?

A. Yes.

X Q. 35. When was the Thaddeus Davids Co. incorporated?

A. Before my time.

X Q. 36. Are you acquainted with the manufacture, that is, the process of manufacture and the ingredients used in the inks, mucilage and paste put out by the Complainant Co.?

A. No.

X Q. 37. Nor with any of them?

A. Why, I have a slight knowledge of the general ingredients used in the manufacture of inks, paste, mucilage, but my connection with the firm has been salesman and sales manager and had nothing to do with the manufacture of the goods.

X Q. 38. So that you really know nothing about the manufacture of complainant's goods, except in a very general way?

A. That's right.

X Q. 39. Do you know the ingredients in making the complainant's Chemical Writing Fluid?

A. I have already answered what I knew about the manufacture of the goods.

X Q. 40. You have stated that you knew in a general way about them; I want to find out what you do know about them. If you do

not know anything about them sufficient to give a definite answer, please say so, and I will go no further with that branch of the matter?

A. I don't have anything to do with the manufacturing of the goods.

X Q. 41. The processes and ingredients of these inks are in general those which are used by other manufacturers and have been for a great many years, are they not?

16 A. I don't know.

X Q. 42. As sales manager, I should suppose that you would know something about the ingredients and manufacture of the articles which you sell.

A. Not necessarily.

X Q. 43. Well to be more specific, do you know what is used in manufacturing your Security Mucilage?

A. I know there is gum and water in it.

X Q. 44. What sort of gum?

A. I don't know.

X Q. 45. Is gum arabic used by your company in manufacture of that or any of its mucilage?

A. Yes.

X Q. 46. Do you know this to be a fact?

A. Yes.

X Q. 47. Cortlandt I. and Walter I. Davids, or at least Cortlandt I. Davids manufactured sealing wax before he entered the employ of your company, did he not?

A. For the Thaddeus Davids Co.

X Q. 48. If I understand you then Cortlandt I. Davids manufactured sealing wax and sold to the Thaddeus Davids Co., prior to the time that he entered the employ of that company?

A. To the best of my knowledge, that is correct.

Cross-examination closed.

LOUIS E. WILLIAMSON.

17 NEW YORK, *June 29th*, 1910.

Met pursuant to adjournment.

Present Counsel as before.

Deposition of John W. R. Merckle.

Direct Examination by W. P. PREBLE, Jr., Counsel for Complainant, the witness having been duly sworn:

Q. 1. Please state your name, age, residence and occupation?

A. John W. R. Merckle; age, thirty-five; 902 Lincoln Place, Brooklyn, New York; President and General Manager of Thaddeus Davids Company.

Q. 2. How long have you been connected with the Thaddeus Davids Co?

A. Twenty-one years.

Q. 3. Were you present during the testimony of Mr. Williamson, taken yesterday?

A. I was for a part of it.

Q. 4. Have you personal knowledge of the use by the Thaddeus Davids Co., of the labels, introduced as Complainants' Exhibits, to wit: "Specimen of Complainant's label;" "Eight other labels," and "Three more recent labels," and if so, do you agree or disagree with the testimony of Mr. Williamson as to the lengths of time during which those said labels had been used?

A. I have personal knowledge. And I agree with him that they have been used the length of time mentioned.

Q. 5. Have you brought with you any specimens of the signs used by the Complainant company, in advertising its inks, and if so, state what they are and how they are used?

A. I have. Davids' Inks Banner showing advertisement, which has been in use by the company for a period of over twelve years.

Also, three metal signs advertising Davids' Electro-Chemical
18 Writing Fluid, Davids' Scarlet Ink, Davids' Steel Pen Black Ink also the glass sign framed, reading "We recommend Davids' Celebrated Inks." It is customary wth us to distribute these signs to the stationer, and with the glass sign we imprint the dealer's name on the bottom of same. Another paper sign, which reads "Davids' Ink always writes right." The glass sign mentioned we have used for about five years, the metal signs, for over ten years.

Counsel for complainant offers in evidence the signs produced by the witness to be marked respectively, Complainants' Exhibit Banner, Complainants' Exhibit Metal Signs, No. 1, No. 2 and No. 3, Complainants' Exhibit Glass Sign, and Complainants' Exhibit Paper Sign.

Counsel for defendants objects to the answer and the exhibits produced on the ground of immateriality, the same not having been used on or in connection with the goods.

Q. 6. How was the Exhibit Banner used and where?

A. They were distributed to the trade for advertising purposes.

Q. 7. By trade, do you mean the retail stores, and other stores, which handle your ink?

A. Yes, sir.

Q. 8. Were these banners intended and used for distribution by these stores, to their customers accompanying the ink, or as display signs in the stores?

A. They were usually sent in shipments of goods to the customers, and were used by them as display signs in order to advance the sale of Davids' ink. That is our customers' stores.

Q. 9. How about the metal signs, how were they used?

A. They were used in a similar way.

19 Q. 10. How is the glass sign used?

A. The customer usually hung the glass sign in the most prominent part of the store, owing to the fact that it is an elaborate sign advertising our goods, as well as the fact that it usually carried the dealer's name.

Q. 11. How about the Exhibit Paper Sign?

A. Used the same as the banner was used.

Q. 12. Approximately, how many of these various signs has the Thaddeus Davids Co. distributed during the last twelve years, and in what sections of the country?

A. We got out 50,000 metal signs, 10,000 banner signs, 5,000 paper signs, and about 3,000 glass signs in all parts of the United States as well as foreign countries.

Q. 13. When the two defendants, Cortlandt I. Davids and Walter I. Davids, were in the employ of the Thaddeus Davids Co., in 1905 and the early part of 1906, did they or not, or either of them, to your personal knowledge, become acquainted with the various labels which the Thaddeus Davids Co. used on its ink, and with the signs which you have produced and identified?

A. I believe they did.

Q. 14. When first after the defendants left the employ of the Thaddeus Davids Co., in March, 1906, did you learn that they had gone into the ink business under the name of the Davids Manufacturing Co.?

A. To my knowledge it was the latter end of 1907.

Q. 15. Since that time, have your duties as president of the Thaddeus Davids Co. caused you to ascertain to what extent, if any, the fact that defendants were selling inks under the name of the Davids Manufacturing Co. has confused your customers and the public generally as to the origin of Davids' inks; if so, please state briefly what facts in that regard have come to your personal knowledge?

A. There are in no doubt many, but it's hard to recall them just at this time. I will mention one in particular who purchased Davids Manufacturing Co. products, and when our representative called this dealer mentioned the fact to him that she was surprised that we had changed the style of our label. She was informed then of the fact that there was another Davids making ink, by our representative. This same thing may go on without our knowledge in a good many other cases.

Counsel for Defendants objects to the answer as purely hearsay and secondary evidence.

Q. 16. Who was the customer referred to in your last answer?

A. W. F. Murray, Ann Street, near Nassau Street, N. Y. City.

Q. 17. Have you any personal knowledge as to whether mail intended for the Thaddeus Davids Co. has gone to the Davids Manufacturing Co., or mail intended for that company has gone to your company, and, if so, what are the facts in that respect?

A. To my knowledge we have received several communications addressed to us which were intended for the Davids Mfg. Co., and each instance forwarded the letter to the proper address, and I produce a letter signed by the Davids Mfg. Co. which is evidence that mail intended for us reached them.

Q. 18. What is the date of this letter which you now produce?

A. October 19th, 1909.

Q. 19. Was this letter received by you in the ordinary course of business on or about its date?

A. It was.

Counsel for Complainant offers in evidence letter produced
21 by the witness, same to be marked Complainant's Exhibit Letter of October 19th 1909.

Cross-examination by Mr. NEWELL:

X Q. 20. These letters which were delivered to your company, and which you say should have gone to the Davids Manufacturing Co., were addressed to the Davids Manufacturing Co., were they not?

A. In some instances, I believe they were.

X Q. 21. Did they come to your company because the postman had wrongly delivered them to you or because the wrong street number was given on the address?

A. The wrong street number.

X Q. 22. Do you remember any instance whatever of a letter being delivered to your company, and intended for the Davids Manufacturing Co., which was not addressed to that company?

A. I think they all were addressed to the Davids Manufacturing Co.

X Q. 23. The reason they came to your company was because of the wrong street address, was it not?

A. I believe it was. In one instance an order came addressed to us in an envelope and the inner order read for the Davids Mfg. Co., and I had our representative carry it to the Davids Manufacturing Co.

X Q. 24. Do you remember anything about this order of E. Jeantet which is mentioned in the Davids Manufacturing letter of October 19th, 1909?

A. I do. This E. Jeantet bought our goods for years, and when this order came, our bookkeeper called them up and they requested us to fill this particular order, which our company did.

X Q. 25. And this your company did in spite of the fact that the order which you received on the card was addressed to the Davids Manufacturing Co., is that correct?

22 A. No, it was addressed Davids Mfg. Co., 97 Vandam St., N. Y.

X Q. 26. The card was addressed to the Davids Manufacturing Co., but the street address was wrongly given, is that correct?

A. That's right.

X Q. 27. Do you say that you had returned to the Davids Mfg. Co. other orders or letters addressed to them in the same way, and which your company had received?

A. Yes.

X Q. 28. You have stated that Mr. Williamson was right in his answers which he has given in regard to the length of time the labels which have been introduced were used by the complainant company. Are you sure that all of those labels have been used

by your company for the times he mentioned, without any change from what they are now?

A. Kindly let me see labels.

X Q. 29. Haven't you seen them yet?

A. I have.

X Q. 30. Well, then, please answer as to those labels which you have seen? Haven't you seen all those that Mr. Williamson answered about?

A. I have.

X Q. 31. Then you must know what they are. Can you answer my question from recollection?

A. Yes, to the best of my knowledge they have been used for the time mentioned.

X Q. 32. That is, all of them have been used without any change whatever for the times he mentioned?

A. Some of them may have had some slight changes.

X Q. 33. Some of them at least, to your knowledge, have been changed in that instead of the word "Davids" solely at the
23 top, the said word has been substituted for the words "Thaddeus Davids Co."; that is correct, is it not?

A. I believe that is correct.

X Q. 34. So that the labels which Mr. Williamson testified about do not all of them show how the labels were originally used, but what they do show is the labels as they are at the present time used by the Thaddeus Davids Co.; that is correct, isn't it?

A. That's correct.

X Q. 35. It's a common custom, is it not, for manufacturers to change their labels at intervals, as they see fit?

A. I won't say that it is a common custom, but where a manufacture can improve his labels he usually does so.

X Q. 36. And that was the reason you changed your labels, I suppose?

A. That is correct.

X Q. 37. What label of your company is applied to the same kind of ink as the label which appears on the quart bottle of the defendant's ink which has been produced?

A. We don't make the same kind.

X Q. 38. This ink of the defendant's quart bottle would not answer for the uses to which your ink is put, would it?

A. I have not tested it.

X Q. 39. It would be used for the same uses as your ink?

A. It probably would.

X Q. 40. Well, if your company don't make an ink like that of defendants', please indicate which ink of your company comes nearest to it and indicate the label which your company uses on that ink?

A. We make an ink of similar character, but consider ours superior, for the reason that we have better facilities for manufacturing writing ink. The labels that we would use on our writing fluid

would be: Davids' Chemical Writing Fluid and Davids'
24 Electro-Chemical Writing Fluid, and Blue Black Record Ink.

X Q. 41. The label which you first mentioned is Complainant's Exhibit "Specimens of Complainant's label," is it not?

A. It is.

X Q. 42. The other two labels which you mentioned in answer to X Q. 40, are the two labels (among Defendants' Exhibit "Additional labels"), one of which has at the top, Thaddeus Davids Co., and "Electro-Chemical Fluid, Blue, Black" printed above a picture of New York, and the other one has "Thaddeus Davids Company's" at the top on a red background and the words "Blue black" below that on a blue background, is that correct?

A. That is right.

X Q. 43. The label which your company uses on its carmine ink, which is of a similar kind to that in defendants' half pint bottle, is that one included among complainants' exhibit "Three More Recent Labels," and which has the word "Oriental" over a red crescent and the words "Carmine ink" printed in red below it, is that right?

A. That is right.

X Q. 44. How long have you been president of that company?

A. About a year.

X Q. 45. What was your position before that?

A. Secretary-Treasurer.

X Q. 46. You were there when the two defendants were in the employ of the complainant company?

A. I was.

X Q. 47. C. I. Davids is the grandson and Walter I. Davids the great-grandson of the original Thaddeus Davids, by whom your company was founded, are they not?

A. I believe they are.

X Q. 48. Did you ever hear of John B. Davids?

A. I knew him.

25 X Q. 49. Who was he?

A. Son of the original Thaddeus Davids.

X Q. 50. He was in business for himself in New York City, several years ago, was he not?

A. Not since my connection with the Thaddeus Davids Co.

X Q. 51. Are you sure about that?

A. Positive.

X Q. 52. And the John B. Davids Company was not either?

A. Not to my knowledge.

X Q. 53. That company made and sold inks in New York, didn't they?

A. I believe they did.

Adjourned for recess.

X Q. 54. If some other name, for example, C. I. Smith's, were used on defendant's labels in place of the C. I. Davids', which appears thereon, there would be nothing on the labels to confuse the ordinary purchaser into thinking he was purchasing the Thaddeus Davids' Co. inks, would there?

A. If it was Smith's inks they naturally could not take it for Davids' inks.

X Q. 55. Then your answer to the *proceeding* question is substantially "no," is it not?

A. Yes.

X Q. 56. In other words, it is the presence thereon of the name "Davids" which is alone its confusing feature to the ordinary purchaser, is that correct?

A. That is correct.

X Q. 57. And if C. I. Davids should take off his name from his labels, your company would have no cause for complaint, would they?

A. Yes, they would.

X Q. 58. What I mean is, with relation to the labels only.

A. I would say that the name as well of the Davids Mfg.
26 Co. should come off the label, as they conflict, as the name of Davids has been known in the ink line in my opinion ever since 1825.

X Q. 59. What I mean is, if the name at the top were C. I. Smith's instead of C. I. Davids' and the name at the bottom were Smith's Mfg. Co., instead of Davids Mfg. Co., on the defendants' labels, there would then be no cause for complaint by your company, would there?

A. I don't see how there could be.

X Q. 60. It is the name "Davids" which is the sole cause of the confusion, as you consider it, between the labels of the defendants and the complainant's manner of marking its goods. That is correct is it not?

A. That is correct.

X Q. 61. It has been the custom for other ink manufacturers to place their name (Staffords or Carters, for example) at the top of their labels the word "ink" or "mucilage" or "paste" at the middle of the label and the name of the company (for example, Carter Ink Co.) at the bottom of the labels, has it not?

A. I believe that is their custom.

X Q. 62. This has been so for a great many years, has it not?

A. I believe it has.

X Q. 63. At least it has been so ever since you have been with the Thaddeus Davids Co., hasn't it.

A. Yes.

X Q. 64. And you have been with the Thaddeus Davids for how many years?

A. Twenty-one years. I also wish to state that I believe competitors' ink companys use their full name of the company as well as only part of the name of the company, in some cases, on their labels.

X Q. 65. That is, the other companys use their full name, for instance, "S. S. Staffords" at the top of the label, as well as
27 using the word "Staffords" alone, on other labels on inks, mucilages, and paste?

A. That is correct.

X Q. 66. There is no imitation on defendant's labels of the name of the Thaddeus Davids Co., except the use of the word "Davids," is there?

A. No, there is not.

X Q. 67. When C. I. and Walter I Davids entered the employ of the complainant company, they did so at the request of what person in your company?

A. David F. Davids; but, to my recollection, David F. Davids simply hired C. I. Davids out of charity.

X Q. 68. Do you know what relation David F. Davids was to Cortland I. Davids?

A. His uncle.

X Q. 70. He also hired Walter I. Davids, did he not?

A. He did.

X Q. 71. What position did David F. Davids hold in the complainant company?

A. He was the president.

X Q. 72. Is he alive now?

A. No, he is dead.

X Q. 73. Do you know whether or not Mr. David F. Davids asked or authorized Walter I. Davids to learn the business of the complainant company while he was in their employ?

A. I really don't know.

X Q. 74. While Walter I. Davids was so employed, he did, at the request of Mr. Davids, or some else in the company, learn more or less about the manufacture of inks, did he not?

28 A. I don't see how he could, he was employed in the office, and had nothing to do with the manufacturing end of the business.

X Q. 75. Would your answer be the same in regard to Mr. Cortlandt I. Davids?

A. Yes it would.

X Q. 76. The Davids Mfg. Co., has been accustomed to and has returned to your company, letters which have come to the Davids Mfg. Co's place of business, although addressed to the Thaddeus Davids Co., have they not?

A. I'll leave that for them to say.

X Q. 77. It is correct, is it not, that you know of no instance of any letters or orders addressed to the Thaddeus Davids Co., which have gone to the Davids Mfg. Co.?

A. I do not.

X Q. 78. It is also true, is it not, that orders addressed to the Davids Mfg. Co., for inks and which they could not fill, have been sent by them to the Thaddeus Davids Co. to fill?

A. Yes, I know of a few instances.

Cross-examination closed.

Redirect examination by Mr. PREBLE:

R. D. Q. 79. When you received the letter which you have offered in evidence, what was the business address of the Thaddeus Davids Co.?

A. 95-97 Vandam Street, New York City.

R. D. Q. 80. Since you have been connected with the Thaddeus Davids Co., have you been personally familiar with most of the mail received by that company?

A. I have.

R. D. Q. 81. Have letters received by the Thaddeus Davids Co., since you have been with that company, and which were intended for said company, always been directed to "Thaddeus Davids Co."?

A. They have not.

29 R. D. Q. 82. Have they always contained the correct or any street address?

A. They have not?

R. D. Q. 83. Can you recall any addresses on letters received by the Thaddeus Davids Co. while you have been with that company, and which letters had been intended for said company, and which addresses were not strictly accurate, in that they did not contain the full name of the company, or the correct street address; if so, please mention a few of them?

Counsel for defendant objects to the question as calling for secondary evidence, as the letters themselves are the best evidence.

A. Yes, I can recall numerous letters for many years addressed as follows: Davids Ink Co., Davids Ink Mfg. Co., T. Davids Co., Davids Co., and in fact I believe I can produce several letters that are now on our files addressed in the manner above mentioned.

In view of the last answer, defendants' counsel renews his objection, as the witness has shown that the best evidence is producable.

R. D. Q. 84. You have only answered as to the name of the company; how about the street number?

Same objection.

A. In many instances the envelope bears no street address at all, simply saying New York. We have also received them with all sort of addresses. We at times even received letters directed to us in Chicago, where we have no office, and are returned to us here in New York.

JOHN W. R. MERCKLE.

30 NEW YORK, *June 29th*, 1910.

Deposition of Stephen T. Buckham.

Direct examination by W. P. PREBLE, JR., Counsel for Complainant, the witness having been duly sworn:

Q. 1. Please state your name, age, residence, and occupation.

A. Stephen T. Buckham, thirty-five years old, 396A Decatur St., Brooklyn, New York, salesman for the Thaddeus Davids Co.

Q. 2. How long have you been in the employ of the Thaddeus — Co.?

A. About twenty months.

Q. 3. What territory do you cover?

A. New York City and vicinity.

Q. 4. In offering the inks of the Thaddeus Davids Co., have you run across the goods of the defendants like the two exhibits in this case, now shown you, marked Specimen of Defendants' Black Ink and Specimen of defendants' Carmine Ink?

A. I have, a little.

Q. 5. Please tell us what you know, of your personal knowledge, of any confusion which may have arisen in your trade, that is the trade of the Thaddeus Davids Co., in inks, from the fact that defendants are putting out such inks as those two samples with the name "Davids" at the top and the name "Davids Mfg." at the bottom of the label?

Defendant's counsel requests that, inasmuch as the witnesses preceding this one have given a good deal of hearsay testimony, and as the foregoing question may be answered by the witness with similar evidence, that counsel for complainant instruct the witness not to give hearsay evidence, or evidence of what any one told him,
but only as to the facts which he knows of his own personal
31 knowledge. Counsel for defendants makes his request that,
if possible, hearsay testimony be excluded from this record in the future.

Counsel for complainant replies that the question calls for what the witness knows from his personal knowledge, and nothing else, but to make the matter perfectly plain, he, as requested, instructs the witness that he should testify as to the instances, if any, in which he personally has seen and talked to the persons who were deceived as to the names, and not pay any attention to what others told him about other people being deceived.

A. In the early part of 1909, a few months after I became connected with the Thaddeus Davids Co., I called on a stationer—W. F. Murray, Ann Street, City—and introduced myself as a salesman of the Thaddeus Davids Co. The buyer of this concern told me that the last order placed with Davids' salesman had been filled with goods having labels altogether different than our regular labels. I investigated, and found that the order had been filled by the Davids Mfg. Co., and they supposed that they——

Defendants' counsel interrupts and objects to this hearsay evidence as to what somebody told him on the ground that it is secondary evidence. This is precisely the reason why he made the request following the question above, and gives notice that if such hearsay evidence is persisted in he will move to strike out the same at the cost of the complainant. He requested the witness to refrain from hearsay evidence and give only the facts that he himself knows.

The buyer then told me that he expected to receive merchandise manufactured by the Thaddeus Davids Co., when the order was placed.

Counsel for defendant renews his objection.

32 In the latter part of 1909, the Thaddeus Davids Co. received a letter from a down-town export house requesting a salesman to call and quote prices. I called there, quoted the prices, and was told by the buyer he would mail the order to me. As he did not receive the order within the next few weeks, I called and found that the order had been mailed through error to the Davids Mfg. Co., and was told that the order had been filled by them and goods had been shipped. The name of the concern is Melchoir, Armstrong & Dessau, 116 Broad Street, City. In the latter part of 1909 I called on the Martin B. Brown Co., of Park Place, N. Y., and quoted them prices on sealing wax. A few days later I called and received a verbal order for the same and was told by the buyer that the order would be mailed to us. A few days later I received a request to call and see the buyer, and he asked me to be kind enough to cancel our order as the order had since been filled; I found this order was mailed to the Davids Mfg. Co., and they said was done so in error. I very often receive complaints from stationers saying that the Davids' Ink people are calling on the consumers, selling them at a price as good or better than given to the stationers. The last complaint received of this kind was from Hyman & Young, 122 West 22nd Street, N. Y., who said he thought it was the Thaddeus Davids Co. He told me later that he called on these people and found that it was the Davids Mfg. Co. An office on the Santa Fe R. R., which had been using our writing fluid, sent out for a bottle a few weeks ago and received a bottle of the Davids Mfg. Co., which they returned to the stationer and received a bottle of our ink in place of it.

So much of the foregoing answer as is hearsay evidence or otherwise secondary is hereby objected to by counsel for defendants.

Adjourned until Thursday, July 7th, 1910.

33 Met pursuant to adjournment.

Present counsel as before.

NEW YORK, *July 7th*, 1910.

A. 5 (continued). A few months ago, I called on a stationer of 23rd street, J. J. O'Brien, I met there a party in their employ by the name of Mr. Devereaux who complained to me upon the way we were filling orders. He said he placed an order with our sales-man, three or four weeks ago, and did not receive the goods until after he had mailed an order into our house firm. He told me that a party called on him, representing himself to be selling Davids' inks, and he gave him an order for some miscellaneous goods, among which was an order for some of our Letterine. This is an article to which we have copyrighted trade-mark. A few weeks later, this same salesman called on this concern, and upon being asked why the goods were not delivered, he appeared surprised and said he would look into the matter. After an elapse of another week or ten days the goods not having been received, the customer mailed the order in to us.

Counsel for defendants objects to the entire answer as obviously grossly secondary evidence only.

Q. 6. Have you at my request, looked at the files of the Thaddeus Davids Co., to find the wrongly addressed envelopes and letters and if so, have you found any and brought any with you?

Counsel for Defendants objects to the question as immaterial.

A. Yes, I looked through the files and brought a few of envelopes and letters, also some orders.

From the envelopes, letters and orders produced by the witness Complainant's counsel offers in evidence the following: Postal
34 card, post-marked Poughkeepsie, August 2, 1908, directed to Davids Ink Co., 95 Vandam Street, New York City, to be marked Complainant's Exhibit Postal No. 1.

Postal card, post-marked Willimantic, Conn., Sept. 24th, 1908, addressed Mr. Thaddeus Davis, 127 William St., New York City, to be marked Complainant's Exhibit Postal No. 2.

Postal card, post-marked Canton, Ohio, Jan. 23rd, 1909, directed Thaddeus Davis Co., New York, N. Y., to be marked Complainant's Exhibit Postal No. 3.

Postal card, post-marked Albany, New York, March 9th, 1910, addressed to T. Davids, William St., New York, to be marked Complainant's Exhibit Postal No. 4.

Postal card, post-marked New York, N. Y. Sta. B, April 19, 1910, addressed to Davids Ink & Mucilage Co., 90 Van Dam Street, N. Y. C., to be marked Complainant's Exhibit Postal No. 5.

Postal card, post-marked Elizabeth, N. J., May 17th, 1910, addressed Messrs. Thaddeus Davids Sons, 95 Vandam St., New York City, to be marked Complainant's Exhibit Postal No. 6.

Envelope, post-marked Boston, Mass., June 28th, 1910, addressed, Thaddeus David, Ink Co., N. Y. City, to be marked Complainant's Exhibit Envelope No. 1.

Envelope, post-marked Hudson Terminal Sta., New York, June 30th, 1910, addressed T. Davids Mfg. Co., 95 Vandam Street, N. Y. C., with the invoice enclosed directed T. Davids Mfg. Co., 95 Vandam St., calling for 3 Gals., Davids' Marking Ink, the same being from Arthur Mountain & Co., of 111 Liberty St., New York, to be marked Complainant's Exhibit, Arthur Mountain & Co., Envelope and Invoice.

Envelope post-marked New York, N. Y., Sta. S., July 6th,
35 1910, addressed to Davids Ink, 95 Vandam St., City, to be marked Complainant's Exhibit Envelope No. 2.

Post card, post-marked Boston, Mass., July 6th, 1910, addressed Davids Ink Co., New York, N. Y., to be marked Complainant's Exhibit Postal No. 7.

Counsel for defendants objects to the exhibits, as immaterial, to any question here involved, and is not proved.

Q. 7. Please examine the seven postal cards, and envelope and invoice which have been just offered in evidence, and state whether from their contents you can determine if such postal cards and in-

voice and envelope were actually intended for the Thaddeus Davids Co.?

Objected to as calling for evidence which is obviously impossible for the witness to give of his own knowledge.

A. Postal card, Exhibit No. 1, is an order for a book on lettering and show card writing, known as Practical Letterer. This is a book we have published for years. Post card, Exhibit No. 2, is an order for "marking ink, same as usual." An order of this kind had been filled by us to this party previous to the post card. Post card, Exhibit No. 3, is an inquiry regarding our book, Davids' Practical Letterer, the same as in Exhibit No. 1. Post card No. 4 is for a brand of mucilage put out by us. Post card No. 5 is for marking ink which is made by us. Post card No. 6 refers to a shipment which we made to this concern which we made some days previous to the post card. Post card No. 7 is an order for Lettering Show Card Ink, an article on which we have a copyrighted trademark. Envelope and order of Arthur Mountain & Co. is an order similar to those received before from this concern.

36 Q. 8. Do you know whether Wm. M. L. McAdams, of Boston, Mass., and Geo. B. Hurd & Co., New York, whose names are printed on envelopes 1 and 2, were customers of your company prior to the dates of these envelopes?

A. Geo. B. Hurd & Co. I know were, but I can't answer for W. L. McAdams.

Q. 9. You have brought here a letter of the Stock-bridge Elevator Co., of Jackson, Mich., dated June 10th, 1910, addressed to Davids Mfg. Co., New York, N. Y., and calling for a dozen Perfection Paste Jars, to which letter there is pinned an envelope of the Davids Mfg. Co., post-marked Hudson Terminal Sta., New York, June 4th, 1910, 4 P. M., and directed Thaddeus Davids Co., 95 Van Dam Street, N. Y. City. Please explain the circumstances of your receiving this letter and whether or not the order therein contained was filled by your company.

A. This order was received by us in the envelope of the Davids Mfg. Co., but it did not have the envelope that it was originally sent in, with it. This order is for brushes and paste jar, on which we hold a patent. The order was filled by us.

Letter and envelope offered in evidence by counsel for complainant, to be marked, Complainant's exhibit, Stock-bridge Order.

Q. 10. You have also produced an order of Wm. H. Hebert, N. Y. City, dated March 3, 1910, postmarked March 3, 1910, New York, addressed Messrs. Davids Ink Co., 95-97 Vandam Street, N. Y. City, and calling for a Gallon of Scarlet Ink, with packing order attached. Please state whether or not this was received by your company in regular course, at or about its date?

A. Yes, it was received by us and filled, with scarlet ink, an ink that we have catalogued and sold for years.

37 Q. 11. Among these things which you have produced, is an order of Geo. W. Green, Newburgh, N. Y., dated January

18, 1910, Davids & Co., calling for three gross, two ounce, Dark electro fluid, with packing order attached; please state whether that order was received and filled by the Thaddeus Davids Co., on or about its date?

Objected to as immaterial by counsel for defendants.

A. Yes, this order was received and filled by us. This order is for our Electro Chemical Writing fluid, which we have catalogued and sold for years.

Counsel for complainants offers in evidence the Hebert order identified by the witness, same to be marked Complainants' Exhibit Hebert Order; also the Green order identified by the witness, same to be marked Complainants' Exhibit Green Order.

Q. 12. You have also produced a postal card, post-marked New York, N. Y., Sta. J., June 29th, 1910, from I. Pollatshek, 350 Bowery, directed Davids Ink Co., 95 Vandam St., City, which reads: "N. Y. June 29, 1910, Mr. Buckham. Please send me from the new Qt. Bottle 1/2 Doz. Writing fluid. Yours, truly, I. Pollatshek." Please state whether you know Mr. Pollatshek personally, and if you received said order and your company filled it, on or about said date?

Same objection.

A. Mr. Pollatshek is a customer of mine. This order was received by us and filled. The reference he makes to the new bottle is made owing to the fact that we started to pack some of our goods in new bottles a few months ago.

Complainants' counsel offers in evidence the order just identified by the witness, to be marked Complainants' Pollatshek order.

38 Q. 13. You have also produced an order of the Central New York Supply Co., of Utica, N. Y., dated June 26, 1910, which reads: "Davids Ink Co., 17 Van Dam St., N. Y. Gentlemen: Kindly ship order left at your place July 1st, West Shore Train 57, and oblige, Central New York Supply Co., B. R. Please state what personal knowledge you have as to this order and its filling."

Same objection.

A. This communication was received by us a few days ago, and refers to an order that I took from Mr. Rothblum, proprietor of this concern, when he was in New York a few weeks ago.

Counsel for complainant offers the letter just identified by the witness in evidence to be marked Complainant's Exhibit Central New York Supply Co. letter.

Q. 14. You have produced an order from Douglas & Son, directed to Davids Co., Jan. 3rd, for one copy Davids' Practical Letterer. Please state, if you know, in what year that order was received by the Thaddeus Davids Co.?

A. I took that order from our files which contained orders for the years of 1909 and 1910, and I can't tell which year we received it.

Counsel for complainant offers in evidence the letter just identified, to be marked Complainant's Exhibit Douglas Order.

Q. You have produced an order of Morey Stationery Co., of Dec. 14th, 1909, directed Davids' Ink Co., 95-97 Vandam street, New York; one of J. Geo. Hintz, of Reading, Pa., dated May 13th, 1908, Davids' Ink, 125 William St., New York.

Adjourned for recess.
Testimony of the witness suspended by agreement.

39 One of the Mobile Stationery Co., Mobile, Ala., of Jan. 3, 1910, to the Davids Ink Co., New York, N. Y.; one of the Citizens Coal Company, 555 West 55th St., New York, Nov. 13th, 1908, to the Davids Ink Co.; an order of the Eagle Book Store, Reading, Pa., to Davids Ink Co., of Dec. 4th, 1908, and an order of Hunter & Finck, of Galveston, Texas, May 28th, 1908, directed to Mr. Williams, Davids Ink Co., New York, N. Y. Please examine these various letters to the Davids Ink Co., and state of such of them as you can, from personal knowledge, whether their contents refer to goods peculiar to the Thaddeus Davids Co. or not, and whether such orders were received in due course, by said company on or about their respective dates?

Counsel for Defendant objects to the question as immaterial.

A. The order for the Morey Stationery Co. was received by us and the goods shipped. The order calls for goods manufactured by us, two of the items being for our Oriental Carmine Ink, a brand we have catalogued and sold for years. The order from J. Geo. Hintz was received by us and filled; this order calls for goods sold or manufactured by us. One of the items for two dozen empty pint bottles is a re-order. This party gives him this for. The order for the Mobile Stationery Co. was received and filled by us. This order is for 5 gross of Davids General Mucilage, a brand that we have catalogued and sold for a great number of years. The Citizens Coal Co.—this letter was received by us and I am not familiar with the contents. The Eagle Book Store order was received by us and filled. This order is for a line of stamp pads which we sell. The order from Hunter & Finck was received by us and filled. This order is for Security Mucilage, Oriental Carmine Ink and No. 8 Express wax.

All of these items we have catalogued and sold for years.

40 Q. 16. There seems to be among the papers you brought this morning from your files six orders directed to the Thaddeus Davids Ink Co. Is that correct?

A. Some of these six are orders and some are letters.

Q. 17. There seem also to be two orders and one letter directed to the T. Davids Ink Co. Is that correct?

A. Yes, that is correct.

Q. 18. There also seem to be two orders—that is, one order and one letter—directed to the Thaddeus Davids Mfg. Co.—one dated June 14th, 1910, and the other dated Dec. 29th, 1908. Can you

tell from their contents whether those two papers were intended for the Thaddeus Davids Co.?

Counsel for defendant objects as calling for secondary evidence.

A. Yes. Both of them have the word "Thaddeus" with the abbreviation before the name and the order of June 14th, calling for Magic Black Ink—a brand we have catalogued and sold for years.

Counsel for complainant offers in evidence the orders identified by the witness in Answer 15, the same to be marked Complainant's Exhibit Davids Ink Co. orders.

Q. 19. Have you brought with you some of the labels which go on the back of the bottle of ink and sold by the Thaddeus Davids Co., in addition to the labels heretofore produced as going on the front of the bottle; if so, please state what they are?

A. I have brought two different labels; these labels are pasted on the reverse side of some of the bottles of the labels shown before. The round label has been in use for a number of years. The square label has also been in use for a number of years. The round
41 label applies to the Record, the Combined and the U. S. Copying Ink, and the square label applies to Electro Chemical Writing Fluid.

Counsel for complainant offers in evidence the two labels just produced by the witness, to be marked Complainant's Exhibit Round Label and Complainant's Exhibit Square Label.

Direct examination closed.

Cross-examination by Mr. NEWELL:

X Q. 20. What does J. Geo. Hintz use the empty glass bottles for? Which are referred to in the order of May 13th, 1908?

A. I have been told that he bottles a line of his own typewriting oil. And having no bottles of his own, we accommodate him by selling him some of our bottles.

X Q. 21. Are you accustomed to sell him bottles in this way?

A. Not myself personally, but the company does.

X Q. 22. These are ordinary glass bottles without any labels on them, aren't they, when they leave your place of business?

A. As far as I know they have no labels, but have our design patent stamped on the bottom of them.

X Q. 23. W. F. Murray of Ann Street, New York, has been a customer of the complainant for a good while, has he not?

A. He has.

X Q. 24. All you know about the alleged confusion in the trade of the Thaddeus Davids Co., and in regard to which you gave some instances, were known to you solely by what the people told you, were they not?

A. They were.

X Q. 25. You knew nothing about it yourself personally, did you?

A. All I know about the confusion is what was told me and what I saw in the mail.

42 X Q. 26. And you have testified in this respect, only from what they told you, you of course believing that they told the truth. Is that correct?

A. That is correct.

X Q. 27. The complainant company (Thaddeus Davids Co.) has had its office at 95-97 Vandam St., New York City, for the last three or four years, hasn't it?

A. It has.

X Q. 28. The complainant puts out an ink which they call "Electro-Chemical Writing Fluid," the label of which you have already referred to, and they have been putting this on the market for a great many years, haven't they?

A. They have.

X Q. 29. Is any electricity used in the manufacture of this ink, or in connection therewith?

A. I am the New York City salesman and am not familiar of the details of the manufacture of our goods.

X Q. 30. Then you don't know how this ink is manufactured?

A. I know some of the ingredients. These we publish in our advertising matter, but as far as the details of the manufacture, I don't know.

X Q. 31. What chemicals are used in this manufacture, or are there any at all?

A. I have been told by the president of our company that this ink contains nutgalls and iron. This fact we published on this circular which is distributed all over the country by the stationer.

X Q. 32. The ingredients of practically all of your inks are similarly published?

A. They are not.

X Q. 33. Is this the only one that is?

A. As far as I know, it is.

X Q. 34. A large proportion of the goods mentioned in the
43 orders, letters, etc., which have been introduced in evidence, call for goods which are not manufactured by the defendants, do they not?

A. Some of the orders in evidence could be filled by the Davids Mfg. Co., with their substitutes, should they receive the orders. One or two of the orders in question, I notice are for writing fluid. The customer does not state the brand, but these orders also contain other items quoted under our brand names, which we have copyrighted, which prove beyond a doubt that the order was intended for us. One of the orders that I refer to, is an order that has already been offered in evidence which we received from the Morey Stationery Co.; the first two items on this order are as follows: Two dozen quarts of writing fluid. One dozen pints of writing fluid. This order also calls for three dozen of Oriental Carmine, two dozen half pints of Oriental Carmine. Ink under this brand, we have catalogued and sold for years, and are the only manufacturers putting out such a brand.

X Q. 35. This ink which is marked "Oriental Carmine," is made by the complainant, isn't it?

A. It is made by us, yes.

X Q. 36. And your manufactory is located in this city, is it not?

A. Yes, on Vandam Street.

S. T. BUCKHAM.

Adjourned until Thursday, July 14th, 1910.

44 NEW YORK, *July 14th*, 1910.

Met pursuant to adjournment.

Present, Counsel as before.

Deposition of Oscar Woelfeld.

Direct examination by W. PREBLE, JR., of counsel for complainant, the witness being first duly sworn:

Q. 1. Please state your name, age, residence and occupation?

A. Oscar Woelfeld; age 32 years; Bay Ridge, New York; Buyer for Melchoir, Armstrong & Dessau, 116 Broad Street, New York City.

Q. 2. How long have you been a buyer for that concern?

A. I have been with the concern for about ten years, of which five as buyer.

Q. 3. Have you, during that time, bought any ink of the Thaddeus Davids Company, complainant, herein?

A. Yes.

Q. 4. In about what quantities, and how long?

A. I should say occasional orders during, say, the last three years.

Q. 5. Have you, as buyer for said firm, ever bought any of the ink of the Davids Mfg. Co., defendants?

A. No.

Q. 6. Have you run across such ink in the market or has the same been offered you at any time?

A. The Davids Mfg. Co. filled an order for ink which was intended for the Thaddeus Davids Ink Co. The goods were shipped and payment withheld in order to see whether there would be any objection from our customers for sending the other ink. Bill finally settled.

Q. 7. When you say the goods were shipped, do you mean shipped by your firm to the customer, or by the Davids Mfg. Co. to you?

45 A. The Davids Mfg. Co. shipped the goods for us in our name, abroad. Order was shipped for our account by the Davids Mfg. Co. direct to the steamer, according to our instructions, the goods not passing through our hands, and we not seeing the goods.

Q. 8. Will you please explain briefly how this order came to be

filled by the Davids Mfg. Co. I mean was it a mail order, telephone order, or an orally delivered order?

A. On June 9th, 1909, we sent an order to the Davids Ink Co., New York, by mail. This order was intended for Thaddeus Davids Co., but the order was executed by the Davids Mfg. Co.

Counsel for defendants objects to the answer as secondary evidence, and also as immaterial, as the occurrences mentioned took place long after the filing of the bill of complaint.

Q. 9. Can you produce a copy of the order referred to?

A. I can.

Counsel for complainant offers in evidence the copy of order produced by the witness, same to be marked Complainant's Exhibit M., A. and D. order.

Counsel for defendants objects to the exhibit, as secondary and as it does not appear where the order came from or how it is an alleged copy.

Counsel for complainant calls upon counsel for defendants to produce the original order of which the paper just offered in evidence is a copy.

Counsel for defendants states that this is the first notice he has had of such paper being wanted and he will instruct defendants to search for it and see if any original order can be found, without admitting the admissibility or materiality of the same.

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Q. 10. Where did you get the copy which you produce?

A. From original copy in our order book.

Counsel for defendants objects to the copy again in view of the last answer, as now admitted as being third hand evidence.

Q. 11. The order calls for two cases blue black writing Davids in large bottles, lowest possible export price. Had you previously ordered the same kind of ink of the Thaddeus Davids Co.?

A. As far as I can remember, yes.

Q. 12. How did you find out that the order had been filled by the Davids Mfg. Co., instead of by the Thaddeus Davids Co., and what did you find to be the ink supplied in filling said order?

A. If I remember correctly a bill was sent us by the Davids Mfg. Co. I don't know what kind of ink was supplied.

Cross-Examination by MR. NEWELL, without waiver of objections:

X Q. 13. Did you send this order which you have referred to?

A. I did not.

X Q. 14. Then you personally do not know for whom the order was really intended?

A. I did.

X Q. 15. Is this copy which you have produced an exact copy in every respect of the original order as it was originally sent?

A. Exactly as taken from our copy book.

X Q. 16. The order was mailed in an envelope, I suppose?

A. In an envelope.

X Q. 17. And so far as you know, this envelope might
47 have been addressed to the address of the Davids Mfg. Co., might it not?

A. As I had nothing to do with the mailing, I can't say.

X Q. 18. Do you know who made out or sent the order?

A. I made it; who sent it I don't know.

Counsel for defendants hereby objects to the entire deposition of the witness as secondary evidence and immaterial.

OSCAR WOELFELD.

NEW YORK, *August 12th*, 1910.

Met pursuant to agreement.

Present: Counsel as before.

Deposition of Stephen T. Buchanan, recalled.

Direct examination by W. P. PREBLE, Jr., of counsel for complainant:

Q. 1. Are you the same Stephen T. Buchanan who testified in this case on July 7th, 1910?

A. I am.

Q. 2. Since that date, have you found on the market any ink of the defendants', marked with a yellow label of about the size of the yellow label on your company's marking ink; if so, please produce a bottle of your marking ink with defendants' marking ink and state briefly what you know of this recent discovery?

A. I have found them, and have brought the samples with me. The bottle of ink manufactured by us and labeled Davids' Marking
Ink, I have been told by members of our company has been
48 on the market, put up with a yellow label, for over thirty-five years. The Davids Mfg. Co. have been marketing a marking ink to my knowledge for the last year and a half. I never saw any marking ink put out by the Davids Mfg. Co. with anything but a white label until two weeks ago. This I found in the stationery store of T. L. Harding of Greenwich Street. About a year ago I compiled a circular in which was described our marking ink. This circular we furnished to retail stationers in thousand lots or over so as they can distribute them to the customers. We have ourselves distributed from 25 to 50,000 of these circulars amongst the consumers. Knowing that the Davids Mfg. Co. were putting a marking ink on the market, at the time when I complied this circular I put the following lines under the description. "Insist on Davids, with the yellow label, all others are imitations." This stationer from whom I received this bottle of ink told me so that——

Defendants's counsel interrupts and strenuously objects to hearsay evidence not only on the point the witness is about to testify on, but the hearsay evidence he has given heretofore in answers, and requests counsel for complainant to instruct the witness to refrain from

statements of what he was told, and to give facts that he knows of himself.

So instructed.

he received the ink with the——

Counsel for defendants interrupts again and calls the witness's attention to the instruction which he has just received from his own counsel to refrain from statements of what he was told.

I canvassed the wholesale and retail stationers of New York pretty thoroughly and this is the first instance where I have found
49 marking ink manufactured by the Davids Mfg. Co., put up with any other colored label excepting white, and this I did not find until several months, after we had spread this circular broadcast to the retail stationer and the consumer. I have also brought with me a sample of the marking ink manufactured by the Davids Mfg. Co., showing how the style of bottle and label have been changed.

Complainant's counsel offers in evidence the three bottles of ink and the circular produced by the witness the same to be marked respectively Complainants' Marking Ink, Complainants' Yellow Label Circular, Defendants' Marking Ink, Yellow Label, and Defendants' Marking Ink, White Label.

Direct-examination closed.

Cross-examination by MR. NEWELL:

X Q. 3. You personally do not know who made or put out the ink which you have referred to as the ink with the yellow label of the Davids Mfg. Co., do you?

A. No, the only way I know is what the customers tell me, and it has the Davids Mfg. Co. label on the bottle.

The answer is objected to (except for the first word) as volunteered.

Adjourned subject to notice. Complainants' Counsel stating that he has probably closed his prima facie case, but will give formal notice to that effect later on.

S. T. BUCKHAM.

50 NEW YORK, *December 22nd*, 1910.

Evidence for Complainants in Reply.

Taken under the 67th Rule in Equity, before John A. Shields, Esq., Standing Examiner, at the office of W. P. Preble, Jr., Counsel for Complainants, at 150 Nassau Street, New York City, New York, pursuant to agreement between Counsel.

Present:

W. P. Preble, Jr., for Complainant;
Emerson R. Newell, for Defendants.

Deposition of John W. R. Merckle, a Witness Recalled by Counsel for Complainant.

Direct examination by W. P. PREBLE, Jr., of counsel for Complainant:

Q. 1. Some of the witnesses for defendants have criticized some of the statements and labels which appear in the trade price-list of the Thaddeus Davids Co., for the year 1908, which has been made an exhibit in this case. I call your attention to the Electro-Chemical Writing Fluid label on page 3, and the Davids' Oriental Carmine Ink on page 16. Also Davids' Oriental Red Ink on page 26. What meaning, if any, was intended to be conveyed to the trade by the words, "Oriental" and "Electro-chemical?"

A. Now in regard to the Electro-Chemical Writing Fluid label, I would state that the label was originally designed and named by David F. Davids, who was the eldest son of Thaddeus Davids, and, as far as I can understand, the name was simply taken for the reason that they, for a number of years, made and sold a Chemical Writing Fluid. As to the Oriental, both for carmine and red ink, this name, I understand, was taken merely as a fancy name, they having for years sold the Carmine ink, called Brilliant
51 Ink, and in order to make a distinction to the trade, they gave it its name, "Oriental." Oriental Red Ink was named a number of years before they put out Oriental Carmine.

Q. 2. I also call your attention to the label of the fountain pen ink on page 28 of the price-list, which contains the words Silk filtered, as a part of the label. Please state what you know about the use of the words Silk filtered as applied to Davids' Fountain pen ink?

A. The name Silk filtered was adopted by the concern for the reason that fountain pens were becoming in heavy demand and it required a limpid ink that would be free from glutinous matter and they started out and filtered the ink and afterward found a different process of manufacture and this silk filtered fountain pen ink is now put out perfumed.

Q. 3. Do the words "Silk filtered" appear on the label of the perfumed ink or have they been discontinued?

A. The same label is being used with an additional label put on

the bottle, mentioning the fact that it is perfumed and we also make it in all other colors besides blue black.

Q. 4. What is the difference between a scarlet ink, a carmine ink, and a red ink, as understood by the trade?

A. The brilliant carmine ink has been made for many years from a French cochineal carmine which was imported by the house for a good many years from France. The "oriental carmine," "oriental red ink" and "scarlet ink," are made from aniline colors that are made in this country.

Q. 5. Is there any difference in the color of these various inks or are they all alike?

A. There is a difference in quality, shade of color, and price.

Q. 6. Does that difference in color bear any relation to the different shades of red which appear on the label of "brilliant car-
52 mine ink" (on page 12), "Red copying carmine color" (on page 13), "oriental carmine ink" (on page 16), "brilliant scarlet ink" (on page 18), and "oriental red ink" (on page 26) of the price-list. In other words, are those differences in color which appear on the labels, accidental or intentional?

A. The color of the label has nothing to do with the shade of ink contained in the bottle. The "oriental red ink" and the "red copying ink" are about the same color, whereas the scarlet ink is somewhat lighter in color and is different from the oriental carmine ink.

Q. 7. I call your attention to the top label on page 13, Davids' Non-copying Carmine Ink. What is understood in the trade by the term non-copying?

A. It is understood in the trade by a Non-copying carmine, as an ink especially for writing and ruling where a copy is not required. This ink is made especially light for that purpose, and the name non-copying is used by all other manufacturers, such as Stafford, Carter, Sanford and others.

Q. 8. According to the price-list, pages 3 and 7, you sell the electro-chemical writing fluid at $9.00 per dozen quarts, and the chemical writing fluid at $7.50 per dozen quarts. Why is there such a difference in the price of the two inks?

A. The reason for the difference in price, we figure that our chemical writing fluid does not cost as much to manufacture as the electro-chemical writing fluid.

Q. 9. One of the witnesses, called by defendants, testifies that the greater part of all writing ink is water, is that correct?

A. It is.

Q. 10. Which contains more water, the "electro-chemical" or the "chemical"?

A. Naturally if a person bought 5 gallons of ink, it would have to contain nearly 5 gallons of water, with other acids and
53 chemicals, which are the expensive parts in the manufacture of ink. The "electro-chemical" writing ink contains more of the expensive material than the "chemical."

Q. 11. Do you mean that the two inks referred to, "electro-chemical" and "chemical," contain the same expensive materials, or do you mean that the expensive materials are of a different kind?

A. They are of the same nature.

Q. 12. What is generally understood in the trade, by the term "Gum Arabic" as used in the preparation of mucilage?

A. As far as I could understand it, our house, Thaddeus Davids Co., some years ago, made a purchase of somewhere from 50 to 100 cases that were sold to them as "Gum Arabic" from a concern called Parke Davis & Co. of New York and after the goods were delivered, so I have been told by David F. Davids, he discovered that it was a gum such as he could not use in the manufacture of their "Extra Adhesive mucilage." He refused payment of this particular lot of gum, and Parke Davis & Co., brought suit for the money and the case was carried into some court in New York and I was told by David F. Davids that the gum that he purchased was a gum senegal. And the courts finally decided that any gum that was soluble in water, and had adhesive qualities could be termed "Gum Arabic." And for that reason they immediately started out to put out their brands of mucilage called "Security" on page 29, and "General," on page 31 of the price list. The suit was finally lost and the Thaddeus Davids Co. had to pay all costs, as far as I understand it.

Counsel for defendants objects to the answer as purely hearsay, as admittedly not in the knowledge of the witness, and therefore grossly secondary evidence.

54 Q. 13. Was this Parke Davis suit against the Thaddeus Davids Co. before you entered the employ of the Thaddeus Davids Co. or afterwards?

A. It was during my time of employment by them.

Q. 14. How many years ago?

A. Over twenty.

Q. 15. Have you made a search to find the records of that case recently at my request, and if so, with what result?

A. I have, but with no result as yet. I cannot locate the Law firm, but hope to find them very shortly.

Q. 16. You mean the law firm which represented the Thaddeus Davids Co. in that suit?

A. I do.

Q. 17. Have you looked up in any standard publication of the drug trade, the definition of "Gum Arabic," if so, will you please produce a copy of what you found therein?

A. I submit herewith data taken from the U. S. Dispensatory, handed to me by the National Analine & Chemical Co., 100 William Street, N. Y. City, which I wish to go in as evidence.

Q. 18. What can you tell us about the publication of this "U. S. Dispensatory." Is it a book or pamphlet, and if so, when was it published and where?

A. I understand it is a publication gotten out by the United States Government in book form.

Q. 19. You mean as an official publication?

A. As an official publication. I cannot give the date.

Complainant's counsel offers in evidence, the paper produced by

the witness, subject to subsequent proof, as to the date and character of the publication and the correctness of extract submitted, the same to be marked Complainant's Exhibit Definition of Gum Arabic.

55 Q. 20. Has the Thaddeus Davids Co., to your knowledge, ever received complaints from customers as to the character or quality of the gum used in your "General" and "Security" mucilage?

A. Not to my knowledge.

Q. 21. According to this extract which you have produced, the "Gum Ghatti," when rubbed up with three parts of distilled water and strained, is superior in its adhesive power to "Gum Arabic." Have you found that to be the case?

A. I have in many instances.

Q. 22. How do the prices of "Gum Arabic," "Gum Gedda" and "Gum Ghatti" compare?

A. Egyptian "Gum Arabic" has for the past several years been at a lower figure than "Gum Ghatti." "Gum Gedda" is not used in the manufacture of mucilage to my knowledge.

Q. 23. Some of the witnesses for the defendants have testified that the Thaddeus Davids Co. used "Gum Gedda" as well as "Gum Ghatti" in its "Security" and "General" mucilage?

A. That is incorrect. We don't use any "Gedda" in mucilage.

Q. 24. What can you tell us about the sale on the New York market of ink bearing labels containing the name "Emry Davis," and can you produce some of the labels so used?

A. We have manufactured for a number of years the writing fluid sold by Emry Davis. We originally bottled it for him, but now he buys it in bulk and bottles it himself. I produce three labels, each of which we used on his bottles, when we bottled the goods for him. One is for Copying ink, one for Carmine ink and one for writing fluid. He may not be using the same style label at the present time.

Q. 25. Has the Thaddeus Davids Co. ever authorized Emry Davis to use any label which might lead the public to mistake his ink for your own ink, as put on the market under your own label?

56 A. The label that was originally used by him would not in any way conflict with any goods that we ever put on the market under our own label. We never authorized him to use any label that would conflict.

Q. 26. Have you any knowledge that he has used any such label as would conflict with yours?

A. I have not.

Complainant's counsel offers in evidence the three labels produced by the witness, and the same are marked Complainant's exhibits Emry Davis Carmine, Copying and Writing Fluid labels respectively.

Q. 27. What personal knowledge have you, as President of the Thaddeus Davids Co., or otherwise, of the sale upon the New York market of ink, bottled like the specimen now shown you, marked Defendants' Exhibit Davis Ink Co. Label?

A. I have heard of many complaints entered our office on account of this particular individual who has been going around New York

for a number of years selling this fake ink, at 25 cents per bottle, some of the purchasers believing that they were going to get Davids' ink, and when they received the bottle, complained to us, of being defrauded. He sells this at 25 cents, and where he gets the money in advance, the purchaser gets nothing. I know of a time, that our firm sampled the New York Exchange Bldg., and found anywhere from 100 to 150 who were let in on this fake proposition. Our company, the Thaddeus Davids Co., have complained to Police Headquarters several times in order to hunt up this Davis Ink Co. man in order to stop him putting out the goods. Notices have appeared in several New York daily papers, calling attention of the consumer to be on the lookout for this particular fakir. We can produce notices from these several papers, if necessary. In fact, he
57 called on a particular friend of mine, and stated that he was soliciting orders for a quart of David's celebrated ink at 25 cents in order to introduce it. My friend ordered a bottle, and met me about a week afterwards, and told me that the ink that he bought was no good and he was surprised that a concern like ours would put out any such stuff. I told him that it certainly must be some error and I would stop at his office and look at the bottle; I then found it to be of the so-called ink, manufactured or at least put out by the Davis Ink Co.

Q. 28. You mean like the exhibit?

A. Yes.

Q. 29. What steps, if any, except merely complaining to the police, did the Thaddeus Davids Co. take to try to catch this impostor, and with what result?

A. Besides having the N. Y. Police Dept. on the lookout for him we have sent our own representatives around New York, in order to try and catch him, and up to date it has been impossible for us to lay our hands on him.

Cross-examination by Mr. NEWELL:

X Q. 30. I thoroughly agree with you that this alleged "David's Ink Co." is imposing on the public in the quality of the ink. The Thaddeus Davids Co. wants to protect the public from having such poor quality of ink sold, and this is what they objected to; but they do not object to the mere name "Davis" at the top of the label, with the word "ink" near the middle of the label, and the words "Davis Ink Co." at the bottom of the label, or do they object to all this?

A. Object to all of it.

X Q. 31. Why?

A. For the reason that this party is representing himself as selling Davids' ink, and we hardly believe there is any such man
58 making that particular ink by that name.

X Q. 32. You said that your company had received several complaints in regard to this "Davis Ink." Did you mean that when the people that made the complaints bought the ink with that label on it they thought they were buying the Thaddeus Davids Co.'s ink?

A. Yes, so they have told us verbally as well as in writing.

X Q. 33. What reason have they to think so? The word "Davis" couldn't be mistaken for "Davids," could it?

A. Seems they were on account of the similarity of the name, and our concern having been in business so many years our brand became popular.

X Q. 34. Do you mean to say that, in your opinion, the ordinary purchaser who has been familiar with "Davids" inks and labels would be deceived by the words "Davis" into purchasing this fake ink for yours?

A. It appears they are doing so right along, for we are still getting their complaints.

X Q. 35. Then your answer to the preceding question is "Yes?"

A. Yes.

X Q. 36. Then you think that the word "Davis" is substantially the same as the trade-mark "Davids?" Is that what you mean?

A. Yes, I do.

Adjourned for lunch.

X Q. 37. In regard to the "Electro-Chemical" writing fluid, there is no electricity in this, is there?

A. There is not.

X Q. 38. There is no electricity used upon it, in its process of manufacture, is there?

59 A. No, sir.

X Q. 39. You said that the complainant adopted this term to distinguish this particular ink. Why did you adopt the word "Electro" and the representation of thunder clouds and lightning which also appear on the label?

A. As a trade-mark to distinguish one from the other.

X Q. 40. That was the entire reason for adopting those features?

A. To the best of my knowledge and belief, it was.

X Q. 41. The ingredients of the "Electro-chemical" ink and the "Chemical writing fluid" are the same, are they not?

A. They are similar.

X Q. 42. Aren't they the same?

A. They are not.

X Q. 43. Please state what difference there is?

A. Not the same strength.

X Q. 44. In other words, the ingredients are the same, but not of the same strength. Is that correct?

A. That is correct.

X Q. 46. The "Chemical writing fluid," as seen by the price-list, is sold at $7.50 per dozen quarts, and the "Electro-Chemical writing fluid" at $9.00 per dozen quarts. You have said that the chemical ingredients were the expensive part. You have also said that the "Electro-chemical writing fluid" had the stronger ingredients. I presume this is the reason you have to charge more for that ink?

A. Correct.

X Q. 47. Now, Mr. Merckle, is it not a fact, that except for the strength of the ingredients, the "Electro-chemical writing fluid" and the "Chemical writing fluid," are the same.

A. That is correct.

X Q. 48. If I understand you correctly, your "Oriental
60 Carmine Ink" is made of a aniline dye, is that correct.

A. Correct.

X Q. 49. And made in the city of New York?

A. Yes.

X Q. 50. What is, what is known in the trade as "Carmine"?

A. As far as I know, when we made our original Carmine ink they used the French Cochineal Carmine, which was extracted from the Cochineal bug.

X Q. 51. "Carmine," then, is an extract from the Cochineal bug, which is a red extract, is it not?

A. It is.

X Q. 52. This is what you mean in the price-list, when you state on page 12, in regard to the "Brilliant Carmine Ink," that it is "made from extra chemically pure French Carmine." Is that correct?

A. That is correct.

X Q. 53. Your price-list also, on page 12, states that this genuine French Carmine ink "Does not fade out as do other so called Carmine inks." I suppose that this ink will not fade out because it is made of the genuine Carmine; is that correct?

A. As far as I know that is correct.

X Q. 54. The genuine carmine make- a much better ink, so far as its fading qualities are concerned, than aniline dye inks, does it not?

A. As far as I know it does.

X Q. 55. You believe it does, don't you?

A. Yes, I do.

X Q. 56. The word "Copying" on the labels shown on pages 4, 5 and 6, of the price-list, means that the inks will produce copies, for example, letter press or other copies, does it not?

A. It does.

X Q. 57. And these inks shown on those labels, will do so, will they not?

A. They will.

61 X Q. 58. Will your so-called "Non-Copying Carmine ink" shown on the top of page 13, produce letter press copies?

A. It will.

X Q. 59. If I understand you correctly, this ink and also the "Oriental Carmine Ink," shown on page 16, are both made of Aniline colors or dyes, are they not?

A. That is correct.

X Q. 60. "Oriental red ink" shown on page 16, is made in New York City, and from Aniline dye, is it not?

A. Yes.

X Q. 61. Does the word "Oriental" mean anything in regard to these inks, or is it just a catch word which you adopted to distinguish?

A. It's a trade name.

Q. 62. That is all?

A. That is all.

X Q. 63. If I understand you correctly, the complainant company did at one time, several years ago, filter its fountain pen ink through silk, but that it had not done so for some time. Is that correct?

A. That is correct.

X Q. 65. Because silk is so fine, it would produce an ink much more free from particles held in suspension therein, if the ink were filtered through it than would be produced if it were not so filtered. That is correct, isn't it?

A. Yes under our old process of manufacture.

X Q. 66. And even under your new process of manufacture, if there was any sediment, or matter held in suspension in the ink, filtering it through silk would produce a better ink for fountain pen use, because it is desirable to have a limpid freely flowing ink in fountain pens. That is correct, isn't it?

A. That is correct.

X Q. 67. If I understood you correctly, the complainant
62 company stopped silk filtering fountain pen ink some seven years ago, and that it has been using the same label ever since. Is that correct.

A. That is about correct.

X Q 68. The mucilage shown on page 30 of the price list is made from pure Egyptian Gum Arabic, and the mucilages shown on page 29, 31 and 32 are made from Gum Ghatti?

A. That is correct.

Cross-examination closed.

Redirect examination by W. P. PREBLE, JR.

R. D. Q. 69. Can you state more definitely, from what book the extract which was put in this morning, by you, was taken?

A. Yes. United States Dispensatory, 18th edition, published in 1899, by J. B. Lippincott Company, Philadelphia, article Acacia on pages 3 to 10.

JOHN W. R. MERCKLE.

Deposition of Louis E. Williamson, a recalled witness.

Direct-examination by Mr. PREBLE, of Counsel for Complainant:

Q. 1. Have you been present and heard the testimony which has been given to-day as to the labels of the Thaddeus Davids Co., used on their inks and mucilages?

A. I was present and heard the testimony.

Q. 2. Please tell us briefly, from your long connection with that company, what the trade names or advertising words "Electro-chemical," "Oriental," "Silk-filtered," "Carmine" and "Non-copying" were intended to convey to purchasers and the ink trade in general.

Objected to by Counsel for defendant as immaterial what the intention was.

63 A. Because the quality of the goods had become so well known throughout the world that they have a great value.

Q. 3. Was the word "Electro" intended to convey the idea that electricity was used in the preparation of the writing fluid, or that the writing fluid had any electrical properties?

A. No. It was simply done to have a different name from any other on the market.

Q. 4. How about the word "Oriental?" Was that intended to convey the idea that the ink was made in the Orient and not in New York City?

Same objection of immateriality, and this objection is understood to continue to any question as to the intention, although not re-repeated after any question.

A. It was not. It is simply another name to distinguish that particular brand from a great many others which we manufacture.

Q. 5. As I understnd it, there was a time when the Thaddeus Davids Co., actually filtered its fountain pen ink, with silk and afterwards gave that up. Is that correct?

A. It is, for this reason. We first filtered it through silk. We afterwards discovered a process that we could get better results from and we are now using this new process, and have for a number of years.

Q. 6. Do you claim that the fountain pen ink which you are now selling under the old label, of page 28, as silk filtered, is better than the fountain pen ink which you previously made, and which was actually silk filtered?

A. I do.

Q. 7. Do you know of any other manufacturers of ink who have designated their ink as silk filtered?

A. I never have heard of one, and I think I know all of the ink manufacturers in the country.

64 Q. 8. Have there, to your knowledge, been any complaints to the Thaddeus Davids Co., in regard to the fountain pen ink on the ground that it was not actually silk filtered?

A. There never was such a complaint.

Q. 9. Do you know whether purchasers and users of "Red inks," understand the word "Carmine" as referring to the shade of red or to the substance from which the red color is derived?

Same objection as calling for hearsay evidence solely.

A. That is a hard question to answer because there are many people who do know the difference, for that reason we call our inks by the different titles, such as "Brilliant Carmine," "Oriental Carmine," "Oriental Red" and "Scarlet Ink."

Q. 10. As a matter of fact, are the various Red inks which you sell as "Brilliant Carmine," "Non-copying," "Red Copying, Carmine Color," "Oriental Carmine," and "Oriental Red," all the same shade or different shades of red?

A. They are of different shades.

Q. 11. What is meant by the expression which occurs in this price-list, with regard to many of your inks, that they will not "Offset"?

A. Where we say, they will not offset, it means the ink is made so that when the writing dries, and the book is closed it would not appear on the other side of the page.

Q. 12. You mean do you, that it will not reproduce a reversed image on the page which comes against it as is the case with old-fashioned printed books?

A. Yes, that is just what I mean.

Q. 13. Then, if I understand you to say an ink will not offset, is not the same as saying that it will not copy?

A. By saying that it copies, I understand that to mean
65 that the reproduction will be readable, but to say it will not offset that would simply mean that it wouldn't appear on the opposite page.

Q. 13½. Please explain, briefly, why for some writing a copying ink is preferred, and for other writing a non-copying ink is preferred.

A. When a copying ink is preferred the person using it wants to copy his letters; when he uses it to write in books he doesn't want an ink that will copy.

Q. 14. Do you mean that a copying ink has a heavier body than a non-copying ink?

A. I do.

Q. 15. And is it the fact that a copying ink like your United States Copying Ink, on page 5 of the price list from which you state "more than twenty copies are procured from the first writing," requires a heavier body than your Combined Writing and Copying Ink, of page 4, which you recommend "where two or three press copies are required"?

A. A much heavier body.

Q. 16. Is it the fact that writing ink consists, broadly speaking, of a large amount of water and a small amount of coloring matter, soluble in said water, and that the act of writing consists in depositing, by the aid of the water, this coloring matter, which then dries by evaporation?

A. There is more than coloring matter and water in the manufacturing of ink, but when writing with ink made by the Thaddeus Davids Co., the coloring matter, after the writing is dry, evaporates, and the ink becomes oxidized and is then permanent. I'm talking about black inks only.

Q. 17. Please state briefly what your personal experience has been with the use of mucilage of the various acacia gums known as "Gum Arabic" or "Turkey Gum," "Gum Gedda," "Gum Ghatti," an "Gum Senegal"?

A. I have nothing to do with the manufacture dep't. That
66 is, I do not manufacture any of the goods. But have sold the Thaddeus Davids Co.'s mucilage for a good many years with good satisfaction, all over the country.

Q. 18. What personal knowledge have you as to the appearance

in New York of the so-called Davis Ink Co. ink and the attempts, if any, by the Thaddeus Davids Co. to stop it and catch the seller?

A. As sales manager of the company I hear the reports of the salesmen, and a number of our men have reported to me that there were some persons representing themselves as representing the oldest ink house in the country, and that they would give a quart bottle of ink away if the receiver would pay a charge of 25 cents, which would cover the freight for delivery. And a number of people had received a bottle of so-called ink put up in the secondhand Hunyadi Janos mineral water bottles, and people, thinking they were getting Thaddeus Davids's ink, readily agreed to accept the quart and pay the charges. Then we received lots of complaints by 'phone and letters, stating that they had a bottle of our ink which was no good. Invariably in looking up these complaints, we found that the ink so bought was an ink put up by somebody calling themselves the "Davis" Ink Co. We got the N. Y. Police Dept. to put detectives on the swindler's track, but have not succeeded to catch them. These facts were published by the Davids' people to warn the people in general against buying this humbug.

Adjourned until Friday, December 23rd, 1910.

NEW YORK, *Dec.* 23, 1910.

Cross-examination by Mr. NEWELL:

X Q. 19. Do you agree with Mr. Merkle's statements that "Red" ink made from genuine Carmine will not fade out as do other
67 red inks not so made?

A. I have no positive knowledge that all other red inks will fade.

X Q. 20. Well, red ink made from genuine carmine will hold its color better than inks made from aniline dyes. That is correct, is it not?

A. I couldn't answer that positive

X Q. 21. You believe it will, don't you?

A. I think it will last better. For this reason, in years past there was a large demand for genuine Carmine ink; but of later years the general public demanded brighter ink, therefore the large increase of the aniline colored ink.

X Q. 22. Do you agree with Mr. Merkle's statement that genuine Carmine is an extract made from the Cochineal bug?

A. I have been told by our chemist that it was so.

X Q. 23. Do you mean the chemist of your factory?

A. Yes; but he is now dead. I refer to Mr. Edwin Davids.

X Q. 24. You are the sales manager of the Thaddeus Davids Co. and direct the salesmen all over the country. Is that right?

A. Yes.

X Q. 25. Have you also yourself personally acted as salesman?

A. I have for almost twenty-five years. I do sell goods occasionally now.

X Q. 26. Do you ever make it a point in talking to the customer

that your carmine ink shown on page 12 of your price list is made of genuine Carmine?

A. Yes.

X Q. 27. And do you also state that this is offering a better ink?

A. No, sir; but for some purposes, I do.

X Q. 28. Do you always tell the customer that the "Non-copying" and "Oriental" inks are made from aniline colors?

A. If I am asked.

68 X Q. 29. But not otherwise?

A. I don't tell the customers what any ink is made of unless asked.

X Q. 30. As far as you know, these last two inks I have mentioned, the "Non-copying" and the "Oriental," are made from aniline color, are they not?

A. As far as I know.

X Q. 31. An aniline color is much less expensive than a genuine Carmine, isn't it?

A. I don't know.

X Q. 32. What is your belief on the subject?

A. I believe they are.

X Q. 33. Did you ever purchase any "Oriental" rugs?

A. Imitations, I guess. That's all out of the question.

X Q. 34. If you went in to purchase an "Oriental" rug and the salesman showed you one and told you it was an oriental rug, and you purchased it and afterwards found that it was made right here in New York, would you be perfectly satisfied, or would you not?

A. If I were to go to purchase an Oriental rug, I would naturally ask the question, is this made in the Orient? I would then know whether it was made in the Orient or in New York.

X Q. 35. And if the salesman said that it was really an Oriental rug, you would then understand that it was made in the Orient, wouldn't you?

A. I would naturally suppose he was telling the truth.

X Q. 36. In other words, if the salesman guaranteed that it was an oriental rug, you would believe he was telling the truth that it was made in the Orient—for example, Asia, or somewhere around there? That is correct, is it not?

A. Hardly, for if I was buying an oriental rug, I should

69 surely make it a point to find out whether it was made in Orient or in the domestic market.

X Q. 37. Do you know the National Aniline & Chemical Co. of 100 William St.?

A. I know of them.

X Q. 38. Are they the parties from whom your house purchases its aniline colors?

A. I know we purchase some things: whether it is aniline colors, I don't know.

X Q. 39. So far as you know, that is a fact, is it not?

A. No. As I know we buy aniline colors from other houses.

X Q. 40. Then if I understand you correctly, your house pur-

chases aniline dyes from, probably, half a dozen houses in New York City, from one time to another?

A. Yes, from more than the National Aniline & Chemical Co.

X Q. 41. Do you tell your customers that your fountain pen ink is not filtered through silk?

A. I would if they asked me.

X Q. 42. But not unless they asked you?

A. No, because the word "Silk filtered" is a sort of an established trade-mark, and in all my experience I don't know if I have ever been asked that question.

X Q. 43. How long has your house been using the fountain pen ink label shown on page 28 of the price-list?

A. To my knowledge for over five years and I think possibly ten years, and perhaps longer than that.

X Q. 44. The "Electro-Chemical Writing Fluid" and the "Chemical Writing Fluid" are used for the same class of writing, but the "Electro-Chemical" is a better ink in your opinion?

A. I don't know if they are used for the same class of
70 writing, but the "Electro-Chemical Fluid" is a better ink than the "Chemical Writing Fluid."

X Q. 45. Do you ever make it a point with your customers, that your mucilage, which on page 30 of the price-list is termed "Extra Adhesive," is made from genuine "Gum Arabic"?

A. I never used the word genuine "Gum Arabic," but when I do speak on this subject, I call it the "Best grade of Gum Arabic."

X Q. 46. Do you agree or disagree with Mr. Merckle's statement that the ordinary purchaser could be deceived by the "Davis Ink Co." label into thinking that he was purchasing your ink, because the name "Davis" is substantially the same as "Davids"?

A. I know of my own knowledge that there are hundreds of people in and around New York who have bought the Davis' ink, thinking that they were going to get a bottle of Davids' ink.

X Q. 47. Then your answer to the preceding question is substantially * * * I agree?

A. I fully agree with Mr. Merckle on this subject.

X Q. 48. Have you ever known any one to be actually so deceived by the similarity of the name?

A. Lots of them.

X Q. 49. And they have come to you or communicated to you and complained, and were very much surprised to find that you showed them that it was not the Thaddeus Davids Co.'s ink?

A. Yes.

X Q. 50. What do consider to be the trade-mark of the Thaddeus Davids Co. Is it the word "Davids," or the words "Thaddeus Davids Co."?

A. The word "Davids," because invariably all over the country people say, in buying or speaking of our goods, "Give me so many quarts of 'Davids' ink," or "Here comes 'Davids' man."

Cross-examination closed.

71 Redirect-examination by Mr. PREBLE:

R. D. Q. 51. Have you visited the city of St. Louis, Mo., more or less frequently during the last five or six years?

A. I have visited St. Louis many, many times, but not so often in the last five or six years. I have been there, though, during that time.

R. D. Q. 52. Did you, on any of your visits to St. Louis, during the last five or six years, try to find the Davis Ink Co., and if so, with what result?

A. I did try to find the Davis Ink Co. during that time, but did not succeed to find them, being told by dealers there that they never heard of this concern.

L. E. WILLIAMSON.

Deposition of Gilbert L. Johnstone.

Direct-examination by Mr. PREBLE, of counsel for Complainant:

Q. 1. Please state your name, age, residence and occupation?

A. Gilbert L. Johnstone; 43 years of age; Manhasset, Long Island; Director and Eastern Sales-manager of the United States Printing Co.

Q. 2. Please state briefly to what extent you have familiarized yourself with manufacturers' labels, in various lines, and what study you have given to the question of the similarity or differences between such labels as they appear on the market and as they are printed by the United States Printing Co., especially with regard to the manufacture of inks?

A. I have been connected with the printing business for over twenty-five years. This connection has been with the above concern, the United States Printing Co. It is our policy not to
72 make colorable imitation of labels which will infringe on those adopted and used by the trade, also not to use trade-marks or names of a similar nature that are already in use by manufacturers or others which could be construed as an infringement. Invariably, the line of ink manufactures used their surname as their brand name and trade-mark for the identification of their inks and other products manufactured by them. Fancy names for distinguishing marks of their various brands, for easy identification, also for trade-mark value.

Q. 3. Has your company established a collection or record of the trade-marks and brand names which have been used and recorded in the United States to enable you to avoid printing new marks which interfere with old, and if so, about how large has that collection become?

A. It has. We have collected all the brand names that our company has printed and created from the time of its inception, and we have also secured from the United States Government, so far as we know, a complete record of all their registered brands, which combined run over one hundred thousand brand names.

Q. 4. From your experience and knowledge as to the habits and customs of ink manufacturers in this country what, in your opinion, would be the effect of a new concern starting in the business of making and selling inks, and calling itself say Thompson Ink Co. or Bryant's Mfg. Co.?

Counsel for defendant objects to the question as immaterial and irrelevant. The witness has not qualified as familiar with the ink trade in any such way as would qualify him to answer this question or questions along this line. Furthermore, if it is counsel's intention that this witness testifies — an expert in regard to any specific question of infringement, as to trade-marks, whether in issue
73 in this case or not, which may be occularly compared, objection is made to any such testimony as being entirely incompetent and immaterial to prove or tend to prove any question here in issue. Infringement of a trade-mark should, it is believed, be determined by the Court, through its own comparison—and expert testimony is incompetent along this line.

A. If such a concern or concerns started in business, where their names and trade-marks are dissimilar and fair competitive methods were employed, the result would not be harmful to the trade. But if they did use similar brand names or fancy names, that would be construed as an infringement on those in use, the harmful effect would be very great to those whom they infringed upon.

Q. 5. You have stated that invariably the line of ink manufacturers use their surname as their brand name and trade-mark for the identification of their inks and other products. If therefore a new concern should start under the name of Thompson Ink Co., would it or not, in your opinion, result in its inks being known as Thompsons' inks?

Same objection by Mr. Newell.

A. They would.

Q. 6. In your experience in printing labels for ink manufacturers, have you found any other reason for the adoption of a surname as part of the corporate name than that the inks should become known by that surname in the market?

Same objection, and this applies to the entire examination, although not repeated after each question by Mr. Newell.

A. No.

Q. 7. Please look at the various bottles now shown you, being the four samples of defendants' inks introduced as exhibits in
74 this case, and state whether or not, in your opinion, and from your knowledge of labels used in the ink trade, the labels on those bottles, would tend to make ink so sold known to customers and the public generally, as "Davids inks?"

Defendants' counsel makes the same objection for the reasons heretofore given.

A. In the ink business, I would, especially where the trade and

the consumer had not thoroughly familiarized themselves with the difference in the appearance of the label or trade-mark and brand name.

Direct-examination closed.

Cross-examination by Mr. NEWELL:

Counsel for defendants cross examines without waiver of any of the objections heretofore made. He considers that the entire deposition of the witness is incompetent for the reasons given.

X Q. 8. Your business is that of a printer of labels?

A. Yes.

X Q. 9. You are not connected with the ink business except in so far as you use ink, in your business?

A. No. That's all.

X Q. 10. Does your company print the labels used by the Thaddeus Davids Co.?

A. Some of them.

X Q. 11. Please look at defendants' exhibit "Complainant's price list" and state which of these your company has printed?

A. A portion of them.

X Q. 12. Please look at the list and identify by the pages which ones you know your company has so printed.

75 A. Page 3, pages 4, 5, 11, 13 top label, 16, 26, 28, 29, 31.

X Q. 13. For how long have your company been printing labels for the Thaddeus Davids Co.?

A. Several years.

X Q. 14. You mean five years to your own knowledge, and probably several years before that?

A. Yes.

X Q. 15. Did you ever study law?

A. No.

X Q. 16. Then, all you know about the law of trade-marks is what you think ought to be the law. Is that correct?

A. I have read several of the trade-mark laws, but never made a study of them.

X Q. 17. And this is the extent of your knowledge of trade-mark law?

A. Yes; that and common usages.

X Q. 18. Then, if I understand you correctly, you think that a trade-mark, trade-name or label infringes another merely because of the similarity of the two sufficient to cause confusion in the trade. Is that correct?

A. Yes; where they have a tendency to deceive the public.

X Q. 19. In other words, if there is a tendency to deceive the public, there must be an infringement. Is that what you mean?

A. Yes.

In view of the foregoing answers, counsel for defendants renews his objections to this deposition, as the witness obviously has erro-

neous views of the trade-mark law, and is therefore incompetent to judge of any questions of infringement.

X Q. 20. It has been the custom for a great many years for ink manufacturers to print their name or surname (such as Staf-
76 fords, Carters, etc.) at the top of the label, the word "ink" at the middle of the label, and the name of the company at the bottom of the label, has it not?

A. In some cases.

X Q. 21. In about how many cases to your knowledge?

A. In one or more cases.

X Q. 22. In four or five cases, at least, don't you think?

A. In some cases.

X Q. 23. I don't mean that every ink manufacturer does this on all of his labels. Is it not a fact that a great many manufacturers have done so on at least some of their labels for a great many years?

A. In some of their labels they have their name at the top and others have them on the bottom and other cases on other parts of the label.

X Q. 24. Then the mere fact that an ink manufacturer uses his surname at the top of his label, and the word "ink" at the middle of the label, and the name of his company at the bottom of the label would not be an infringement on any one's right in your opinion, if his name was a different one and if the general appearance of the label was also different. Is that correct.

A. That is correct.

X Q. 25. Except for the name "Davids," defendants' labels are not like any of those of the Thaddeus Davids Co., are they?

A. Of the exhibits before me, the only one that I would consider an imitation or an infringement, is the "Davids Marking Ink" label on bottle.

X Q. 26. And this only because it is yellow?

A. Yellow and the name.

X Q. 27. Which would you, as an ordinary purchaser consider the trade-mark of the Thaddeus Davids Co., the name "Davids," or the name "Thaddeus Davids Co.?"

77 A. I would consider both, one as being part of the other.

X Q. 28. I don't think you quite understood me. Take, for example, the label on page 11 of complainant's price-list. Would you consider the word "Davids" at the top of the label the trade-mark, or the words "Thaddeus Davids Co." at the bottom?

A. "Davids."

X Q. 29. Would you consider the word "Davis" to be substantially the same as the word "Davids," with reference to ink as a trade-mark?

A. Not exactly.

X Q. 30. Naturally, it is not precisely the same. But would you consider that the two were substantially alike to the eye of an ordinary purchaser, giving to it such attention as an ordinary purchaser would give in making a purchase of ink?

A. A careless purchaser might be mistaken.

X Q. 31. You think a careless purchaser, or even an ordinary one using the ordinary amount of care might be deceived by the similarity of names into purchasing the "Davis" ink, when intending to purchase "Davids" ink?

A. He is liable to.

X Q. 32. Would you think one was an infringement of the other?

A. It all depends on how the name may be constructed on the label.

X Q. 33. Then if the name "Davids" was printed in ordinary type and the name "Davis" were printed in ordinary type it would be an infringement, but if they were printed in different sorts of type, there would be no infringement. Is that what you mean?

A. No.

X Q. 34. Please explain what you do mean?

A. I can't put myself in a position of an ordinary purchaser. On account of my wide experience in the manufacture of trade-marks and brands.

78 X Q. 35. In other words, on this account, you don't feel that you are competent to view the question from the standpoint of an ordinary purchaser. Is that correct?

A. Yes, in the manner that you want me to.

X Q. 36. I don't want you to do anything except to view the question from the standpoint of an ordinary purchaser. If you are unable to give your judgment from that standpoint because of your familiarity with labels and brands, please say so, and that will end the matter. I only want to get your position.

A. I cannot put myself in the position of an ordinary purchaser.

Cross-examination closed.

G. L. JOHNSTONE.

Counsel for Defendants, in order that Counsel for Complainant may not be surprised at the hearing, gives notice that at the hearing of this cause he will urge that the Court has no jurisdiction to consider any question of unfair competition.

DAVIDS CO. v. DAVIDS, COMPLAINANT'S EXHIBIT, LETTER OF OCTOBER 19TH, 1909.

NEW YORK, *October 19th*, 1909.

Thaddeus Davids Co., 95 Van Dam St., N. Y. City.

We are remailing you a letter received by us in re your book on lettering, and beg to call attention to the fact that it is not the first time we have done this on occasions when goods which we

79 do not produce have been requested both by letter and personally request.

In this respect we do not recall a single instance of reciprocation on your part, on the contrary you have received goods plainly marked for us, also mail orders intended for us which you have

filled, only recently you received a postal order directed to us which you filled. This card came from one E. Jeantet, and we respectfully now make demand for the delivery of this card to us, before making a formal complaint to the U. S. Postal Authorities.

Whether or not you elect to do these questionable things to get business and also by untruthful statements endeavor to discredit a competitor, it will be our policy to continue as the first paragraph of this note indicates.

Respectfully,

DAVIDS MFG. CO.
C. I. D.

P. S.—We also enclose a card requesting a pint of your ink.
C. I. D.

COMPLAINANT'S EXHIBIT POSTAL NO. 1.

Davids Ink Co., 95 Van Dam St., New York City:

J. H. Fitchett, Books and Stationery, 271 Main St., Poughkeepsie, N. Y.

Send a/c N. Y. News Co., 15 Warren. 1 Practical Letterer.
J. H. FITCHETT.

80 COMPLAINANT'S EXHIBIT POSTAL NO. 2.

Mr. Thaddeus Davis, 127 William St., New York, N. Y.:

WILLIMANTIC, CONN., *Sept.* 23, 1908.

DEAR SIR: We are sending one keg, which kindly fill with Marking ink, same as usual and return by Adams Express.

From,

G. J. KIRBY CO.,
Willimantic, Conn.

COMPLAINANT'S EXHIBIT POSTAL NO. 3.

Thaddeus Davis & Co., New York, N. Y.:

CANTON, OHIO, 1/23, 1909.

Please send price of your book of "Lettering" and description To #401 Arlington Ave.

Respectfully yours,

C. E. SAINT.

COMPLAINANT'S EXHIBIT POSTAL NO. 4.

T. Davids, William St., New York, to T. Davids.

ALBANY, N. Y., 3/8, 1910.

Walker & Gibson, Wholesale Druggists:

DEAR SIR: Please send us 6 doz. Raven Mucilage.

Yours truly,

WALKER & GIBSON.

81 COMPLAINANT'S EXHIBIT, POSTAL No. 5.

Davids Ink & Mucilage Co., 90 Vandam St., N. Y. C.

4/9/10.

GENTLEMEN: Please send to #3 Orchard St. 1 Doz. Qts. Marking Ink. Mail bill and charge to our account.

Yours Very Resp.,

W. EMSLOCH & SON.

50 *W. 18th St.*

COMPLAINANT'S EXHIBIT, POSTAL No. 6.

Messrs. Thaddeus Davids Sons, 95 Vandam St., New York City.

May 17,1910.

GENTLEMEN: We received some Ink from you a week or so ago but have never received any invoice covering the same. Kindly mail at once and oblige.

Yours very truly,

L. F. HERSH & BRO.

COMPLAINANT'S EXHIBIT, ENVELOPE No. 1.

Return in 5 days to Wm. M. L. McAdams, Stationer, Lithographer, Printer, 14-16 Federal and 113-115 Congress Streets, Boston, Mass.

Thaddeus Davids Ink Co., N. Y. City.

82 COMPLAINANT'S EXHIBIT, ARTHUR MOUNTAIN & CO., ENVELOPE & INVOICE.

After 5 Days, Return to Arthur Mountain & Co., Manufacturing Stationers, 111 Liberty Street, N. Y.

Davids Mfg. Co., 95 Vandam St., N. Y. C.

(Invoice) G7126.

To T. Davids Mfg. Co., 95 Vandam St.:

Order from Arthur Mountain & Co., Manufacturing Stationers, 111 Liberty St., New York.

JUNE 30, 1910.

Please deliver 3 Gals Davids Marking Ink.

ARTHUR MOUNTAIN CO.,

EDW. J. PLUNKETT.

COMPLAINANT'S EXHIBIT, ENVELOPE No. 2.

George B. Hurd & Co., Fine Paper Makers, 425 & 427 Broome Street, New York, U. S. A.

David Ink, 95 Vandam St., City.

83 COMPLAINANT'S EXHIBIT, POSTAL NO. 7.

Davids Ink Co., New York, N. Y.:

H. A. Shepard & Co., Stationers, Blank Book Manufacturers,
50-52 Cornhill.

BOSTON, 7-6, 1910.

Send to Kimpton H. & H.
1 Doz. Violet Lettering
1 " Black " } Small bottles.— Lettering Book.

H. A. SHEPARD & CO.
Per H.

COMPLAINANT'S EXHIBIT, STOCKBRIDGE ORDER.

Stockbridge Elevator Co.

JACKSON, MICH., *June* 2, 1910.

Davids Mfg. Co., New York, N. Y.

DEAR SIRS: We use quite extensively your paste and we use it in your perfection paste jars and for these we need the small brushes which we are unable to get here. Will you kindly send us a dozen by mail along with the bill for same, and greatly oblige,

Very truly yours,

STOCKBRIDGE ELEVATOR CO.

84 COMPLAINANT'S EXHIBIT, HEBERT ORDER.

Mess. Davids Ink Co., 95-97 Vandam St., N. Y. City.

N. Y., *Mar.* 3, 1910.

Davids Ink Co., N. Y. City.

GENTLEMEN: Please deliver to Terminal Stores, 27 St. & 11th Ave., 1 Gallon Scarlet Ink and charge to account of

Mail bill to.....

WM. H. HEBERT,
334 *Produce Exchange,*
N. Y. City.

Packing Order.

W. H. Hebert, City:
1 Gal Scarlet Ink.
To Terml. Stores,
27 St. & 11th Ave.

85 COMPLAINANT'S EXHIBIT, GREEN ORDER.

Geo. W. Green, Bookseller, Stationer and Engraver,
Fine Cut Glass, Fancy Goods, and Office Supplies,
65-67 Water St., Newburgh, N. Y.

JANY. 18, 1910.

Davids & Co.

GENTLEMEN: Please send me while the weather is mild by Erie R. R.

3 Gross 2 oz. Desk Electro Fluid.
E. T. Top. Send this in bulk.
No Labels.

Yours,

G. W. GREEN.

Packing Order.

Geo. W. Green, Newburgh, N. Y.

3 Gro. 2 oz. Dsk. Electro.
No Labels E. T. cork.
Loose.

COMPLAINANT'S EXHIBIT, POLLATSHEK ORDER.

Davis Ink Co., 95 Van Dam St., City.

N. Y., *June* 29, 1910.

MR. BUCKHAM: Please send me from the new Qt. Bottles, ½ Doz. Writing Fluid.

Yours truly,
Sg. POLLATSHEK.

Packing Order.

I. Pollatshek, City.

½ Doz. Qts. Electro.

86 COMPLAINANT'S EXHIBIT, CENTRAL NEW YORK SUPPLY CO. LETTER.

Central New York Supply Co.,
Wholesalers & Jobbers,
339 Bleeker St., Utica, N. Y.

JUNE 26, 1910.

Davids Ink Co., 17 Van Dam St., N. Y.

GENTLEMEN: Kindly ship order left at your place, July 1st, West Shore Train 57.

& Oblige,

B. R.

COMPLAINANT'S EXHIBIT, DOUGLAS ORDER.

Douglas & Son,
Rubber Stamps, Badges, Stencils, Seals, Etc.
751 6th Avenue, Telephone 4393 Bryant.

NEW YORK, *Jan.* 3.

Davids Co.

DEAR SIR: Please send C. W. Gray, 50 Chapman St., Greenfield, Mass., 1 Copy "Davids Practical Letterer."
Charge to

DOUGLAS & SON.
Per D.

87 COMPLAINANT'S EXHIBIT. DAVIDS' INK CO. ORDERS.

Morey Stationery Company,
Stationers, Printers, Blank Book Makers,
40 and 42 Center Street, Brockton, Mass.

Order No. 393.

Davids Ink Co., 95-97 Vandam St., N. Y.:

Please ship by Freight to us.

DEC. 14, 1909.

2 Doz. qts. Writing Fluid.
1 Doz. pts. Writing Fluid.
3 Doz. pts. Oriental Carmine.
2 Doz. ½ Pts. Oriental Carmine.
¼ Gr. each of blue, black, purple, red and green excelsior stamping ink in ½ oz. square bottles.
1/6 Gr. 2 oz. square Davids White Ink.

MOREY STATIONER COMPANY.
By C. HOWARD ELLINWOOD.

Packing Order.

E. 710.

Morey Stat'y Co.,
Brockton, Mass.

2 Dz. qts. Electro.
1 " pts. "
3 " pts. O. Carmine.
2 " ½ pts. "
¼ Gro. ½ oz. Blue Stp. Ink.
¼ " " " Black " "
¼ " " " Violet " "
¼ " " " Red " "
¼ " " " Green " "
2 Dz. 1 oz. White Stp. Ink.

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J. George Hintz,
Stationer.

READING, PA., *May* 13, 1908.

Davis Ink Co., 125 William St., N. Y.

DEAR SIR: Please send via R. R.
2 Doz. Empty Glass Bottles. Pints.
1 " Qts. Fluid electro.
1 " " Marking Ink, Black.
Respectfully,

J. GEO. HINTZ.

Mobile Stationery Company,
Mobile, Ala.

Order No. 3986.

Date 1/3/10.

The Davis Ink Co., New York, N. Y.:

Please ship us via Mallory promptly:
5 Gro. 2 Ounce Cones Davids General Mucilage, packed 1 Doz. to the case.

MOBILE STATIONERY CO.

Packing Order.

Mobile Stat'y Co.,
Mobile, Ala.

8 Gro. 2 oz. Cones Gen'l.

The Citizens Coal Company,
(Incorporated under the Laws of New York),
Yards and Office 555 to 559 West 55th St.

NEW YORK, *Nov.* 13, 1908.

The Davids Ink Co.

GENTLEMEN: If the Bill rendered differs from this it is erroneous. The Enclosed is correct.

Per A. GRANGER.

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DEC. 4, 1908.

Order No. 1568.

M. Davids Ink Co.:

Ship to Eagle Book Store at Reading, Pa.
How ship a/c Miller Pkg. Co., 28 Howard St.
Terms: When—At once.
1 Doz. Black Ink Pad No. 0
2 " Red " " No. 0
2 " Black " " No. 1
2 " Red " " No. 1

EAGLE BOOK STORE,
Per R.

Hunter & Finck,
Manufacturing Stationers and Printers.
Galveston, Texas.

5/28-08.

Mr. Williams, Davids Ink Co., New York, N. Y.

DEAR SIR: Please ship us by Mallory Line the following:
12 Quarts Security Mucilage,
12 Pints Oriental Carmine,
12½ " " "
5 lbs. #2 Red Express Wax 4's,
5 " #2 Green " " 4's,
1 Doz. Ass't'd 1½ oz. Stamp Pad Ink ¼ Green,—
1 Doz. Ass't'd 1½ oz. Stamp Pad Ink ¼ Green, ¾ Purple.
1 " 4 oz. Oriental Carmine G. S.
Charge same to our account, and oblige,
Yours truly,

HUNTER & FINCK.

90 COMPLAINANT'S EXHIBIT M. A. & D. ORDER.

Melchoir, Armstrong & Dessau,
116 Broad Street.

NEW YORK, *June 9th*, 1909.

Order for Shipment.

Messrs. Davids Ink Co., N. Y.:

Please ship in our name at once per S. S. Caracas loading at Pier 11 B'kl'n the following goods:

Exact gross and net weight and measurement of each package to be stated in the Bill.

Separate bills required for each Mark.

Please notify us at once if goods cannot be shipped at date specified.

Bills must be delivered at our office by—the Ship's Receipt to follow as soon as possible after goods are shipped.

Marks.	Nos.	
2	4	2 Two Cases blue black Writing Davids in large bottles lowest possible export price.

M. A. D.
Janman.

Yours truly,

MELCHOIR, ARMSTRONG & DESSAU.
W.

91 COMPLAINANT'S EXHIBIT—DEFINITION OF "GUM ARABIC."

National Aniline & Chemical Co., New York.

Taken from United States Dispensatory.

Copy.

Acacia U. S. (Br.) Acacia. (Gum Arabic).

"A gummy exudation from Acacia Senegal, Willdenow (nat. Ord. Leguminosæ)" U. S. "A gummy exudation from the stem and branches of Acacia Senegal Wild., and of other species of Acacia, Wild." Br.

Acaciæ Gummi, Br.; Gum Acacia; Gummi Arabicum; Gummi Momosæ; Gomme Arabique; Fr.; Arabisches Gummi, G.; Gomma Arabica, It.; Gomma Arabiga, Sp.; Samagh Arabee, Arab.

This genus is one of those into which the old genus Mimosa of Linnæus was divided by Willdenow. The name Acacia was employed by the ancient Greeks to designate the Gum-tree of Egypt, and has been appropriately applied to the new genus in which that plant is included.

Gen. Ch. Hermaphrodite.—Calyx five-toothed. Corolla five cleft, or formed of five petals. Stamens 4-100. Pistil one. Legume bivalve. Male. Calyx five-toothed. Corolla five-cleft, or formed of five petals. Stamens 4-100. Willd.

The most important of the gum-yielding Acacias are A. vera and the official A. Senegal. A vera and A. Arabica were considered by Willdenow to be distinct species, but are now esteemed as one.

Acacia vera. Willd. Sp. Plant. iv. 1805; Hayne, Darstel. und Beschreib. x. 34. Syn. A. Arabica. Willd. Sp. Plant. iv. 1805; Hayne Darstel. und Beschrieb. x. 32; Carson Illust. of Med. Bot. i. 31.—Acacia Nilotica, Dellille, Illust. Flor. de l'Egypte, p. 79. This is a tree of middle size, with numerous scattered branches, of
92 which the younger are much bent, and covered with a reddish-brown bark. The leaves are alternate and bipinnate, with two pairs of pinnæ, of which the lower are usually furnished with ten pairs of leaflets, the upper with eight. The leaflets are very small, oblong-linear, smooth, and supported upon very short footstalks. On the common petiole is a gland between each pair of pinnæ. Both the common and partial petiole are smooth in typical specimens of A. vera, but downy in the variety A. arabica. Two sharp spines, from a quarter to half an inch long, of the color of the smaller branches, and joined together at their base, are found at the insertion of each leaf. The flowers are yellow, inodorous, small, and collected in globular heads supported upon slender peduncles which rise from the axis of the leaves in number from two to five together. The fruit is a smooth flat, two-valved legume, divided, by contractions occurring at regular intervals, into several roundish portions, each containing one seed. This species flourishes in Southern Nubia, Egypt, and Senegal, and is probably

scattered over the whole intervening portions of Africa; it is also abundant in Hindostan.

A Senegal, Willdenow; A. verek, Guillemin and Perottet, Flore de Senegambie, 1830, 246, B. & T., 1877. Mimosa Senegal, L. This is a small tree with a grayish bark, the inner layers of which are strongly fibrous, bipinnate leaves, dense spikes of small yellow flowers longer than the leaves, and broad pods 3 to 4 inches long, containing 5 or 6 seeds. It rarely exceeds 20 feet in height, forms large forests in Western Africa, north of the river Senegal, and is abundant in Eastern Africa, Kordofan, and Southern Nubia. It is known by the natives as Verek or Hashab.

Besides the species above described, the following afford considerable quantities of gum:

A. Marroo of the Cape of Good Hope, formerly considered by some as identical with A. vera; A. gummifera, seen by
93 Broussonet in Morocco near Magador; A. ehrenbergiana a schrub six or eight feet high, named in honor of the German traveller Ehrenberg, who observed it in the Deserts of Libya, and Dongola; A. seyal, growing in the same region, and also in Upper Egypt and Senegambia; A. adonsonii and A. Verek, said to contribute a portion of the Senegal gum; and A. tortillis, which attains the height of sixty feet, and inhabits Arabia Felix, Nubia, Dongola and the Libyan Desert. According to Schweinfurth, A. stenocarpa yields the brownish gum of the Soudan sometimes known as the "talen" gum, whilst gum from Gedaref and from Southern Nubia is yielded by the A. fistula. Brownish or reddish gums are also yielded by A. Nilotica, and probably by various undescribed species. A. decurrens and A. floribunma yield gum in Australia. Gum is also yielded by various trees not belonging to the genus Acacia.

The gum-bearing Acacias are all thorny or prickly trees or shrubs, calculated by nature for a dry and sandy soil, and flourishing in deserts where few other trees will grow. We are told that camels, attached to the caravans, derive from them their chief sustenance in many parts of those desolate regions in which Africa abounds. In such localities, they have a stunted growth, and present a bare, withered, and uninviting aspect; but in favorable situations as on the banks of rivers, they are often luxuriant and beautiful.

Their bark and unripe fruit contain tannic and gallic acids, and are sometimes used in tanning. An extract was formerly obtained from the immature pods of A. arabica and A. vera, by expression and inspissation. It was known to the ancients by the name of acaciæ veræ succus, and was highly praised by some of the Greek medical writers, but it is at present little used. It is a solid, heavy, shining, reddish-brown substance, of a sweetish, acidulous, styptic
taste, and soluble in water. Its virtues are probably those
94 of a mild astringent. On the continent of Europe, a preparation is said to be substituted for it called acacia nostras, obtained by expression and inspissation from the unripe fruit of Prunus spinosa, or the wild plum-tree.

The gum of the Acacias exudes spontaneously from the bark, and

hardens on exposure; but incisions are sometimes made in order to facilitate the exudation. The gum is said also to be found immediately under the bark, where it is sometimes collected in regular cavities. (Journ. de Pharm., t. xxiv. p. 321.) It is probably produced by a process of degeneration from the cellulose, and is incapable of serving further in plant-growth. It is stated by Jackson that, in Morocco, the greatest product is obtained in the driest and hottest weather, and from the most sickly trees. An elevated temperature appears to be essential; for in cooler climates, though the trees may flourish it yields no gum. According to Ehrenberg, the varieties in the characters of the gum do not depend upon difference in the species of the plant. Thus, from the same tree it will exude frothy or thick, and clear or dark-colored, and will assume, upon hardening, different shades and sizes; so that the pieces when collected, require to be assorted before being delivered into commerce. Schweinfurth and other observers state, however, that the finest gum is obtained only from the A. vera, and perhaps one or two other species.

Egyptian gums consisted chiefly of small irregular fragments, interspersed with roundish pieces of various size, and containing much of that form of gum arabic which is characterized by innumerable minute fissures, pervading its substance and impairing its transparency.

The difference in the varieties mentioned is chiefly in regard to color, the inferior gums being more yellow or reddish, and usually containing also more impurities. Since the capture of Khartoum and the closure of the Soudan, the Mahdi, Egyptian Gum has scarcely entered commerce as though a portion of the
95 product probably gets into commerce through Morocco as Mogador gum. Deddah gum of the present time, sometimes spoken of as an Egyptian gum, enters commerce through Geddah, or Jidda, on the Arabian side of the Red Sea. It seems to be the same as Mecca or El Wisch or Aden gums, which are sometimes spoken as Egyptian gums, but are probably produced in the triangular peninsula which forms the eastern extremity of Africa. These gums used to be exclusively collected at the Red Sea ports by Bombay merchants and carried to Bombay, where they were distributed, and hence have been known as Bombay or India gum. The finest specimens yield a useful mucilage, not quite so bland as that made from the best Egyptian gum. (See India Gum).

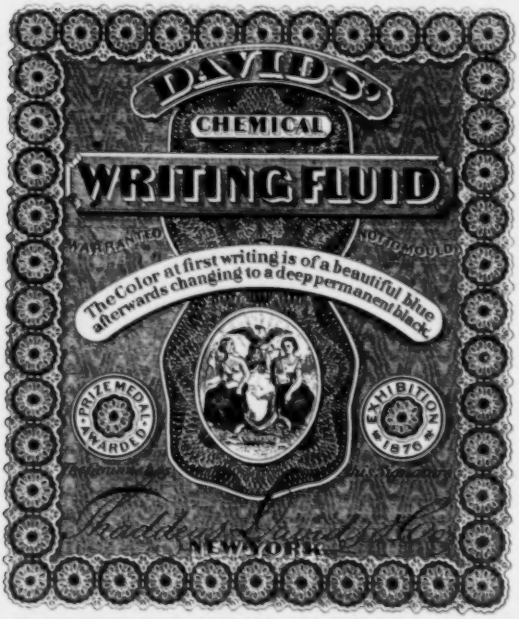
Senegal Gum.—This variety was introduced into Europe by the Dutch. The French afterwards planted a colony on the western coast of Africa, and took possession of the trade. St. Louis, at the mouth of the Senegal, and Pordentic, considerably further north, are the ports in which the commerce in gum chiefly centres. Immense forests exist in the interior containing many species of the genus Acacia, all of which are said to yield gum, as is affirmed do also various trees belonging to other genera. (Journ. de Phrm., xxiv. 318.) The chief harvest begins in October and ends in December, although gum is also collected in March. The dry winds,

which prevail after the rainy season, cause the bark to crack; the juice flows out and hardens in masses, which are often as large as a pigeon's egg, and sometimes as that of an ostrich. It is affirmed that the exudation is also largely caused by a parasitic plant, Loranthus senegalensis, the gummy exudation freely oozing out at the point where the parasite penetrates the bark. (Pharm. Centralh., Aug. 1895.) Senegal Gum is usually in roundish or oval unbroken pieces, or in straight or curled cylindrical pieces of various sizes, in the finest grades whitish, or colorless, but generally yellow-
96 ish, reddish, or brownish red. The pieces are larger than these of Turkey gum, less brittle and pulverizable, and breaking with a mort conchoidal fracture. According to L. Liebermann, Gum Senegal can be distinguished from Turkey Gum Arabic by heating the solutions for some time with potassimum Hydroxide. The Gum Senegal does not alter in color, or becomes only very faintly yellow while the Turkey gum arabic solution changes to an amber yellow color (as do solutions of dextrin). (A. J. P. 1891.)

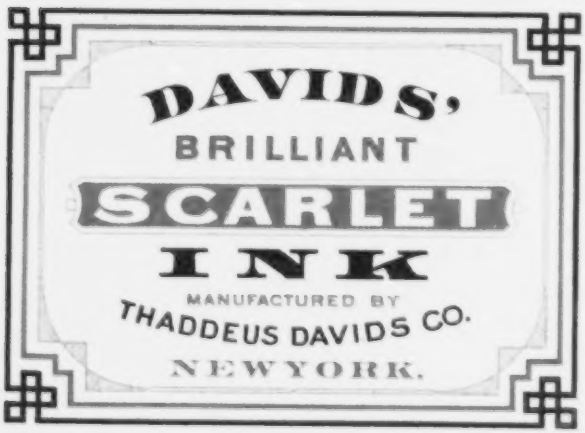
Ghatti Gum.—A pale gum consisting of rounded or vermiform pieces varying in size, clear internally, but dull and roughened on the surface, apparently caused by shrinkage in drying, from brownish-yellow to perfectly colorless and transparent. Mucilage a pale yellowish-brown semi solid mass.

Of these gums, India gums of the London market, the first four varieties yield mucilages which are so dark-colored that they cannot be used in practical pharmacy. One part of the Ghatti gum rubbed up with three parts of distilled water strained, yields a mucilage which is tasteless, odorless, colorless, and which is superior to the emulsion of Gum Arabic in its adhesive power, and even in its emulsive power, the emulsion made with it being almost of snowy whiteness. Ghatti gum would therefore seem to be thoroughly adapted for the purpose of pharmacy, and its extreme cheapness will undoubtedly give it vogue.

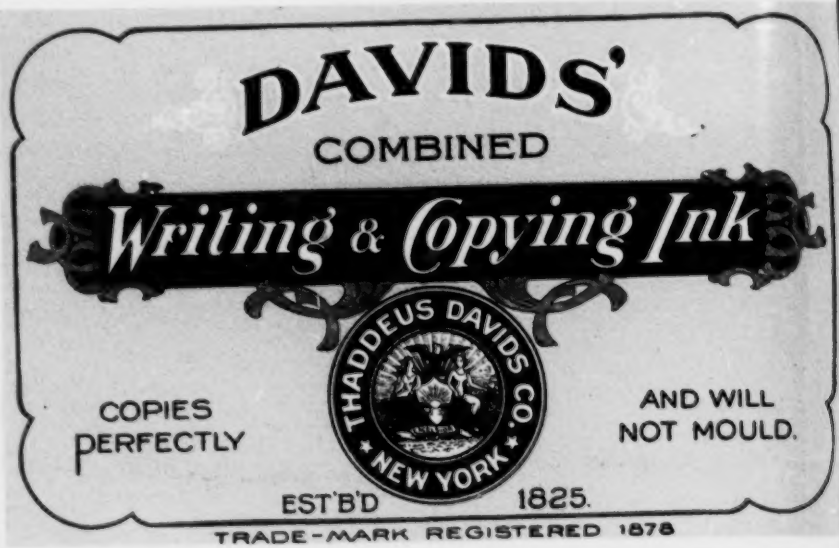
97 COMPLAINANT'S EXHIBIT SPECIMEN OF COMPLAINANT'S LABEL.



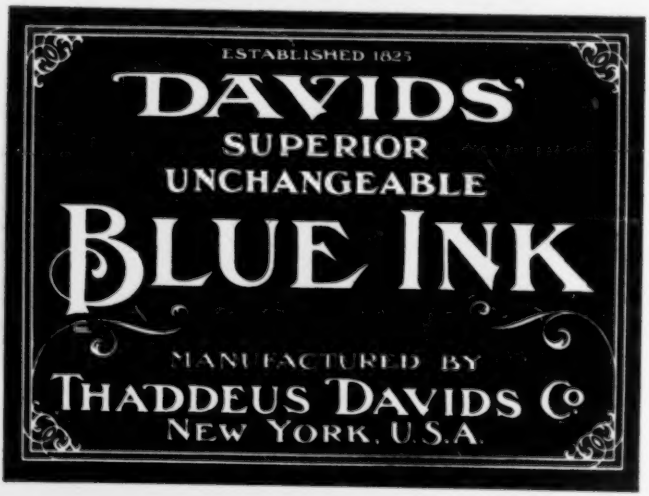
COMPLAINANT'S EXHIBIT EIGHT OTHER LABELS.

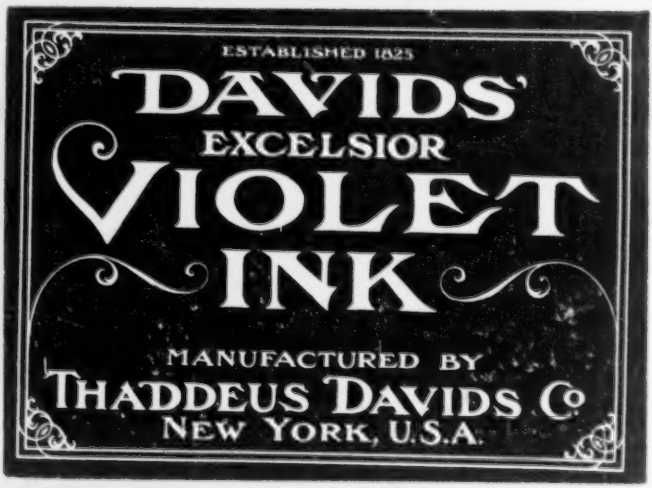


98 COMPLAINANT'S EXHIBIT EIGHT OTHER LABELS—(Continued).

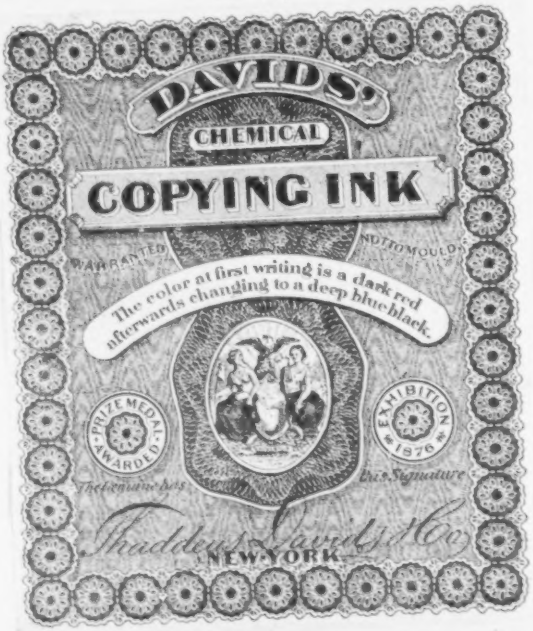


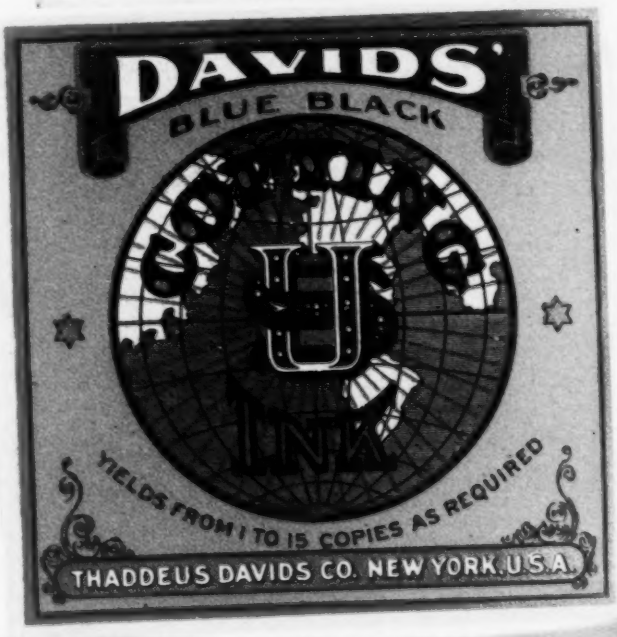
99 COMPLAINANT'S EXHIBIT EIGHT OTHER LABELS—(Continued).





100 COMPLAINANT'S EXHIBIT EIGHT OTHER LABELS—(Continued).





101 COMPLAINANT'S EXHIBIT EIGHT OTHER LABELS—(Continued).

DAVIDS'

MARKING INK

PREPARED BY

THADDEUS DAVIDS CO.,

MANUFACTURING & STATIONERS,

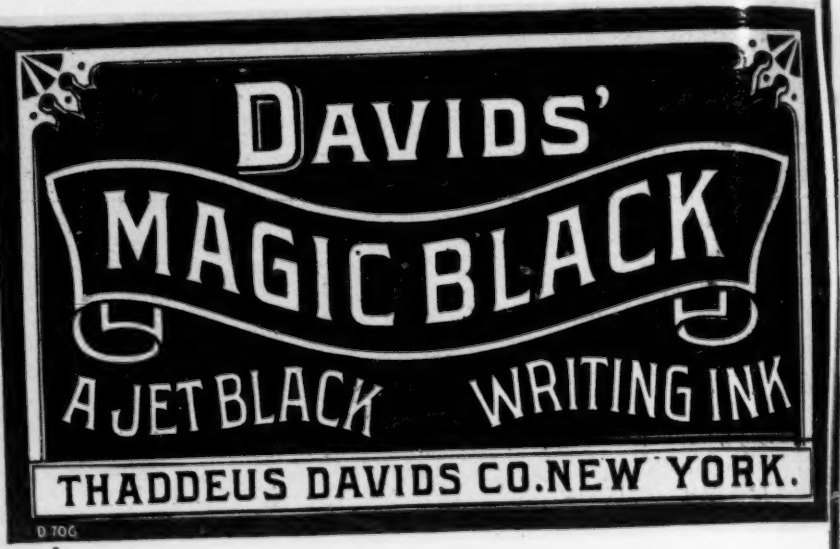
NEW YORK

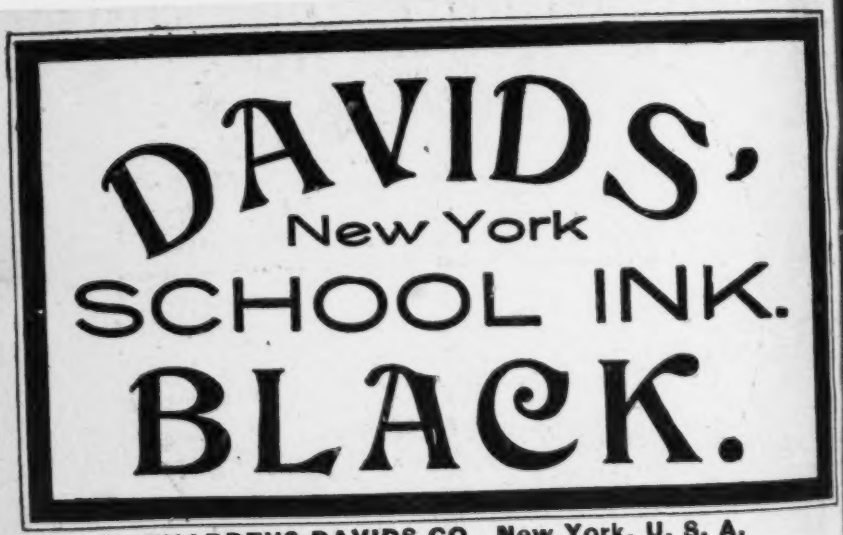
This Ink is better than turpentine, or oil and lamp-black for marking Boxes, Bales and Bundles; being cheaper, neater, and in all respects more desirable, as it will not fade, smut or rub off.

DIRECTIONS.—Use a stencil for marking bundles and smooth boxes, for bales and rough packages, a brush is best.

BEING HEAVY IT SHOULD BE SHAKEN BEFORE USING.

102 COMPLAINANT'S EXHIBIT THREE MORE RECENT LABELS.



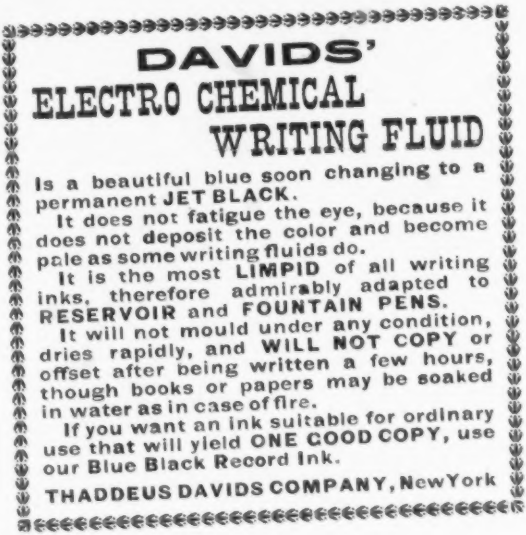


103 COMPLAINANT'S EXHIBIT THREE MORE RECENT LABELS—(Continued).

COMPLAINANT'S EXHIBIT ROUND LABEL.

DAVIDS' INKS
AN EXPERIENCE
OF 65 YEARS ENABLES
US TO PRODUCE A SERIES OF
WRITING AND COPYING INKS
WHICH FOR THE IMPORTANT ESSENTIALS OF
LIMPIDITY, CLEANLINESS, PERMANENT BLACK COLOR,
1825 AND NON-THICKENING, ARE UNEQUALLED 1890
THE "RECORD" (BLACK OR BLUE-BLACK)
IS SUPERIOR FOR BOOKKEEPING AND RESERVOIR PENS.
THE "COMBINED" WRITING AND COPYING
YIELDS GOOD COPIES AND DOES NOT OFFSET.
THE "U.S. COPYING"
IS IN EVERY RESPECT THE STRONGEST AND
BEST COPYING INK
KNOWN.
12 MEDALS AND 21 DIPLOMAS
HAVE BEEN AWARDED THE MANUFACTURERS

104 COMPLAINANT'S EXHIBIT SQUARE LABEL

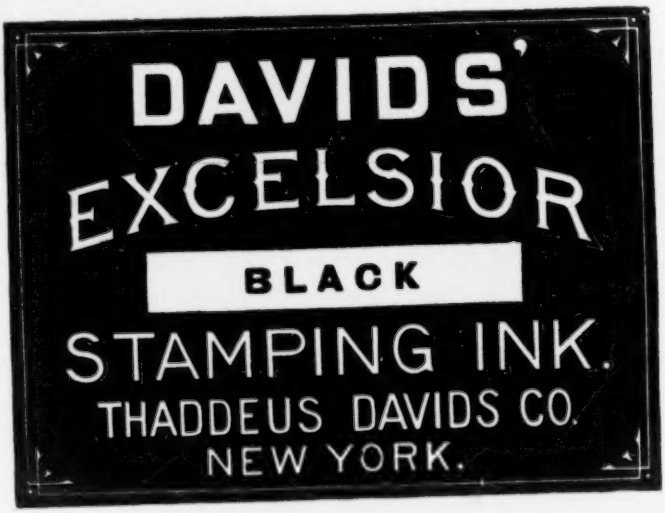

DAVIDS'
ELECTRO CHEMICAL
WRITING FLUID
Is a beautiful blue soon changing to a permanent JET BLACK.
It does not fatigue the eye, because it does not deposit the color and become pale as some writing fluids do.
It is the most LIMPID of all writing inks, therefore admirably adapted to RESERVOIR and FOUNTAIN PENS.
It will not mould under any condition, dries rapidly, and WILL NOT COPY or offset after being written a few hours, though books or papers may be soaked in water as in case of fire.
If you want an ink suitable for ordinary use that will yield ONE COOD COPY, use our Blue Black Record Ink.
THADDEUS DAVIDS COMPANY, NewYork

COMPLAINANT'S EXHIBIT EMRY DAVIS CARMINE LABEL.

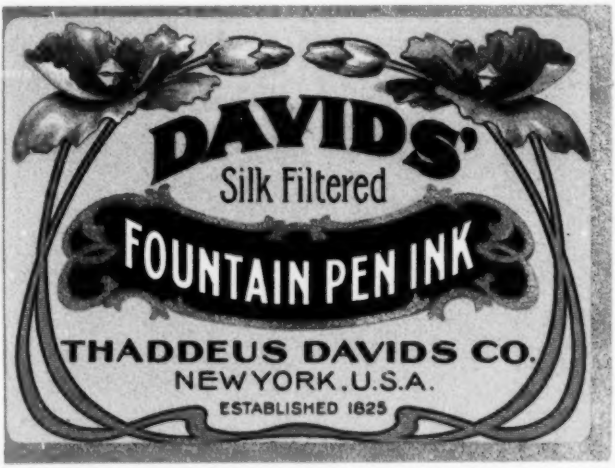
105 COMPLAINANT'S EXHIBIT EMRY DAVIS COPYING LABEL.

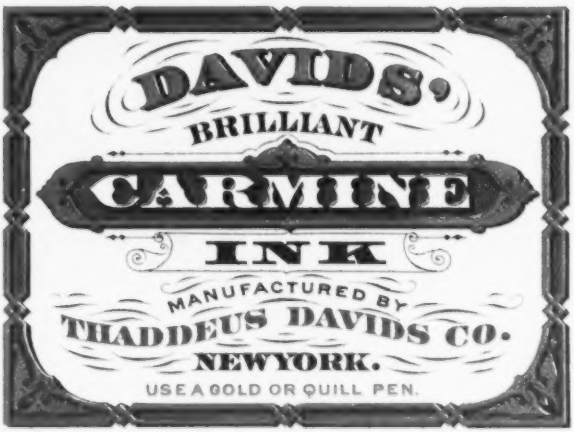
COMPLAINANT'S EXHIBIT EMRY DAVIS WRITING FLUID LABEL.

106 DEFENDANTS' EXHIBIT ADDITIONAL LABELS.

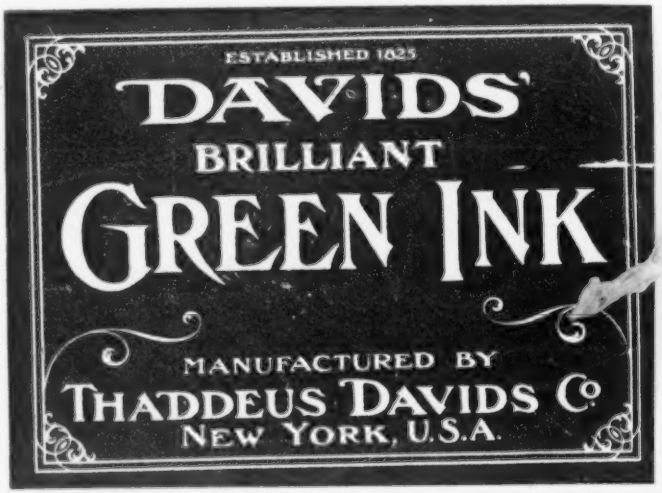


107 DEFENDANTS' EXHIBIT ADDITIONAL LABELS—(Continued).

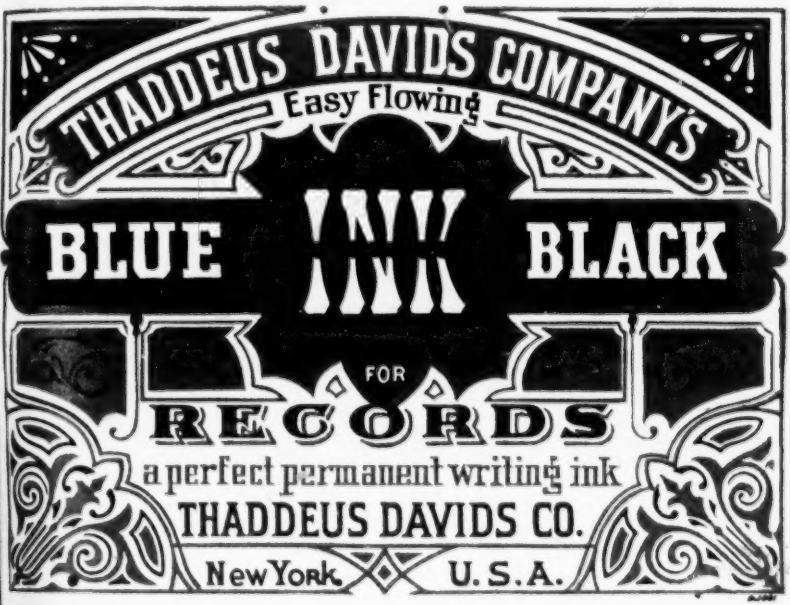




108 DEFENDANTS' EXHIBIT ADDITIONAL LABELS—(Continued).



DEFENDANTS' EXHIBIT ADDITIONAL LABELS—(Continued).



110 United States Patent Office.

Thaddeus Davids Company, of New York, N. Y.

Trade-mark for Inks and Stamp-pads.

No. 59,898.

Registered Jan. 22, 1907.

Statement and Declaration.

Application Filed July 10, 1906. Serial No. 20,831.

Statement.

To all whom it may concern:

Be it known that the Thaddeus Davids Company, a corporation organized under the laws of the State of New York, located and doing business in New York city, county of New York, in the State of New York, has adopted for its use the trade-mark shown in the accompanying drawing.

This mark has been continuously used in the business of said corporation and its predecessor, Thaddeus Davids, since about 1825.

The general class of merchandise to which the mark is appropriated is Class 60, Inks and inking materials, and the particular description of goods comprised in such class upon which it is used is writing-inks of all varieties, hectograph-ink, show-card, indelible and stamping ink, and stamp-pads.

It is customary to print the mark upon labels which are attached to the receptacles containing the goods.

THADDEUS DAVIDS COMPANY,
By E. W. DAVIDS, *Secy.*

Declaration.

STATE OF NEW YORK,
County of New York, ss:

E. W. Davids, being duly sworn, deposes and says that he is secretary of said corporation the applicant named in the foregoing statement, that he believes the foregoing statement to be true, that he believes said corporation to be the owner of the trade-mark sought to be registered, and that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use the trade-mark, either in the identical form or in any such near resemblance thereto as might be calculated to deceive, and that the trade-mark is used by said corporation in commerce among the several States of the United States; and that the description, drawing and specimens (or facsimiles) pre-

109

TRADE-MARK.

No. 59,898. REGISTERED JAN. 22, 1907.

THADDEUS DAVIDS COMPANY.

INKS AND STAMP PADS.

APPLICATION FILED JULY 10, 1906.

DAVIDS'

Proprietor

Thaddeus Davids Company

By Wilkinson

Attorney

sented truly represent the trade-mark sought to be registered, and that said mark has been actually used as a trade-mark by the applicant and its predecessor from whom title is derived, for ten years next preceding the passage of the act of February 20, 1905, and to the best of his knowledge and belief such use has been exclusive.

E. W. DAVIDS.

Subscribed and sworn to before me this 23d day of October, A. D. 1906.

[L. S.] GEO. F. CHURCHILL,
Notary Public, Kings County.
Certificate filed in N. Y. County.

(Here follows diagram marked page 109.)

111 United States Circuit Court, Southern District of New York.

In Equity.

THADDEUS DAVIDS COMPANY, Complainant,
vs.
CORTLANDT I. DAVIDS and WALTER L. DAVIDS, Defendants.

Stipulation.

It is hereby stipulated and agreed between Counsel for the respective parties that the following exhibits of the Complainant may be omitted from the transcript on appeal, to-wit:

Emry Davis Carmine Label,
Emry Davis Copying Label,
Emry Davis Writing Fluid Labels,

and that the original bill of complaint need not be included in the transcript.

W. P. PREBLE, JR.,
Solicitor and Counsel for Complainant.
EMERSON R. NEWELL,
Solicitor and Counsel for Defendants.

New York, N. Y., Sept. 20th, 1911.

112 United States Circuit Court, Southern District of New York.

In Equity.

THADDEUS DAVIDS COMPANY
vs.
CORTLANDT I. DAVIDS and WALTER I. DAVIDS, Trading as Davids Mfg. Co.

Answer to the Amended Bill of Complaint.

To the Honorable the Judges of the United States Circuit Court for the Southern District of New York:

These defendants now and at all times hereafter, saving and reserving to themselves all and all manner of benefit or advantage of exception or otherwise that can or may be taken to the many errors, uncertainties and imperfections in the bill of complaint contained, for answer thereto, or to so much thereof as they are advised is material or necessary for them to make answer to, answering, say:

(1). That they are not informed, save by said bill of complaint, that the Thaddeus Davids Company is, or at any time was, a corporation organized under the laws of the State of New York, and therefore deny the same and leave complainant to make proof

thereof. They are informed and believe that its principal
113 place of business was at #127 William Street, in the City of New York, in the Southern District of New York.

(2). Said defendants admit that they are citizens of the State of New York, and that at the time of the filing of said amended bill of complaint were doing business at #203 Front Street, in the City of New York, under the name of Davids Manufacturing Company.

(3). These defendants are not informed, save by said bill of complaint, that the complainant is, or at any time was, the owner of a trade-mark used in commerce among the several States of the United States of America, and therefore deny the same and leave complainant to make proof thereof. They are informed and believe that the complainant is a manufacturer of inks, mucilage and paste and similar articles, but whether it has been so engaged, together with its predecessors, in business in the City of New York continuously ever since 1825, or whether all or any of the inks, mucilage and paste and similar articles manufactured and sold by the complainants and its predecessors have borne said trade-mark, or have been sold under said trade-mark or whether said trade-mark has been used continuously or at all by the complainants or its predecessors in commerce among the several States, or whether said articles have acquired any high reputation in the market for goods of this description, namely, inks, mucilage and paste, or whether said goods have become and are popular or well known throughout the United States under any appellation, is unknown to these defendants, who therefore deny the same and leave complainant to make proof thereof.

(4). These defendants are not informed, save by said bill of complaint, that the complainant at any time filed in the
114 United States Patent Office an application for registration for its trade-mark, or that said application was in writing, or was as alleged in the amended bill of complaint, and therefore deny the same and leave complainant to make proof thereof. Said defendants on information and belief deny that the complainant complied with the requirements of the Act of Congress in such case made and provided.

(5). These defendants are informed and believe that on January 22, 1907, a certificate of registration #59,898 was issued to the complainant, but on information and belief deny that the same was issued in due form of law, or that said registration was legally granted. These defendants are not informed, save by said bill of complaint, that said registration is still in force, or that the complainant was at any time, or is, the sole and exclusive owner of said trade-mark, and therefore deny the same and leave complainant to make proof thereof.

(6). These defendants are not informed, save by said bill of complaint, that the trade-mark so registered was originally adopted by the complainant's predecessors in business, or that they were about the year 1825 or at any other time the owner of the mark, or that it was a mark by which the goods of the said owner may

be distinguished from other goods of the same class, or that said mark had been continuously used for said purpose by the complainant and its predecessors in business since said date or is still so used, or that said mark distingaished the goods in any way, and therefore deny the same. Said defendants on information and belief deny that any such trade-mark was in actual and exclusive use as a trade-mark of the applicant, or its predecessors from which it derived title, for ten years next preceding the passage of the
115 trade-mark act of Congress, approved February 20, 1905, and deny that such registration was obtained as legally required by said act or in Section 5 thereof. These defendants are not informed, save by said bill of complaint, of what the complainant is advised or believes as specified in the latter part of Paragraph 4 of the amended bill of complaint, but on information and belief deny that said alleged trade-mark was in actual and exclusive use as a trade-mark of the complainant, or its predecessors, for ten years next preceding the passage of said Act, and deny that it was entitled to registration, or that said registration was a valid registration, or is entitled to the protection of this Court in any way.

(7). These defendants, on information and belief, deny the conclusions of law set forth in Paragraph 5 in the amended bill of complaint.

(8). These defendants are not informed, save by said bill of complaint, as to the manner in which the complainant's alleged trade-mark was applied to its goods, or that it or its labels were arranged and applied as specified in Paragraph 6 of the amended bill of complaint, and therefore deny the same and leave complainant to make proof thereof.

(9). These defendants are not informed, save by said bill of complaint, that said alleged trade-mark, or the right to its exclusive use, is of any value to the complainant, or that any infringement thereof, or any use of a mark so closely resembling the same as to mislead the public, would, or is likely to, cause irreparable injury to the complainant, or to deprive it of any reward or fruits, or that the complainant's goods have become known by the designation of "Davids' Inks," "Davids' Mucilage" or "Davids' Paste," and
116 therefore deny the same and leave complainant to make proof thereof.

(10). These defendants are not informed, save by said bill of complaint, that the complainant or its predecessors have made and sold under said registered trade-mark, or are now making or selling any variety of inks, mucilage or paste, or that any such has been known in the market and are called for as "Davids' Inks," "Davids' Paste" or Davids' Mucilage," or that purchasers or the public generally have come to indentify the same in any way by reason of the presence upon the labels of the word Davids, and, therefore, deny the same, and on information and belief they deny that the word Davids has identified to the public or the trade articles of the complainant.

(11). These defendants admit that Cortlandt I. Davids entered the employ of the complainant in or about the month of June, 1905, and

remained in said employ for about nine months, and that Walter I. Davids entered the employ of the complainant in the year 1904 and remained in said employ until about the month of March, 1906, and they admit that while in said employ they did see the inks, mucilage and paste of the complainant in its showrooms, and, to a limited extent knew the names of some of its customers. Said defendants admit that to a certain extent they became familiar with the methods of manufacture of the complainant's inks, mucilage and paste, but not surreptitiously, but, on the contrary, at the direct request of Mr. David F. Davids, who was at that time the President of the complainant company.

(12). These defendants admit that at about the month of March, 1906, Edwin W. Davids, who was then Secretary of the com-
117 plainant company (said David F. Davids having meanwhile died), discharged these defendants from their positions, but deny that it was for good cause, but, on the contrary, allege that it was for the reason that said Edwin W. Davids while intoxicated became unjustly vexed at these defendants and peremptorily discharged them without cause. Said defendants are lineal descendants of the original Thaddeus Davids, who founded the complainant company early in the last century. These defendants admit that since that time there has been no business connection between the complainant and these defendants, and admit that the complainant had not since that time, given them any permission to use any of its trade-marks, and these defendants state on information and belief that no mark or trade-mark owned by the complainant has been used by said defendants, or either of them, and they deny that they have at any time since then held themselves out as having any connection with the complainant or its products or processes of manufacture.

(13). These defendants admit that they have associated themselves together in the business of making inks, mucilage, and paste, but they deny that they contrived or intended to injure, or have legally injured, the complainant in its business, or have illegally diverted to themselves any benefit or advantage which otherwise would have accrued to the complainant. These defendants admit that they have adopted as a trade name the firm name and style of Davids Manufacturing Company, and began putting on the market inks, mucilage and paste in bottles, on which were pasted labels, at the top of which were the words "C. I. Davids," with the words "Ink," "Mucilage" or "Paste," near the middle of the same, and the words "Davids Manufacturing Co." near the bottom,
118 but they deny that they have sold or offered the same for sale as Davids' Ink, Davids' Mucilage or Davids' Paste, or that the goods so labelled were calculated to or would deceive the public, or did deceive the public, or that any confusion was created in the market as to the origin of the goods, or that any illegal damage or injury to the complainant resulted therefrom, or that said goods or labels were an infringement of the complainants' registered trade-mark or of any rights of the complainant at common law.

(14). These defendants deny that they so manufactured or sold

said articles or so labelled them in infringement of the complainant's rights in any way, or that they caused, or are threatening to continue, any illegal injury to the complainant.

(15). These defendants deny that the name Davids Manufacturing Company is an imitation of the complainant's name, and on information and belief allege that the acts alleged by the complainant in Paragraph 13 of the amended bill of complaint were no infringement of the complainant's rights.

(16). These defendants further answering deny that they have ever put their goods on the market as or for the complainant's goods, and deny each and every allegation of infringement, unfair or unlawful competition, or other unlawful act by them, or either of them, alleged in the bill of complaint as amended.

(17). These defendants further answering allege that said registration of said trade-mark was unlawful and invalid and of no force and effect, for the reason that said mark as registered was not of such a character as was entitled to registration under the
119 trade-mark act, and because it was not in actual and exclusive use as a trade-mark of the applicant or its predecessors from whom it derived title for ten years next preceding February 20, 1905; and that said mark was in use by others as a trade-mark in the United States and elsewhere for goods of the same descriptive qualities between February 20, 1895, and February 20, 1905.

(18). These defendants further answering on information and belief allege that this complainant has no right of action herein, because it has permitted and allowed others than this complainant and its predecessors to manufacture and sell or distribute in the United States and elsewhere goods of the same descriptive qualities with the said trade-mark thereon, and which goods did not in any way originate in the complainant and were not the complainant's goods, to the deception of the public and the trade.

(19). These defendants further answering on information and belief allege that said registered trade-mark was used to identify goods patented in the United States, and which patent or patents expired before the defendants committed any act of infringement complained of in the bill of complaint.

(20). These defendants further answering on information and belief allege that said complainant comes into Court with unclean hands and has no right of action in the premises, because said complainant by its labels, statements, advertisements and otherwise, unlawfully deceived and misled the public and the trade as to the manufacture, ingredients, quality, etc., of its goods upon which said mark was used, for the purpose and with the result of deceiv-
120 ing the public and the trade into purchasing and using the complainant's goods under the impression and expectation that said goods were materially different from what they were in fact.

(21). These defendants further answering on information and belief allege that the complainant's registration of its trade-mark is invalid and of no force and effect, for the reason that neither it nor its predecessors used said trade-mark upon all of the articles named

in said registration as required by the Trade-mark Statute of the United States, and that said certificate of registration was, in consequence thereof and for other reasons, fraudulently obtained.

(22). These defendants further answering on information and belief, deny all unlawful acts with which they, or either of them, are charged by said bill of complaint, and they say that said complainant has no right to any further answer to said bill of complaint, or to any part thereof, than is herein contained, and is not entitled to any judgment, account, damage or other relief prayed for in said bill; without this that any other matter, cause or thing in said complainant's bill of complaint contained, material or necessary to be answered by these defendants, and not herein and hereby sufficiently well answered unto, confessed and avoided, traversed or denied, is true; all of which matters and things these defendants are willing to aver, maintain and prove as this Honorable Court shall direct, and they humbly pray to be hence dismissed with their reasonable costs and charges in this behalf most wrongfully sustained.

CORTLANDT I. DAVIDS AND
WALTER I. DAVIDS,
By EMERSON R. NEWELL,
Solicitor and Counsel for Defendants,
#2 Rector Street, New York, N. Y.

121 STATE OF NEW YORK,
County of New York, ss:

Cortlandt I. Davids, being duly sworn, deposes and says that he is one of the defendants named in the foregoing answer; that he has read the said answer and knows the contents thereof; that the same is true of his own knowledge except as to the matters stated or alleged on information and belief and the matters admitted, and as to such matters he believes it to be true.

CORTLANDT I. DAVIDS.

Subscribed and sworn to before me this 28th day of May, 1910.

[SEAL.] BEATRICE MIRVIS,
Notary Public.

Defendants' Proofs.

United States Circuit Court, Southern District of New York.

In Equity.

THADDEUS DAVIDS COMPANY
vs.
CORTLANDT I. DAVIDS and WALTER I. DAVIDS, Trading as DAVIDS MANUFACTURING CO.

NEW YORK, N. Y., *December* 8, 1910.

Proofs for defendants taken under the 67th Rule in Equity, before John A. Shields, Esq., Standing Examiner, at the office of Emerson R. Newell, Esq., counsel for defendants, at #2 Rector Street, New York City, New York, pursuant to agreement between counsel.

122 Present:

W. P. Preble, Jr., for Complainant.
Emerson R. Newell, for Defendants.

CORTLANDT I. DAVIDS, having been duly sworn, deposes and says in answer to questions by Mr. Newell:

Q. 1. What is your name, age, residence and occupation?
A. Cortlandt I. Davids; 46; #469 W. 152nd Street, New York; manufacturer of inks.
Q. 2. Do you know the Thaddeus Davids Company, the complainant herein?
A. I do.
Q. 3. Are you any relative of Thaddeus Davids, who founded the complainant company some 75 years ago or so?
A. I am grandson.
Q. 4. Walter I. Davids, the other defendant, is your son?
A. My son, yes, sir.
Q. 5. About what time did you and your son enter the employ of the Thaddeus Davids Co.?
A. Walter went there I think in August, 1904, and I went there in May, 1905.
Q. 6. Who employed you?
A. David F. Davids, who was at that time President of the Thaddeus Davids Co.
Q. 7. Is he alive now?
A. No, sir.
Q. 8. What relation was he to you?
A. My uncle.
Q. 9. You were in the business of manufacturing sealing wax previous to the time you were employed by the complainant?
A. I was.

Q. 10. Some of the sealing wax which you sold was sold to the complainant company?

A. Practically all of it.

123 Q. 11. Do you know anything about how your son came to be employed by the complainant? If so, please state how it was?

A. David F. Davids, President of the company, telephoned to my house and requested my son to come over and see him, and he arranged to employ him at that time.

Q. 12. Did your son enter the employ of the complainant immediately thereafter?

A. Within a week at most.

Q. 13. During the time you and your son were employed by the complainant, was there any restriction placed on you or him in regard to seeing how the inks, mucilage, pastes, etc., were manufactured by the complainant?

A. No, there was not.

Q. 14. Did you and your son in the course of your employment there become acquainted with the ingredients and method of manufacture of the inks, mucilage and paste put out by the complainant?

A. Many of them.

Q. 15. When did you and your son leave the employ of the complainant?

A. In March, 1906.

Q. 16. Did you two leave of your own accord, or were you discharged?

A. We were discharged.

Q. 17. Who discharged you?

A. Edwin W. Davids, the Secretary of the Company.

Q. 18. Were you both discharged at the same time?

A. We were.

Q. 19. Was David F. Davids, the former President of the Company, who employed you and your son, alive at that time?

A. No, sir.

Q. 20. What reason, if any, did Mr. Edwin W. Davids give for discharging you and your son?

124 A. He accused me of calling some one a "sucker."

Q. 21. Was that true as a matter of fact?

A. It was not.

Q. 22. What was Mr. Davids' conditions at the time he made this accusation?

A. He was intoxicated.

Q. 23. Did you deny his accusation?

A. I did.

Q. 24. What did he then say to both of you?

A. "You can both get the hell out of here."

Q. 25. Was your son present at the time?

A. Yes, sir.

Q. 26. And heard the conversation?

A. He did.

Q. 27. You both then left?

A. We did.

Q. 28. Had your son Walter learned any trade previous to the time he went into the employ of the complainant?

A. Well, he had learned the wax business.

Q. 29. By this you mean the business of manufacturing sealing wax?

A. Yes, sir.

Q. 30. Who from?

A. From me.

Q. 31. Had you learned any other trade than the manufacture of sealing wax before you entered the employ of the complainant company?

A. I had not.

Q. 32. When you were in the sealing wax manufacturing business before you went with the complainant, you manufactured sealing wax almost exclusively for the complainant Company?

A. Yes; that's right.

Q. 33. After you were discharged by Mr. Davids you and your son then went into the business of manufacturing sealing wax and inks?

125 A. Not sealing wax; only inks, mucilage and paste.

Q. 34. Are the ingredients and general method of manufacture of the inks, mucilage and paste of the complainant like or different from what is generally known to ink manufacturers for a great many years?

A. Practically the same.

Q. 35. I show you here a trade price list of the Thaddeus Davids Co. for 1908, which shows a lot of different labels with descriptions of different inks, etc., and which is marked Defendant's Exhibit "Complainant's Price List." On page 16 thereof is shown a label of "Davids Oriental Carmine Ink." Was that label used when you and your son were in the employ of the complainant?

A. It was.

Defendant's counsel herewith introduces the Price List referred to, and requests that it be marked as Defendant's Exhibit "Complainant's Price List."

Q. 36. Was there anything oriental about this ink at the time you were in the complainant's employ?

A. Not that I know of.

Q. 37. Was it manufactured here in this country?

A. Yes, sir.

Q. 38. On page 26 of that price list is a label showing "Davids Oriental Red Ink." Would your answer be the same in regard to this ink?

A. Yes, sir.

Q. 39. On page 28 is shown a label of "Davids Silk Filtered Fountain Pen Ink." Was that label the same at the time you were employed there?

A. I think it has been changed, I am not clear on that point.

Q. 40. Were the words "Silk Filtered" on the label when you were there?

A. It was.

126 Q. 41. Was this ink silk-filtered while you were in the complainant's employ?

A. I was told by those that bottled it, that it was not

Q. 42. Was there anything else said in regard to this ink? If so, please state what it was?

A. Occasionally when they sold a bottle of it at $1 a quart, they would remark that that was easy money as it all came from the same barrel as the "Electro Chemical Writing Fluid."

Q. 43. This Electro Chemical Writing Fluid, which you mention, is that of the label shown on page 3, is it not?

A. Yes, sir.

Q. 44. That label was used when you were in the complainant's employ?

A. It was.

Q. 45. Was there anything "Electro Chemical" about that ink?

A. Nothing electrical about it.

Q. 46. On the page 29 of that price list is shown a label of "Davids Pure Gum Security Mucilage." Underneath the label is printed "Warranted Pure Gum Arabic and Extra Heavy." Was that label used on the complainant's security mucilage when you were in their employ?

A. It was.

Q. 47. What was it made out of?

A. Gum Ghatti.

Q. 48. Is that gum as good as pure gum Arabic?

A. No, sir.

Q. 49. Why not?

A. It is not as strong and don't make as strong a mucilage.

Q. 50. Do you consider it inferior to the pure gum Arabic for this purpose?

A. I do.

Q. 51. And if I understand you correctly it is because it

127 will make an inferior mucilage?

A. Yes, sir.

Q. 52. On page 31 of that price list is shown a label reading "Davids General Mucilage—Warranted Pure Gum Arabic," and underneath the label is printed— "A Good Strong Gum Arabic Mucilage * * * " Was that label used while you were there?

A. Yes, sir.

Q. 53. Was it made of "pure gum Arabic?

A. It was not.

Q. 54. What was it made of?

A. Gum Gedda.

Q. 55. Is gum Gedda superior to or inferior to "Pure Gum Arabic" for the manufacture of mucilage?

A. Inferior.

Q. 56. For the same reasons as you gave before?

A. Yes, sir.

Q. 57. Are these two inferior gums which you have mentioned, more costly or less costly than Pure Gum Arabic?

A. Less costly.

Q. 58. Very much so?

A. Quite considerable.

Q. 59. On page 32 of the Exhibit Price List appears the words under Special Notice—

"No mucilage made by us contains dextrine, starch, or other substitutes for pure Gum Arabic. The trade and consumer alike can confidently rely upon Davids' Mucilage as being the very best that can be made or that money can buy."

Did that statement appear in the Price List of the Complainant at the time you were employed by them?

A. Yes, sir

128 Q. 60. Was that statement true in regard to all their mucilages?

A. It was not, except as to starch and dextrine. They didn't use starch or dextrine for making mucilage.

Q. 61. After you and your son had been discharged from the Complainant's employ, you two started into the manufacture of inks, as you have said. Did you consult with any one in regard to the labels which you used on your ink bottles?

A. Yes, sir, I did.

Q. 62. Who was it?

A. It was yourself.

Q. 63. In a general way what did I tell you?

A. Well I stated my purpose and asked you if there would be any infringement in using my name on the labels. I was informed that so long as I did not attempt to imitate the Compainant's labels and used my own name at the top of the label, there could be no infringement.

Q. 64. Some of the complainant's witnesses have testified that there was some confusion between your Company and the Complainant in regard to letters or orders received. Did you ever fill any orders which showed that they were intended for the Complainant Company?

A. We did not.

Q. 65. What did you do with such orders?

A. Mailed them back to them. Very often I sent people up there who have called, and directed them how to get there.

Q. 66. Did you ever hear of the Davis Ink Company?

A. I have.

Q. 67. Where are they located?

A. St. Louis, Mo., according to their label.

Q. 68. How long have you known of them?

129 A. I knew of them at the time I was employed with the Thaddeus Davids Co., and since that time.

Q. 69. Did you know of them before 1905?

A. Only by what I have heard in conversation, complaining that some one was misrepresenting their ink.

Cross-examination by Mr. PREBLE:

X Q. 70. How long had Mr. Davids been dead before you left the Thaddeus Davids Co.?

A. He died on the 26th of August, 1905, and I was discharged on the following March, 1906.

X Q. 71. Edwin W. Davids, then Secretary, is now dead, is he not?

A. Yes, sir.

X Q. 72. How long after you left the Davids Co. was it before you and your son went into the business of making inks, mucilage and paste?

A. About a year.

X Q. 73. And what did you do meanwhile?

A. I didn't do anything. My son had a position.

X Q. 74. In the ink line?

A. No, sir.

X Q. 75. After you entered the employ of the Thaddeus Davids Co. where did your Company get its sealing wax?

A. From the man to whom I had sold the business.

X Q. 76. How long before you entered the employ of the Thaddeus Davids Co. had you sold out the sealing wax business?

A. Not quite two years.

X Q. 77. And during those two years had you been engaged in any business?

A. Nothing steady, no, sir.

X Q. 78. When you say that your uncle telephoned to your son, do you mean to imply that your son had not applied
130 to the Thaddeus Davids Co. for a position?

A. I do.

X Q. 79. In what position were you employed by the Thaddeus Davids Co.?

A. Behind the desk, keeping books.

X Q. 80. Do you mean as Bookkeeper?

A. General work behind the desk, cashier, and everything else.

X Q. 81. And what relation was Edwin W. Davids to you?

A. He was also my uncle.

X Q. 82. Then Edwin W. Davids and David F. Davids were brothers, were they?

A. Yes, sir.

X Q. 83. And both sons of the original Thaddeus Davids?

A. They were.

X Q. 84. What knowledge or experience in the ink business had you had before you entered the employ of the Thaddeus Davids Co.?

A. None, except what I had gained by being about their place. It was always accessible to me as a member of the family.

X Q. 85. What other prominent manufacturers of ink were there to your knowledge in the business, during the time you were with the Thaddeus Davids Co.?

A. Stafford, Carter, Sanford, Paul Ink Co., and I think Thomas.

X Q. 86. You think, then, it was about March, 1907, that you and your son started in the ink business?

A. Yes, sir, the early part of 1907.

X Q. 87. When was this consultation you had with Mr. Newell as to the labels, with reference to the time when you started in business?

131 A. All of six months prior to the date of going in business.

X Q. 88. Then if I understand you correctly, some six months before you and your son started in the ink business you consulted counsel as to the labels which you intended to adopt?

A. That's correct.

X Q. 89. How did you happen to adopt the trade name of Davids Manufacturing Company as the one under which you and your son would do business?

Objected to as immaterial to any question at issue in this cause. The only question here at issue to be decided by this Court is whether the Trade-Mark Davids as registered is valid and has been infringed by the defendants. The full name "Thaddeus Davids Company," the complainant, is not the registered trade-mark and is apparently not so used. Use of the name "Davids Manufacturing Co." in the manner proved by the complainant and admitted by the defendants is not in question here, for even if there were any question of Unfair Competition, this Court has no jurisdiction in regard to same, because complainant and defendants are all citizens of the same State.

A. It appeared to us a convenient one, being our own name, and modern times dictated to us to use our name in that way.

X Q. 90. Is that all?

A. It's the only thing I could think of.

X Q. 91. Was it, or not, the fact, to your knowledge, that the inks made and sold by the prominent manufacturers, whom you have mentioned, as well as the Thaddeus Davids Co., were generally known and recognized in the trade by the sur-name such as Davids', Sanford, Stafford, Paul, Thomas, rather than

132 by the special or fanciful terms adopted for the various kinds or colors of inks?

Objected to as immaterial, and further as not proper cross examination as basis for such has not been laid in the direct examination and complainant has no right to prove any part of its case at defendant's expense.

A. That is true, and for that reason I used my initials.

X Q. 92. Don't you mean rather that for that reason you used the word Davids, but that you used your initals to distinguish your Davids from the other Davids?

A. Exactly. I used them to distinguish the two names, as I wanted to build up a business for myself.

A. I won't be positive where it comes from. I only know the seem to think were inaccurate and misleading, were attached to their goods, did you not think that the word Davids as attached to a new ink concern would be rather a handicap than a help?

A. Not necessarily.

X Q. 94. Where does gum Ghatti come from?

A. It comes from the old country, the Continent.

X Q. 95. Europe or Asia?

A. The southern part of Asia or vicinity.

X Q. 96. India, Persia or Arabia?

A. I won't be positive where it comes from. I only know the difference between them in their use.

X Q. 97. And how about Gum Gedda. Where does that come from?

A. I will make the same answer. It is an imported product, as near as I can tell you.

X Q. 98. What do you understand by the word "Oriental?"

A. Looking to the East is the definition, I think.

133 X Q. 99. You mean East from the United States?

A. Yes.

X Q. 100. And what do you understand by the term "Silk Filtered?"

A. It means that the ink is put through a process of silk filtration.

X Q. 101. At what stage of the process of manufacture?

A. Why when the ink is finished, if ever.

X Q. 102. You mean just before bottling?

A. At any period before it is put into the bottles.

X Q. 103. What do you understand by the term "Electro Chemical" as applied to ink?

A. It would imply that it went through some electrical process, and I have heard the question raised on numerous occasions, "is there any electricity in that ink?"

X Q. 104. When did you change from a white label to a yellow label on your marking ink?

Objected to as immaterial and incompetent as the only testimony in regard to this is in regard to a date some two years after the filing of the bill of complaint and any such question is not included in the question of infringement of the registered trade-mark here under consideration by this Court.

A. Why, only recently.

X Q. 105. How old was your son when he entered the employ of the Thaddeus Davids Co.?

A. Fifteen.

Redirect examination by Mr. NEWELL:

R. D. Q. 106. When did you sell out your sealing wax business?

A. In June, 1903.

R. D. Q. 107. Who did you sell it to?

134 A. Mr. Carl T. Kuehler.

R. D. Q. 108. Under the terms of the sale were you at liberty to go into the sealing wax business after that?

A. I agreed not to.

R. D. Q. 109. What advantage, if any, would it be to a consumer of fountain pen ink to have it "silk filtered," and why?

A. To remove any possible sediment in the ink, thereby allowing it to flow more freely and surely through the fountain pen.

R. D. Q. 110. Is what is known in the trade as "Gum Arabic" or "Pure Gum Arabic" the same as or a different kind from Gum Ghatti and Gum Gedda?

A. Different. A different species of gum. They are sold for just what they are.

Recross-examination by Mr. PREBLE:

R. X Q. 111. Then when you and your son started up in business the early part of 1907 you did not include the manufacture of sealing wax as a part of your business?

A. No, sir.

R. X Q. 112. What you did manufacture was ink, mucilage and paste, and nothing else?

A. That's right.

CORTLANDT I. DAVIDS.

Recess.

WALTER I. DAVIDS, a witness introduced on behalf of defendants, having been duly sworn, deposes and says in answer to questions by Mr. Newell:

Q. 1. Please state your name, age, residence and occupation?

A. Walter I. Davids, 22; 469 W. 152nd St., manufacturer with my father, under the name of the Davids Manufacturing Company.

135 Q. 2. You are one of the defendants in this suit?

A. Yes, sir. The other defendant is my father, Cortlandt I. Davids.

Q. 3. Do you know the Thaddeus Davids Co., the complainant?

A. Yes, sir.

Q. 4. When did you enter their employ?

A. In July or August, 1904.

Q. 5. Did you apply for the position?

A. No, sir.

Q. 6. How did you come to be employed by them?

A. I was out on a day's outing and upon my return home was informed that my uncle, David F. Davids, had phoned requesting me to come and see him. I knew not at the time in reference to what he wanted to see me, but on going over there I met him at the house and we went for a walk around his place. He then asked me how I would like to go to work for him. I told him I would just as leave as go back to school. He then told me he wanted me to report at the downtown office on William Street of the Thaddeus Davids Co. A few days after that I went to work for them. Mr. Davids was then the President of the company.

Q. 7. What was your business at first there?

A. Assisting at the various books, ledger, sales-book, petty cash book, etc. I also opened the mail in the mornings, assorted same, checking off the payments with the various accounts in the ledger.

and turned the letters over to Mr. Edwin W. Davids, who was the Secretary of the Company.

Q. 8. What position did Mr. David F. Davids hold in the Company when he employed you?

A. President.

Q. 9. Is he alive now?

A. No, sir.

Q. 10. What, if anything, did Mr. David F. Davids, the President, tell you in regard to the business?

136 A. He told me that there was no young blood down there in the Company and that he would put me there as he believed I was very ambitious, and he told me he wanted me to learn everything about the business and not overlook anything.

Q. 11. And in pursuance of this request of Mr. Davids did you become acquainted with the manufacture of inks, mucilage and paste?

A. Yes, sir. During my spare time I went around the various parts of the factory and watched the making of various inks, mucilage and paste, and if there was anything I wanted to know I inquired. No information was ever refused me. In this way I got a pretty good general idea of the whole business, as requested by Mr. Davids. All the complainant's inks, mucilage and paste which they put out was made right in their factory where I was employed.

Q. 12. When did you and your father leave the Thaddeus Davids Co.?

A. We were discharged by Edwin W. Davids in March, 1906.

Q. 13. Please explain how he came to discharge you and your father?

A. He came down in the morning and hadn't much to say to anybody, as he appeared very ugly for some unknown reason, and after visiting the outside places and cafés with Mr. Merkle and having become most fully intoxicated, he came back. He accused father of calling him a "sucker" and pop denied it as he said nothing of the kind. Mr. Davids insisted that father did, and he simply answered that it was merely a question of veracity. Father said he didn't and Mr. Davids said he did. Mr. Davids then simply told us to "get to hell out of here." He paid us on Wednesday for the balance of the week, and asked us to sign a receipt for same. We then left.

137 Q. 14. Was your father present when Mr. Davids discharged you?

A. Yes, he discharged us both at one time.

Q. 15. Was any one else present?

A. Yes.

Q. 16. Who?

A. Miss Loretta Murphy, the stenographer.

Q. 17. Any one else?

A. Not that I know of. There were others present on the floor, but they were not nearby.

Q. 18. I show you here complainant's trade price list of 1908 and

which is entitled as Defendant's Exhibit "Complainant's Price List." Was the "Electro Chemical Writing Fluid" label, shown on page 3, used on the complainant's writing fluid while you were employed by them?

A. Yes, sir.

Q. 19. Was there anything electrical about the ink or its manufacture at that time?

A. No, sir.

Q. 20. Did you ever hear any customer make any suggestions or inquiries which would indicate that he thought there was something electrical about it?

A. Yes, sir.

Q. 21. Please state what that was?

A. I have had them ask me what was meant by the name "Electro Chemical" writing fluid. They wanted to know if it was purified in any way by electricity, or whether electricity had anything at all to do with it. I answered them, no.

Q. 22. I show page 16 of the Price List which shows a label of "Oriental Carmine Ink." Was this ink made in the complainant's factory in this City at the time you were employed there?

A. Yes, sir.

Q. 23. And the same in regard to the "Oriental Red Ink" label on page 26?

A. Yes, sir.

138 Q. 24. Both those labels were used while you were there on ink?

A. Yes, sir.

Q. 25. I show you page 28 which contains a label of "Silk Filtered Fountain Pen Ink." Did you ever know the complainant to filter its fountain pen ink through silk while you were there?

A. No, sir.

Q. 26. Did you ever hear any remarks made about this, and if so, what?

A. I heard Mr. Merkle, the present President of the Company, say one day after a customer had come in and ordered a quart of fountain pen ink. After he had gone Mr. Merkle said it was a darn shame to charge a man a dollar when it was the same goods as their electro chemical fluid, with the exception of label. I also heard Mr. Merkle say that they did, several years ago, silk-filter their fountain pen ink, that they still had some of the silk left, and that it had been laying around for a good many years, having no further use for same.

Q. 27. I show you here page 29 of that exhibit Price List which shows a label of "Pure Gum Security Mucilage." Was that label used when you were there?

A. Yes, sir.

Q. 28. Under the label is printed "Warranted Pure Gum Arabic and Extra Heavy * * * ." Was that also in their Price List at that time?

A. Yes, sir.

Q. 29. As a matter of fact was that mucilage made of pure gum Arabic?

A. No, sir.

Q. 30. What gum was used?

A. Gum Ghatti.

Q. 31. On page 31 is a label of "General Mucilage Warranted Pure Gum Arabic," and under it is printed "A Good Strong Gum Arabic Mucilage * * * ." Was that mucilage made of gum Arabic?

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A. No, sir.

Q. 32. What was used?

A. Gum Gedda.

Q. 33. Is Gum Ghatti and Gum Gedda as good as Gum Arabic for mucilage?

A. No, sir.

Q. 34. Why not?

A. It is not as clear, in the first place, is of a darker color, and although it is heavier in body it hasn't got the adhesive qualities of Gum Arabic.

Q. 35. Is "Gum Arabic" the same kind of gum as Gum Gedda and Gum Ghatti?

A. No, sir.

Q. 36. On page 32 of that Price List is printed—

"Special Notice."

No Mucilage made by us contains dextrine, starch, or other substitutes for pure Gum Arabic. The trade and consumer alike can confidently rely upon Davids' Mucilage as being the very best that can be made or that money can buy.

Was this notice in the Complainant's Price List at that time?

A. I couldn't say for sure that the last sentence was in it, but the first sentence was. There was a time when all their mucilages were made of gum Arabic, but the price of gum Arabic went up to a price where they couldn't afford to put it into the cheaper mucilage, and it was then that they looked around and found these other inferior gums and so substituted same for the gum Arabic. When the price dropped again they still continued to use these in-

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ferior gums, and they continued to use this inferior gum up to the time I left.

Q. 37. In regard to the "Silk Filtered" Fountain Pen Ink Label, would the ink be actually better if it were filtered through silk, and why?

A. Yes, because it would take out more of the sediment.

Q. 38. On page 13 of that Exhibit Price List is a label of "Non-Copying Carmine Ink." Was that ink made while you were there?

A. No, sir.

Q. 39. Do you believe that that particular ink is made of genuine carmine?

A. No, sir.

Q. 40. What do you believe it is made of?

A. An aniline color.

Q. 41. Will an aniline color produce as good red ink as genuine carmine?

A. Just as good for various purposes, but an aniline ink will copy more readily and will spread or offset more readily.

Q. 42. If I understand you correctly, while you were in their employ all these labels I have mentioned and the printed matter of their Price List mentioned, were false and misleading, is that correct?

A. Yes, sir.

Q. 43. Had you learned any trade before you were employed by the Complainant Co.?

A. No, sir. I was only 16 years of age when I was employed by them.

Q. 44. When you were employed by the Complainant did they advertise quarts of ink and put out the same in bottles?

A. Yes, sir.

Q. 45. Did these bottles always contain a full quart?

A. Not always.

141 Q. 46. You mean some of them were short quarts?

A. Yes, sir.

Q. 47. How much less than a full quart?

A. 4 ounces.

Q. 48. Did this pertain to mucilage as well?

A. Yes, sir.

Cross-examination by Mr. Preble.

X Q. 49. When you entered the employ of the Thaddeus Davids Co., they were using, as I understand you, what you call "Pure Gum Arabic," and while you were there changed in some instances to the use of the other gums, ghatti and gedda. Is that correct?

A. No, sir, they used all three gums before I went there.

X Q. 50. And also while you were there?

A. Yes, sir.

X Q. 51. How do you know what they used before you went there?

A. Because they had a considerable stock when I went in their employ, and there were goods of the same qualities after I went there.

X Q. 52. How much ink did you make while you were there, personally?

A. That wasn't my duties to perform the making of ink for them. I merely had acted as assistant on the books and had the liberty of going about the factory at my will when I had nothing better to do.

X Q. 53. Did you make any of the mucilage or paste personally?

A. That was another line which I had no hand in. Such duties I was not employed for.

X Q. 54. Where did you learn the alleged difference between these three gums?

A. While in their employ in the department where these mucilages were made.

142 X Q. 55. Do you know where any of these three gums come from?

A. They are all imported. Ghatti and Gedda I am not certain just where they do come from. I think they come from India. Arabic gum comes from Arabia.

X Q. 56. Are you quite sure that they don't all come from Africa?

A. I presume they do as the nature of the climate and soil in parts of Africa is the same as they are in Asia.

X Q. 57. Do you know where the so-called "Egyptian Gum Arabic," referred to on page 30 of the Price List as to which you have testified, comes from?

A. I should imagine from that that it came from Egypt.

X Q. 58. When you say that David F. Davids was your uncle, you mean grand-uncle, do you not?

A. Yes, sir, he was a brother to my grandfather.

Redirect examination by Mr. NEWELL.

R. D. Q. 59. You say that you did not personally make ink or mucilage when you were with the Thaddeus Davids Co. Did you see it made there?

A. Yes, sir.

WALTER I. DAVIDS.

Adjourned to to-morrow, Dec. 9, at 2 o'clock, at the same place.

143 NEW YORK, N. Y., *Dec.* 9, 1910.

Met pursuant to adjournment.

Present: Counsel as before.

JOHN P. O'HANLON, a witness introduced on behalf of defendants, having been duly sworn, deposes and says in answer to questions by Mr. Newell:

Q. 1. Please state your name, age, residence and occupation?

A. John P. O'Hanlon; 37, 85 Cortlandt Street, New York City; ink manufacturer.

Q. 2. How long have you been an ink-maker?

A. About 12 years.

Q. 3. Are you also a maker of mucilage and paste?

A. Yes, sir.

Q. 4. And for the same time?

A. Yes, sir.

Q. 5. If you were ever employed by the Thaddeus Davids Co., please state when you entered their employ and about when you left?

A. I entered their employ in 1898, and left in 1908.

Q. 6. Were you employed as a maker of inks, mucilage and paste while you were with them?

A. Yes, sir.

Q. 7. And you are familiar with the methods of manufacture and the ingredients used in most of their inks, mucilage and paste?

A. Yes, sir.

Q. 8. All their inks were made right here in New York City, were they not?

A. New York City.

Q. 9. I show you here Defendant's Exhibit "Complainant's Price List," and ask you whether you ever made the Electro
144 Chemical Writing Fluid shown on page 3, while you were with the Thaddeus Davids Company?

A. I did.

Q. 10. For how many years?

A. About 9½ years.

Q. 11. Was electricity used in the manufacture of this ink in any way?

A. There was no electricity in the house.

Q. 12. That same label was used all the time you were there?

A. Yes, sir.

Q. 13. I call your attention to page 28 which shows a label of the "Silk Filtered Fountain Pen Ink." Was that label put out on fountain pen ink at the time you were there?

A. Yes, sir.

Q. 14. Was this ink any different from the Electro Chemical Writing Fluid?

A. No, sir.

Q. 15. Do you mean to say that it was precisely the same?

A. Precisely the same. They drew them out of the same tanks, for I have drawn them out myself.

Q. 16. Do you mean to say that the Electro Chemical Writing Fluid and the Fountain Pen Ink were precisely the same, and were kept in the same tanks?

A. Yes, sir, and kept in the same tanks.

Q. 17. Was the alleged fountain pen ink "silk filtered?"

A. I never saw it filtered.

Q. 18. Would you have seen this ink silk filtered if it had been so filtered?

A. Yes.

Q. 19. I call your attention to page 29, which shows a label of the "Pure Gum Security Mucilage," and to the words "Warranted Pure Gum Arabic and Extra Heavy," under it. Was that
145 mucilage made of gum Arabic while you were there?

A. No.

Q. 20. What was it made of?

A. Gum Ghatti or Getty, I don't know which way it is spelled.

Q. 21. Is that gum superior to or inferior to gum Arabic?

A. Inferior.

Q. 22. Why is it inferior?

A. Because it is darker and a weaker gum, and won't make as good a mucilage.

Q. 23. I call your attention to the "Extra Adhesive Mucilage" label on page 30. Was that made of gum Arabic?

A. Yes.

Q. 24. I call your attention to page 31 and the label of "General Mucilage—Warranted Pure Gum Arabic." Was that mucilage made of pure gum Arabic?

A. No.

Q. 25. What was it made of?

A. Gum Gedda.

Q. 26. About how many tanks of the "Extra Adhesive Mucilage" shown on page 30 were made a year while you were with them?

A. About 9 tanks, the highest average.

Q. 27. About how many tanks of the other mucilages were made?

A. 29 to 30 tanks.

Q. 28. You were a foreman of the ink-making department?

A. Yes, foreman of the ink-making department in the cellar at 129 William Street, New York.

Q. 29. Did you actually have charge of the mak- of inks?

A. Yes, I had charge of the majority of the inks that
146 went out. Some of the fancy colors were made upstairs and I did not have charge over those.

Q. 30. You had charge of making the fountain pen ink and the electro chemical writing fluid, and the mucilages?

A. Yes, sir. I also had charge of the Marking Ink, School Ink, the Red, Black and White Letterine, Magic Ink which is the same identical thing as School Ink Writing and Copying Ink, United States Copying Ink, Chemical Copying Ink and Chemical Writing Fluid, and the Steel Pen Ink. Also the Blue-black Record Ink, Ravens Black Ink and Violet Ink.

Q. 31. What difference, if any, was there between the "chemical writing fluid" shown on page 7 of the Price List and the "Electro Chemical Writing Fluid" shown on page 2?

A. No difference at all, except by putting a gallon of water to four gallons of ink—adulterating it. One gallon of water to four gallons of electro chemical writing fluid made the "Chemical Writing Fluid."

Cross-examination by Mr. PREBLE:

X Q. 32. Did your work at the Thaddeus Davids Co., include bottling of the ink, or merely making it and putting them into the bottles?

A. Making it and putting it into the tanks.

X Q. 33. Was the bottling done in the cellar or upstairs?

A. On the third and fourth floors.

X Q. 34. Did you have anything to do with selling this?

A. No, sir, I did not.

X Q. 35. Was your position that of foreman during the entire ten years that you were with the Thaddeus Davids Co.?

147 A. About seven years.

X Q. 36. What was your first position with the Company?

A. Ink filler.

X Q. 37. When did you leave the Thaddeus Davids Co.?

A. In 1908.

X Q. 38. Why?

A. Disagreement with the people I was working there with that were put up to work with me.

X Q. 39. Do you mean the people in the cellar?

A. The people on the top floor.

X Q. 40. Was that the office floor?

A. No, sir, the manufacturing floor.

X Q. 41. Manufacturing what?

A. Mucilage, and inks—boiled ink.

X Q. 42. Do you mean that part of the mucilage and inks was made on the top floor, and part of it in the cellar?

A. No, part on the floor below. On the top floor the boiled ink was made, and on the next floor the cold ink. This is in the Van Dam Street place, where we made no ink in the cellar. I worked on both floors (6th and 7th floors) in the Van Dam Street building, and I worked in the cellar in the William Street Bldg., before we moved to Van Dam Street. When they were at the William Street place we made ink in the cellar.

X Q. 43. You mean all ink in the cellar, do you?

A. No, not all on William Street. All the ink that was in bulk, outside of fancy inks, and that was made on the third floor on William Street. The fancy inks were made on the third floor in Van Dam Street.

X Q. 44. Did this trouble that you speak of with the men put up for you to work with, have anything to do with the Labor Union?

A. No, it did not.

148 X Q. 45. It was entirely personal, was it?

A. Yes, entirely personal altogether.

X Q. 46. Did you leave of your own accord, or were you discharged?

A. I left of my own accord, as I had a man up against me who I couldn't work with and I thought it was time to leave.

X Q. 47. And did you then start in business for yourself?

A. No, sir, I did not.

X Q. 48. What did you do next?

A. Well I walked around for a couple of weeks waiting for a job on board a ship.

X Q. 49. When you say that you are a manufacturer of inks, mucilage and paste, do you mean to say that you are in business for yourself, or in the employ of somebody else?

A. In the employ of somebody else.

X Q. 50. What is the name of the house that you are employed with?

A. Davids Manufacturing Company.

X Q. 51. Do you mean the business run by C. I. Davids and W. I. Davids?

A. Yes, sir.

X Q. 52. Did you know those two gentlemen when they were in the employ of the Thaddeus Davids Co.?

A. Yes, sir. I did.

X Q. 53. Do you call water an adulterant of ink?
A. What do you mean, manufacturing ink?
X Q. 54. Well I don't mean printers' ink, I mean commercial ink, writing ink.
A. Yes, sir.
X Q. 55. Isn't all writing ink made partly of water?
A. The biggest part of it, yes, sir.
X Q. 56. Do you mean that the biggest part of ink is made with water, or that the biggest part of ink is water?
149 A. The biggest part of ink is water.

Redirect examination by Mr. NEWELL:

R. D. Q. 57. If I understand you correctly, you left the Thaddeus Davids Co. of your own accord, and then waited about two weeks to get a job on a steamship?
A. Yes, the Clyde Line.
R. D. Q. 58. Did either Mr. C. I. Davids or W. I. Davids come to you and ask you to go in their employ, or did you apply to them for employment?
A. I applied to them for empolyment.
R. D. Q. 59. Did they have anything at all to do with your leaving the Thaddeus Davids Co.?
A. No, sir.

JOHN P. O'HANLON.

Adjourned subject to agreement.

NEW YORK, N. Y., *Dec.* 20, 1910.

Met pursuant to adjournment.
Present: Counsel as before.

CORTLANDT I. DAVIDS, being recalled for defendants, testifies as follows:

Q. 1. You are the Cordtlandt I. Davids who testified heretofore?
A. Yes.
Q. 2. I show you here an ink-bottle of the Davis Ink Company, St. Louis, Missouri, and ask you how long you have known it to be on the market in the United States with this label thereon?

The bottle and label produced are introduced by defendants and marked as Defendant's Exhibit "Davis Ink Company label."

A. I have seen them myself on the market for over four years, and I believe they have been on the market for a number of
150 years prior to that. People complained to the Thaddeus Davids Co. while I was in their employ that they had been victimized by this same label.
Q. 3. Have you reason to belive that inks bearing these labels were on the market previous to 1905 in the United States?
A. Yes, sir, I have.
Q. 4. And to the knowledge of the Thaddeus Davids Co.?
A. Yes, sir.

Q. 5. Did the Thaddeus Davids Company ever take any action against the Davis Ink Company, so far as you know?

A. No, they did not.

Q. 6. I show you here an ink bottle bearing a label which in part reads "The Emry Davis Writing Fluid, Emry Davis, New York." Would your answer be the same in regard to this label?

A. Well, I know that they have used some form of label with Emry Davis' name on it, but whether it is that exact label or not, I cannot say. I, however, believe, it was.

Q. 7. Has Emry Davis been using such label for the same length of time?

A. Yes, I believe for even a longer time.

The bottle and label referred to are introduced herewith as an exhibit and marked as Defendant's Exhibit "Emry Davis Label."

Q. 8. Do you know where Emry Davis got this ink from?

A. At the time I was employed by the Thaddeus Davids Co., Emry Davis bought the ink in bulk from the Thaddeus Davids Company and bottled it.

Complainant's counsel, for the purpose of this case, admits
151 that bottles like Defendant's Exhibit "Davis Ink Co. Label," containing ink and bearing said label, have been sold in New York City by people not connected with this litigation for a number of years from date and extending back earlier than the year 1905. In making this admission counsel reserves the right to call witnesses to explain the history of this ink on the New York market, but not to contradict the above admission.

Complainant's counsel also admits that the Thaddeus Davids Co. have for many years, and extending back beyond the year 1905, sold in bulk to Emry Davis of New York City ink which said Emry Davis has put upon the market, bearing labels containing the name Emry Davis, the label on the exhibit herein introduced being one of the present labels of said Emry Davis, and counsel for complainant will produce other labels which he concedes had been used by said Emry Davis upon inks purchased from the Thaddeus Davids Co. during said period; reserving the right to explain, but not contradict.

Q. 9. On page 13 of Defendants' Exhibit "Complainant's Price List" is shown a label of the Thaddeus Davids Company reading "Davids Non-Copying Carmine Ink." Have you made any tests with this ink to see whether or not it will copy?

A. Yes, sir; I have.

Q. 10. Will it copy, or will it not?

A. Yes, it will produce a good copy.

Q. 11. You mean by the ordinary letter-press method?

A. Yes, sir, with the usual oil board and dampened blotter or paper.

152 Q. 12. Where did you buy this ink which copied, as you say?

A. It was purchased this morning at the Thaddeus Davids Co sales-rooms.

Q. 13. Is the statement on the label that this ink is "Non-Copying" therefore correct or not?
A. It is not correct.

Cross-examination by Mr. PREBLE:

X Q. 14. The bottle marked Defendants' Exhibit "Davis Ink Company Label" is a nold Hunyadi Janos bottle, is it not?
A. It looks like it, and there is a mark of Hunyadi Janos on the bottom of the bottle, blown in the glass.
X Q. 15. This so-called "Davis Ink Company" ink was a sort of fake, wasn't it?
A. I should say it was.
X Q. 16. That's what you had in mind when you said that there were complaints made to the Thaddeus Davids Co. that they were being victimized by it?
A. Yes, that the ink was no good.

Redirect examination by Mr. NEWELL:

R. D. Q. 17. What you mean by "a fake" is that this Davis Ink Company's ink was of extremely poor quality, is that correct?
A. That's correct.

Recross-examination by Mr. PREBLE:

R. X Q. 18. I think you mean a little more than that. Were you not aware of the fact that this so-called "Davis" ink was peddled about in New York City by persons pretending to represent the Davis Ink Company of St. Louis, who offered to supply a quart bottle free on receipt of 25 cents to cover expressage, and that the enterprise was a swindle?
153 A. Why, yes, they offered to sell quarts of ink, I have been told by the purchasers of it, for 25 cents a quart, but I was not told of the "express" condition of same. It was a swindle, there's no question about that, because it was such poor ink.
R. X Q. 19. And also because if a man so solicited paid his 25 cents in advance, he never got any ink at all?
A. That may be true.
Neither I nor my son, nor any one connected with us, were ever in any way connected with this Davis Ink Company, or the sale of its ink.
I remember that about 2½ years ago, after the defendant Company had started in business, I received a postal card from a party, whose name I don't recall, on lower Broadway, asking me to call in regard to ink. I went down there and he brought out a bottle with a label thereon, the same as Defendants' Exhibit "Davis Ink Co. label," and asked me to bring down a good bottle of ink for it as that was no good. He said he thought it was our ink and that was the reason he wrote us the postal, so that we could make it good. Of course it wasn't our ink, and I told him so.

CORTLANDT I. DAVIDS.

Defendant Rests.
[9228]

154 Circuit Court of the United States, Southern District of New York.

THADDEUS DAVIDS COMPANY, Complainant,
vs.
COURTLANDT I. DAVIDS et al., Trading as the Davids Manufacturing Company, Defendants.

Final Hearing in Equity.

Mr. Preble for complainant;
Mr. Newell for defendants.

HOUGH, *D. J.*:

The bill herein is in the main for infringement of complainant's registered trademark "Davids," as applied to "writing inks of all varieties, hectograph ink, showcard indelible and stamping ink and stamp-pads."

United with this cause of action, however, are allegations of "unfair and unlawful competition on the part of defendants," although all parties to the litigation are residents of this State and district. It is therefore necessary to dismiss from consideration all allegations and evidence relating to unfair competition and to regard the matter not only as one of trademark law alone (National Casket Co. v. New York & Brooklyn Casket Co., 185 Fed Rep., 533), but as a trademark case in which jurisdiction depends solely on registration under the Act of February 20, 1905.

A demurrer herein was before the Circuit Court of Appeals in 178 Fed Rep., 801. The bill of complaint is there sufficiently summarized. The scope of that decision is vitally important now that the cause has come on for hearing upon evidence.

It is understood that that decision held that "Davids'," being the name of the founder of complainant's business, could not be "a valid common law trademark," but it might be a "mark used as a trademark," and might therefore be registered under Section 5 of the Trademark Act of February 20, 1905. It was also declared that the act made "a mark actually and exclusively used for the requisite period (ten years) entitled to registration as a tradmark;" and finally it was asserted that if it be "entitled to registration it is entitled to protection." It is not declared that the "mark" which is an invalid common law trademark, shall be entitled to protection only as a mark; but it is said that "we are unable to appreciate the distinction sought to be drawn by the defendant between the right to register a trademark and the right to protect it." It follows from the language of the higher Court that since the "mark" may be registered as a trademark and is entitled to protection, it is entitled to protection as a trademark, which is equivalent to saying that it becomes a valid trademark by registration. This

seems to be the congressional intention, for Section 5 was amended on February 11, 1911, by adding the proviso

"that nothing herein shall prevent the registration of a trademark otherwise registerable because of its being the name of the applicant or a portion thereof";

and it is also important that the original act in Sec. 29 declares that

"The term 'trade-mark' includes any mark which is entitled
156 to registration under the terms of this Act and whether registered or not and a trade-mark shall be deemed to be 'affixed' to an article when it is placed in any manner in or upon either the article itself or the receptacle or package or upon the envelope or other thing in, by, or with which the goods are packed or inclosed or otherwise prepared for sale or distribution."

The question presented by this litigation is therefore this,—to what measure of relief is one entitled, who owns as a valid trademark a word which before registration under the statute he could not protect at law, without invoking the doctrine of unfair competition?

It is to be regretted that sharp distinction was ever drawn between that trespass on property rights called trademark infringement, and the exactly similar trespass commonly spoken of as unfair competition,—but since the distinction has not only become well known, but been made a basis for limiting jurisdiction, it is necessary here to find infringement of trademark according to strict rules, if complainant is to be entitled to any relief.

Trademark infringement is the use by defendant,—for trading purposes,—and in connection with goods of the kind as to which complainant's exclusive right exists,—of a mark identical with complainant's or colorably resembling it. The wrongful imitation need not be exact or perfect, but may be limited or partial. McLean vs. Fleming, 96 U. S., 245; Saxlehner vs. Eisner, etc., Co., 179 U. S., 19. Within these familiar rules it would seem that any use of the word "Davids" in connection with inks would be infringement, and very interesting questions would arise did the bill seek to enjoin any and every use of defendants' own names in conjunction
157 with the manufacture of an article which is free for all. The bill, however, asks only that defendants be enjoined from the use of complainant's trademark in their trade name of "Davids Manufacturing Company," and also from the use of the word "Davids" at the top of their labels in connection with the business of making and selling inks, etc.

Since it has been held that a proper name can under the circumstances here existing become a valid trademark, then such trademark must receive the same kind and extent of protection as would be accorded to an arbitrary or fanciful name selected for euphony or quaintness, and associated with a particular kind of goods made by a particular person. Thus if complainant's trademark were not "Davids," but "Davyne" (an actual word at present wholly unrelated to ink), defendants would plainly not be permitted to sell, advertise or mark inks as those of the "Davyne Manufacturing Com-

pany," nor to use the word "Davyne" prominently upon their labels. Undoubtedly this statute as construed limits some rights heretofore thought to have been secured to all men in respect of the use of their own names, yet such in my judgment is the logical result of the decision first referred to, and the legislative intent as shown by recent amendment.

The evidence herein conclusively shows that defendants do display the word "Davids" very prominently at the top of their labels and elsewhere, and transact all their business under the trade name of "Davids Manufacturing Company." From these acts (in relation to inks) let them be restrained according to the prayer of the bill, which is for an injunction only and not for an accounting.

C. M. HOUGH, *D. J.*

June 22, 1911.

158 *Note.*

Three defences are urged that will merely be noted:

1st. It is said that complainant has long so misled the public in respect of its products that its trademark is not deserving of protection within such cases as Worden vs. California Fig Syrup Co., 187 U. S., 282. The trademark is the single word "Davids." How that single word can convey or be used to convey any false impression to the public is difficult to see; but entirely apart from this, I am of opinion that the complaints made by the defendants are without merit if they are not frivolous, viz: that "Electro-chemical Writing Fluid" is not prepared by any electrical process; that "Oriental Carmine Ink" does not come from the Orient, and is not based on extract of cochineal, and that "Silk Filtered Ink" is no longer silk filtered, although it once was.

2d. The registration of complainant's trademark is said to be invalid because complainant and its predecessors had not had exclusive use thereof for the statutory period. The only evidence to support this contention is that an impostor named Davis sold "Davis Inks" to people who thought they were buying Davids' Ink. The exclusive use of a trademark means rightfully exclusive use, and is not disturbed by an unsuccessful effort to steal the same, nor even by furtive and partial success in making some profit out of the attempted theft.

3d. Complainant's trademark has not been used in interstate or foreign commerce. This is plainly disproved by the evidence.

The contention as to Gum Arabic, Gum Ghatti or Gum Senegal is not noticed, jurisdiction depends on registration and the
159 trademark registered has to do with inks only, not mucilage or paste.

(Endorsed:) U. S. Circuit Court, Southern District, N. Y.—Filed Jun. 22, 1911.—John A. Shields, Clerk.

Circuit Court of the United States, Southern District of New York.

In Equity.

THADDEUS DAVIDS COMPANY, Complainant,
vs.
CORTLANDT I. DAVIDS et al., Trading as the Davids Manufacturing Company, Defendants.

Decree.

This cause having duly come on for final hearing, before me, at the term of April, 1911, upon pleadings and proofs, and having been argued by Counsel for the respective parties, and on due deliberation, it is:

Ordered, adjudged and decreed, that United States registered trade-mark No. 59,898, issued to complainant herein on the 22nd day of January, 1907, is a good and valid trade-mark; that the defendants have infringed the same by selling, advertising and marking their inks, as those of the Davids Manufacturing Company, and by using the word "Davids" prominently upon their labels.

And it is further ordered, adjudged and decreed, that a
160 perpetual injunction issue forthwith out of and under the seal of this Court, directed to the said defendants, Cortlandt I. Davids and Walter I. Davids, their servants, agents and attorneys, forever enjoining and restraining them as prayed in the bill of complaint herein from the use of the words "Davids Manufacturing Company," and from the use of the word "Davids" at the top of their labels in connection with the business of making and selling inks.

And it is further ordered, adjudged and decreed, that the complainant do have and recover from said defendants, its costs, charges and disbursements in this suit, to be taxed by the Clerk of this Court.

By consent of both parties, it is further ordered that the injunction and all proceedings in this cause be stayed until the hearing of the appeal to be taken by the defendants from this decree and the handing down of the mandate upon such appeal.

(Signed) C. M. HOUGH, *U. S. Judge.*

Dated July 19, 1911.

Approved as to form.

(Signed) EMERSON R. NEWELL,
Solicitor and Counsel for Defendants.

(Endorsed:) U. S. Circuit Court, Southern District N. Y.—Filed Jul. 20, 1911.—John A. Shields, Clerk.

161 United States Circuit Court, Southern District of New York.

In Equity, #2-18.

THADDEUS DAVIDS COMPANY,

vs.

CORTLANDT I. DAVIDS and WALTER I. DAVIDS, Trading as Davids Mfg. Co.

Petition for Appeal.

To the Honorable the Judges of the Circuit Court of the United States in and for the Second Circuit:

The petition of Cortlandt I. Davids and Walter I. Davids, trading as the Davids Mfg. Company, the above-named Defendant, respectfully shows:

Your petitioner, Cortlandt I. Davids et al., trading as the Davids Mfg. Company, considering themselves aggrieved by the final decree granting an injunction made and entered the 20th day of July, 1911, in the above-entitled action, does hereby appeal from said decree to the United States Circuit Court of Appeals for the Second Circuit, for the reasons specified in the assignment of errors which is filed herewith, and it prays that this appeal may be allowed and that a transcript of the record, proceedings and papers upon which said decree was made, duly authenticated, may be sent to the

162 United States Circuit Court of Appeals for the Second Circuit.

EMERSON R. NEWELL,
Solicitor for Defendants.

#2 Rector St., N. Y. City, N. Y.

The foregoing petition for appeal is hereby allowed this 26th day of August, 1911.

E. HENRY LACOMBE,
U. S. Judge.

Service of a copy of the within Petition for Appeal acknowledged this 24th day of August, 1911.

W. P. PREBLE, JR.,
Solr. & Counsel for Complainant-Appellee.

(Endorsed:) U. S. Circuit Court, Southern District, N. Y. Filed Aug. 26, 1911. John A. Shields, Clerk.

United States Circuit Court, Southern District, New York.

In Equity. Nos. 2-18.

THADDEUS DAVIDS COMPANY
vs.
CORTLANDT I. DAVIDS and WALTER I. DAVIDS, Trading as Davids Mfg. Co.

Assignment of Errors.

Now comes Cortlandt I. Davids and Walter I. Davids, trading as the Davids Mfg. Company, the defendants above named, by
163 its solicitor, Emerson R. Newell, and presents, with the accompanying petition for appeal from the decree in this case, the following assignments of error:

(1) The Court erred in not dismissing the Bill of Complaint for want of equity and with costs to the defendants;

(2) The Court erred in not deciding that this cause was contrary to Section 21 of the Trade-Mark Law as amended by Act of February 20, 1905;

(3) The Court erred in not deciding that the complainant's trade-mark was invalid; at least as against these defendants;

(4) The Court erred in not holding the registration of complainant's trade-mark invalid as not complying with the ten-year clause of Section 5 of the Trade-Mark Act as amended February 20, 1905; and

(5) The Court erred in finding that defendant had infringed complainant's trade-mark.

Wherefore the defendant prays that the decree may be reversed in the particulars heretofore set forth, with costs to the defendant, and for such other and further relief as shall seem just in the premises.

EMERSON R. NEWELL,
Solicitor & Counsel for Defendant.

No. 2 Rector Street, N. Y. City.

(Endorsed:) Service of a copy of the within Assignment of Errors acknowledged this 24th day of August, 1912. W. P. Preble, Jr., Solr. & Counsel for Complainant-Appellee. U. S. Circuit Court, Southern District N. Y. Filed Aug. 25, 1911. John A. Shields, Clerk.

164 *Bond.*

A Bond in the sum of Two Hundred Dollars ($200.00) was approved by Judge Lacombe on the 26th day of August, 1911, and filed on the same day in the Clerk's Office by the defendants, Cortlandt I. Davids and Walter I. Davids, trading as Davids Mfg. Co.

United States Circuit Court, Southern District, New York.

In Equity. Nos. 2-18.

THADDEUS DAVIDS COMPANY
vs.
CORTLANDT I. DAVIDS and WALTER I. DAVIDS, Trading as Davids Mfg. Company.

Citation.

UNITED STATES OF AMERICA, *ss:*

The President of the United States of America to Thaddeus Davids Company, Greeting:

Whereby the above-named defendants, Cortlandt I. Davids and Walter I. Davids, trading as the Davids Mfg. Company, have lately appealed to the United States Circuit Court of Appeals for the Second Circuit from the final decree granting an injunction in your favor and against them in the Circuit Court of the United States in and for the Southern District of New York, on the 20th day of July, 1911.

165 You are hereby cited and admonished to appear before the United States Circuit Court of Appeals for the Second Circuit, at the City of New York, in the Southern District of New York, on the 25th day of September, 1911, to show cause why said decree should not be reversed and speedy justice done in that behalf.

Given under my hand at the City of New York, in the Southern District of New York in the Second Circuit, this 26th day of August, 1911.

E. HENRY LACOMBE.
U. S. Circuit Court Judge.

(Endorsed:) United States Circuit Court Southern District New York. Thaddeus Davids Company vs. Cortlandt I. Davids and Walter I. Davids, trading as Davids Mfg. Co. In Equity No. 2-18. Citation. Emerson R. Newell, Sol'r for Def'nd't-Appellant. #2 Rector St., N. Y. City. Service of a copy of the within Citation acknowledged this 24th day of August, 1911. W. P. Preble, Jr., Solicitor for Complainant, Appellee. U. S. Circuit Court, Southern District N. Y. Filed Aug. 26, 1911. John A. Shields, Clerk.

UNITED STATES OF AMERICA,
Southern District of New York, ss:

I, John A. Shields, Clerk of the Circuit Court of the United States of America, for the Southern District of New York, in the Second Circuit, do hereby certify that the foregoing pages, numbered from one to 167, inclusive, contain a true and complete transcript of the record and proceedings had in said Court, in the cause entitled Thad-

deus Davids Company, Complainant-Appellee, against Cort-
166 landt I. Davids and Walter I. Davids, trading as Davids Mfg. Company, Defendant-Appellants, as the same remain of record and on file in my office.

In testimony whereof, I have caused the seal of the said Court to be hereunto affixed, at the City of New York, in the Southern District of New York, in the Second Circuit, this 22nd day of September, in the year of our Lord One Thousand Nine Hundred and Eleven, and of the Independence of the said United States the One Hundred and Thirty-sixth.

[SEAL.] JOHN A. SHIELDS, *Clerk.*

167 United States Circuit Court of Appeals for the Second Circuit, October Term, 1911.

No. 128.

Argued December 19, 1911. Decided January 8, 1912.

THE THADDEUS DAVIDS COMPANY, Complainant-Appellee,
against
CORTLANDT I. DAVIDS and WALTER I. DAVIDS, Trading as Davids Manufacturing Company, Defendants-Appellants.

Appeal from the Circuit Court of the United States for the Southern District of New York.

Before Coxe, Ward and Noyes, Circuit Judges.

On appeal from a decree of the Circuit Court for the Southern District of New York restraining the defendants from infringing the complainant's registered trade-mark "Davids."

Emerson R. Newell, for the Appellants.
W. P. Preble, Jr., for the Appellee.

COXE, *J.:*

We have held that the surname "Davids" was a valid trade-mark under the ten-year clause of the Act of 1905, Davids v. Davids, 178 Fed. 801. The question now to be considered is—Do the defendants infringe? We see no reason why the defendant, Cortlandt I. Davids, who is a lineal descendant of the original Davids, who established the complainant's business, may not engage in the
168 manufacture and sale of ink and use his own name in the business. He has the same right to use his own name as if it were Jones or Smith. Howe Scale Co. v. Wyckoff, 198 U. S. 118. Indeed, this right is expressly conceded by the bill. The contention of the complainant is that though the defendant may use his name, Cortlandt I. Davids, on the label, he has no right to use it at the top of his label, which, in all other important respects,

is dissimilar to the complainant's labels. It must be remembered, however, that we are not dealing with a case of unfair competition, but with the case of a registered trade-mark pure and simple, the trade-mark consisting of the single word "Davids." The use of this word is not limited to any particular position on the label and it is impossible to conceive that its position at the top of the label will be an infringement and its use at the bottom, or in the middle of the label, will not infringe. It follows, therefore, that the conceded right of the defendant to use his name cannot be unlawful if used at the top of his label. If he has a right to use his own name in business he has a right to use it anywhere. He has a right to place it where the proof shows it is generally placed by the manufacturers of ink, namely, at the top of his label. The location of the trade-mark is not an element, especially where no mention of the location is made in the statement or declaration. The "statement" says upon this point that:

"It is customary to print the mark upon the labels which are attached to the receptacles containing the goods."

The use by the defendants of the words "Davids Manufacturing Company" at the bottom of their label is not, in our judgment, an infringement of the registered trade-mark. The complainant has, we think, confused his right of action which is for infringement of its trade-mark with an action for unfair competition. We have no jurisdiction of the latter action as the parties are all citizens of the State of New York. If the complainant is satisfied that it can maintain an action for unfair competition, it should present it to the courts of New York which alone have jurisdiction.

The decree is reversed with costs.

169 United States Circuit Court of Appeals for the Second Circuit, October Term, 1911.

No. 128.

Argued December 19, 1911. Decided January 8, 1912.

THE THADDEUS DAVIDS COMPANY, Complainant-Appellee,
against
CORTLANDT I. DAVIDS and WALTER I. DAVIDS, Trading as Davids Manufacturing Company, Defendants-Appellants.

Appeal from the Circuit Court of the United States for the Southern District of New York.

Before Coxe, Ward and Noyes, Circuit Judges.

NOYES, *Circuit Judge* (dissenting):

We have held that the complainant has a valid registered trade-mark in the name "Davids." This requires us to hold, as it seems to me, that the prominent use of the same name in the same

business by the defendants should be enjoined. If the decision of the majority be well founded, we meant little in saying in our original opinion that if a mark "is entitled to registration it is entitled to protection." It must now be accepted that while surnames may become valid registered trade-marks, they are infringed only by the use of the name standing by itself; there is no latitude in protecting them and they can be practically appropriated with impunity.

170 At a Stated Term of the United States Circuit Court of Appeals in and for the Second Circuit, Held at the Court Rooms in the Post-office Building in the City of New York, on the 18th Day of January, One Thousand Nine Hundred and Twelve.

Present: Hon. Alfred C. Coxe, Hon. Henry G. Ward, Hon. Walter C. Noyes, Circuit Judges.

THADDEUS DAVIDS COMPANY, Complainant-Appellee,
vs.
CORTLAND I. DAVIDS and Another, Defendants-Appellants.

Appeal from the Circuit Court of the United States for the Southern District of New York.

This cause came on to be heard on the transcript of record from the Circuit Court of the United States, for the Southern District of New York, and was argued by counsel.

On consideration whereof, it is now hereby ordered, adjudged and decreed that the decree of said Circuit Court be and it hereby is reversed with costs.

A. C. C.
H. G. W.

It is further ordered that a Mandate issue to the District Court in accordance with this decree.

171 Endorsed: United States Circuit Court of Appeals, Second Circuit. Davids Co. vs. T. I. Davids and Ano. Order for mandate. United States Circuit Court of Appeals, Second Circuit. Filed Jan. 18, 1912. William Parkin, Clerk.

172 UNITED STATES OF AMERICA,
Southern District of New York, ss:

I, William Parkin, Clerk of the United States Circuit Court of Appeals for the Second Circuit, do hereby Certify that the foregoing pages, numbered from 1 to 171 inclusive, contain a true and complete transcript of the record and proceedings had in said Court, in the case of Thaddeus Davids Company against Cortland I. Davids and another as the same remain of record and on file in my office.

In Testimony Whereof, I have caused the seal of the said Court to be hereunto affixed, at the City of New York, in the Southern District of New York, in the Second Circuit, this 30th day of January in the year of our Lord One Thousand Nine Hundred and Twelve and of the Independence of the said United States the One Hundred and thirty-sixth.

[Seal United States Circuit Court of Appeals, Second Circuit.]

WM. PARKIN, *Clerk.*

173 UNITED STATES OF AMERICA, *ss:*

The President of the United States of America to the Honorable the Judges of the United States Circuit Court of Appeals for the Second Circuit, Greeting:

[Seal of the Supreme Court of the United States.]

Being informed that there is now pending before you a suit in which Cortlandt I. Davids and Walter I. Davids, trading as Davids Manufacturing Company, are appellants, and The Thaddeus Davids Company is appellee, which suit was removed into the said Circuit Court of Appeals by virtue of an appeal from the Circuit Court of the United States for the Southern District of New York, and we, being willing for certain reasons that the said cause and the record and proceedings therein should be certified by the said Circuit Court of Appeals and removed into the Supreme Court of the
174 United States, do hereby command you that you send without delay to the said Supreme Court, as aforesaid, the record and proceedings in said cause, so that the said Supreme Court may act thereon as of right and according to law ought to be done.

Witness the Honorable Edward D. White, Chief Justice of the United States, the 6th day of March, in the year of our Lord one thousand nine hundred and twelve.

JAMES H. McKENNEY,
Clerk of the Supreme Court of the United States.

175 [Endorsed:] File No. 23045. Supreme Court of the United States, No. 969, October Term, 1911. Thaddeus Davids Company vs. Cortlandt I. Davids et al. Writ of Certiorari. United States Circuit Court of Appeals, Second Circuit. Filed Mar. 11, 1912. William Parkin, clerk.

176 United States Circuit Court of Appeals for the Second Judicial Circuit.

THADDEUS DAVIDS CO., Appellees,
vs.
CORTLANDT I. DAVIDS et al., Appellants.

In the Matter of Certiorari.

Stipulation.

It is hereby stipulated and agreed by Counsel for the respective parties in the above entitled action that the certified Transcript of Record as filed herein in the office of the Clerk of the Supreme Court of the United States on the 6th day of February 1912 be taken as a return to the Writ of Certiorari granted herein on the 6th day of March 1912 with the same force and effect as if filed in pursuance of said writ.

W. P. PREBLE, JR.,
Counsel for Complainant-Appellees.
E. R. NEWELL,
Counsel for Defendants.

Mar. 8, 1912.

Endorsed: United States Circuit Court of Appeals for the Second Judicial Circuit. Thaddeus Davids Co. appellees vs. Cortlandt I. Davids, et al., Appellants. In the Matter of Certiorari. Stipulation. From the office of W. P. Preble, 150 Nassau Street, New York City. United States Circuit Court of Appeals Sec-nd Circuit. Filed Mar. 11, 1912. William Parkin, Clerk.

177 To the Supreme Court of the United States, Greeting:

The record and all proceedings whereof mention is within made, having lately been certified and filed in the office of the Clerk of the Supreme Court of the United States, a copy of the stipulation of counsel is hereto annexed and certified as a return to the writ of certiorari issued herein.

Dated, New York, March 11th, 1912.

[Seal United States Circuit Court of Appeals, Second Circuit.]

WM. PARKIN,
Clerk of the United States Circuit Court of Appeals for the Second Circuit.

178 [Endorsed:] 969/23045. United States Circuit Court of Appeals, Second Circuit. Thaddeus Davids Co. v. C. I. Davids et al. Return to certiorari.

179 [Endorsed:] File No. 23045. Supreme Court U. S. October Term, 1911. Term No. 969. Thaddeus Davids Company, petitioner, vs. Cortlandt I. Davids et al., etc. Writ of certiorari and return. Filed March 14, 1912.

184

No.

FEB 6 1912

JAMES H. McKENNEY,

Supreme Court of the United States.

OCTOBER TERM, 1911.

No.

RHADOBUS DAVIDS COMPANY,

Petitioner,

vs.

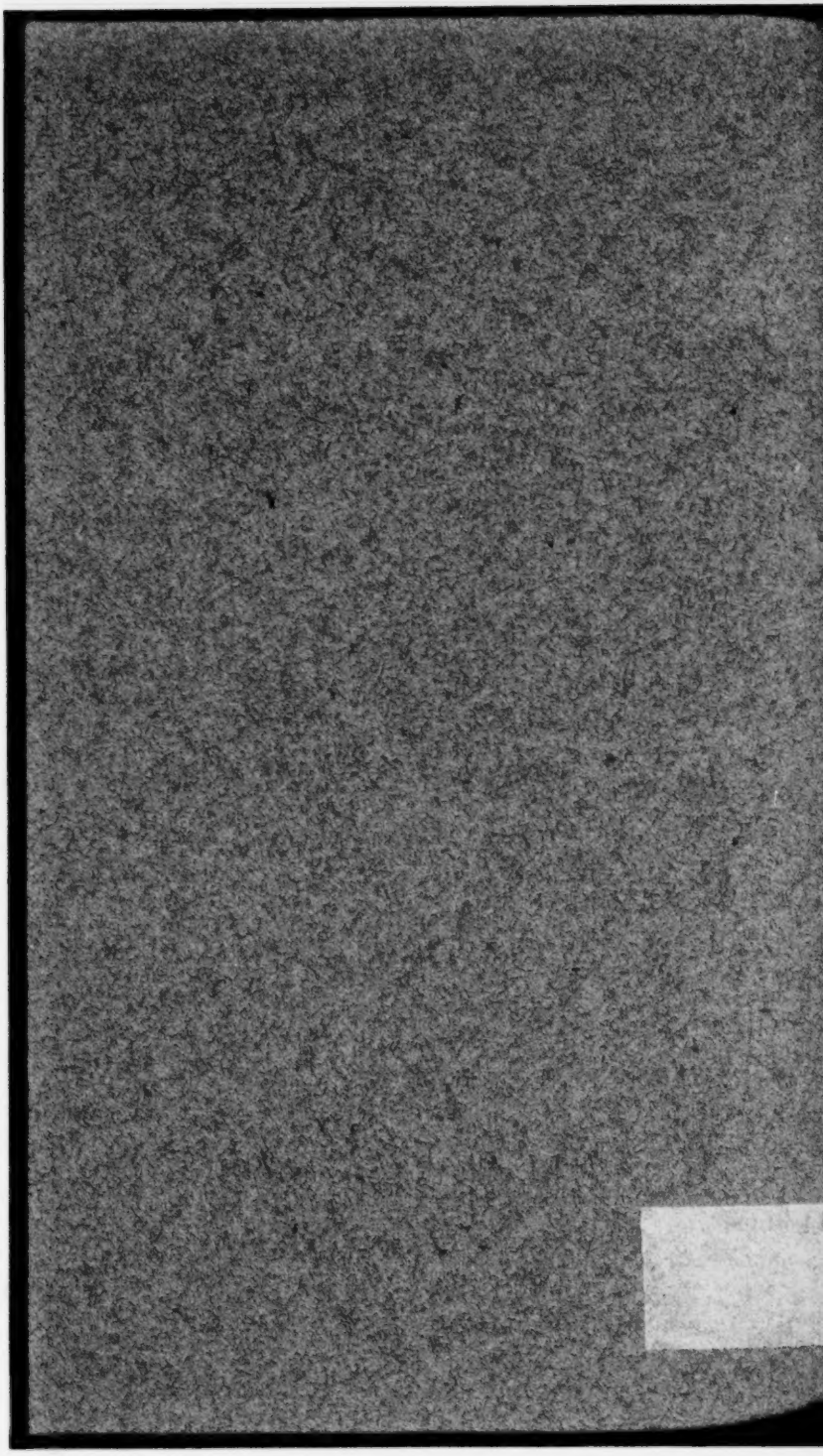
CORTLANDT I. DAVIDS AND WALTER I. DAVIDS, TRADING AS DAVIDS MANUFACTURING CO.,

Defendants.

NOTICE OF MOTION AND PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

W. P. PREBLE,

Attorney and Counsel for Petitioner.



Supreme Court of the United States,

OCTOBER TERM, 1911.

No.

THADDEUS DAVIDS COMPANY,
Complainant-Petitioner,

vs.

C. I. DAVIDS and WALTER I. DAVIDS, trading as DAVIDS MANUFACTURING CO.,
Defendant-Respondent.

Notice of Motion.

TO C. I. DAVIDS AND WALTER I. DAVIDS, THE ABOVE NAMED DEFENDANTS:

Please take notice that on Monday, February 26th, 1912, at the opening of the Court on that day, or as soon thereafter as counsel can be heard, a motion for writ of *certiorari*, of which motion a copy is annexed, will be submitted to the Supreme Court of the United States at Washington, D. C., for the decision of the Court thereon.

In support of said motion a petition and a brief

will also be presented to the Court. A copy of the petition and of the brief are herewith served upon you.

Respectfully,

W. P. PREBLE,
Of Counsel for Petitioners.

New York, January 31, 1912.

Due service of the foregoing notice of motion, the petition and brief in the above cause, is hereby admitted this 30th day of January, 1912.

EMERSON R. NEWELL,
Counsel for Respondents.

SUPREME COURT OF THE UNITED STATES,

OCTOBER TERM, 1911.

THADDEUS DAVIDS COMPANY,
Complainant-Petitioner,

vs.

C. I. DAVIDS and WALTER I. DAVIDS, trading as Davids Manufacturing Co.,
Defendants-Respondents.

Motion.

And now comes the Thaddeus Davids Company, the above named petitioner, by W. P. Preble, its attorney and counsel, and moves this Honorable Court for a writ of *certiorari* directed to the Honorable, the Judges of the United States Circuit Court of Appeals within and for the Second Judicial Circuit, commanding them forthwith to certify and return to this Court all proceedings by them had in the suit lately before them wherein this petitioner was complainant and appellee, and the said C. I. Davids and Walter I. Davids were defendants and appellants.

The matter involved herein relates to the validity and infringement of United States Registered Trade-mark No. 59,898 issued to complainant January 22, 1907, for the surname "Davids" used on Inks and Stamp Pads. Said trade-mark was held valid by said Circuit Court of Appeals, upon demurrer, April 10, 1910, as reported 178 Federal Reporter 801, the Court saying, "and if it is entitled to registration, it is entitled to protection," but when the case came up again on the merits to said Circuit Court of Appeals in spite of the fact that the character of the

alleged infringement was the same as on the first appeal, the majority of said Court failed to extend to said trade-mark, the protection to which it had previously stated that said trade-mark was entitled and reversed the Court below, his Honor Judge Noyes filing a dissenting opinion.

While all four judges therefore have sustained the validity of said trade-mark, they are evenly divided on the question of infringement. The question is one of great public importance as, if the majority decision is taken as the law of the land, it will affect thousands of trade names which consist of the surnames of the manufacturers as Rogers, Edison, Westinghouse, Remington, Waterman, Huyler, Smith & Wesson, Winchester, etc., etc.

THADDEUS DAVIDS COMPANY,
Petitioner,
By W. P. PREBLE,
Attorney & Counsel.

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1911.

No.

THADDEUS DAVIDS COMPANY, Petitioner *in re* Petition for writ of *certiorari*, requiring the Circuit Court of Appeals in and for the Second Circuit, to certify to the Supreme Court for review and determination the case of the Thaddeus Davids Company, Complainant-Appellee,

vs.

CORTLAND I. DAVIDS & WALTER I. DAVIDS, trading as DAVIDS MANUFACTURING CO., Defendants-Appellants.

PETITION.

TO THE HONORABLE THE SUPREME COURT OF THE UNITED STATES, THE PETITION OF THE THADDEUS DAVIDS COMPANY, RESPECTFULLY SHOWS:

1. That petitioner, the Thaddeus Davids Company a New York corporation is an Ink Manufacturer at No. 95 Vandam Street, New York City. The respondents, Cortlandt I. Davids and Walter I. Davids are citizens of the State of New York, copartners in the ink business at No. 79 Cortlandt Street, New York City.

2. That this suit was brought mainly for an injunction against infringement by defendants of

United States Trade-mark No. 59,898, dated January 22, 1907 and issued to petitioner under the ten-year clause of section 5 of the Trade-mark Act of February 20, 1905 for the surname "Davids" which had been used continuously in business as a Trade-mark by petitioner and its predecessors for eighty years next preceding the passage of said act and had been in the actual and exclusive use as a trade-mark of the applicant for ten years next preceding the passage of said act.

3. That by reason of the persistent use of the word Davids on petitioner's inks, they have become universally known throughout the United States as "Davids' Inks"; the large variety of inks sold by petitioner being all known and distinguished from the inks of other manufacturers by the word Davids, but distinguished from each other by the special label, such as Davids' Chemical Writing Fluid, Davids' Brilliant Scarlet Ink, Davids' Combined Writing and Copying Ink, Davids' Oriental Red Ink, Davids' Superior Unchangeable Blue Ink, Davids' Excelsior Violet Ink, Davids' Chemical Copying Ink, Davids' U. S. Copying Ink, Davids' Marking Ink, David's Magic Black, Davids' New York School Ink, Davids' Oriental Carmine Ink, Davids' Non-copying Carmine Ink, Davids' Silk-filtered Fountain Pen Ink, Davids' Excelsior Stamping Ink, Davids' Brilliant Carmine Ink, Davids' Brilliant Green Ink, etc.

4. That the specific act of infringement complained of as affecting said registered trade-mark consisted, as plainly alleged in the bill of complaint, in setting the word Davids prominently at the top of defendant's label as used upon inks, that being the place on the label on which petitioner customarily placed its registered trade-mark Davids.

5. That defendants demurred to said bill on two grounds; first, that the registered trade-mark was

invalid on its face; second, that the act of infringement of said trade-mark alleged in the bill of complaint was not an infringement of said registered trade-mark, but was only, if anything, unfair competition.

6. On December 16, 1908, this demurrer was sustained by the Circuit Court of the United States for the Southern District of New York on both of these general grounds, the Court holding that the trade-mark was not valid, and that the use of the name Davids at the top of the label was no infringement.

7. On April 18, 1910, the Circuit Court of Appeals for the Second Circuit handed down the opinion, Exhibit A (178 Federal Reporter, 801), reversing the decree and remanding the cause with instructions to overrule the demurrers and thereupon proceed in accordance with the rules and practice in equity.

8. That in said opinion the Circuit Court of Appeals said: "We are unable to appreciate the distinction sought to be drawn by the defendant between the right to register a trade-mark and the right to protect it." This language was used by said Court with full knowledge of the fact that the trade-mark in question was the surname Davids alone, and that the infringement specifically complained of was using the word Davids as a part of the name C. I. Davids prominently at the top of defendants' label, where the public was accustomed to look for petitioner's surname as the distinctive mark for its inks.

9. Proofs were taken on both sides and on June 22, 1911, his Honor Judge Hough in said Circuit Court of the United States for the Southern District of New York, handed down the decision marked Exhibit B, sustaining the validity of the trade-mark and finding that the same had been infringed in the following language: "Since it has

been held that a proper name can under circumstances here existing become a valid trade-mark, then such trade-mark must receive the same kind and extent of protection as would be accorded to an arbitrary or fanciful name." And thereupon held that the use of the word Davids very prominently at the top of defendants' labels was an infringement of your petitioner's registered trade-mark on the word Davids.

10. Your petitioner had not asked for damages, but only for an injunction. The injunction asked for was not against any and all use of the word Davids, but only against the *trade-mark* use of the word Davids which consisted in using that word at the top of the labels in connection with the business of making and selling inks. The decree issued went only to that effect.

11. Defendants appealed and on January 8, 1912, two of the Judges of the Circuit Court of Appeals for the Second Circuit, Judges Coxe and Ward, handed down the decision marked Exhibit C, in which they hold that the use of the word Davids as a part of the name C. I. Davids, at the top of the respondent's label, is not an infringement of your petitioner's registered trade-mark.

12. On the same day, the third Judge of the Circuit Court of Appeals, Judge Noyes, handed down a dissenting opinion marked Exhibit D, in which he says: " We have held that the complainant has a valid registered trade-mark in the name of Davids. This requires us to hold, as it seems to me, that the prominent use of the same name in the same business by the defendants should be enjoined."

13. That the decree of said Circuit Court of Appeals was duly entered and its mandate has been issued and said decree is final as regards the Second Judicial Circuit, between the parties, unless this

Honorable Court, of its own motion, should direct the bringing for review the said cause, and determine for the United States the highly important question of whether a valid registered trade mark consisting of a personal name shall be given the same latitude of interpretation with regard to infringement and the same protection as other valid registered trade-marks or shall be so narrowly interpreted and with "No latitude in protecting them," so that they become practically valueless.

Wherefore, petitioner respectfully prays that a writ of *certiorari* may be issued out of and under the seal of this Honorable Court, directed to the United States Circuit Court of Appeals for the Second Circuit, commanding the said Court to certify and send to this Honorable Court, on a day certain, to be therein designated, a full and complete transcript of the record and all proceedings of the said Circuit Court of Appeals in the said cause therein entitled Thaddeus Davids Company, Complainant-Appellee, against Cortlandt I. Davids and Walter I. Davids, trading as Davids Manufacturing Company, Defendants-Appellants, in equity, to the end that the case may be reviewed and determined by this Honorable Court, as provided in Section 6 of the Act of Congress entitled "An act to establish Circuit Courts of Appeal and to define and regulate in certain cases the jurisdiction of the courts of the United States, and for other purposes," approved March 3, 1891, and that your petitioner may have such other and further relief in the premises as to this Court may seem appropriate and in conformity with said act, and that the said judgment of the said Circuit Court of Appeals for the Second Circuit in the said cause and every part thereof may be reversed by this Honorable Court.

Your petitioner will ever pray, etc.

W. P. PREBLE,
Attorney and Counsel.

Exhibit A.

Before COXE, WARD, and NOYES, Circuit Judges.

NOYES, Circuit Judge (after stating the facts as above). It is manifest at the outset that the personal name "Davids" is not a valid common-law trade-mark. It is also clear that its registration would have given it no validity as a registered trade-mark under Trade-Mark Act March 3, 1881, c. 138, 21 Stat. 502 (U. S. Comp. St. 1901, p. 3401). In Howe Scale Co. *v.* Wyckoff, Seamans & Benedict, 198 U. S. 118, 134, 25 Sup. Ct. 609, 612 (49 L. Ed. 972), the Supreme Court said:

> "But it is well settled that a personal name cannot be exclusively appropriated by any one as against others having a right to use it; and, as the name 'Remington' is an ordinary family surname, it was manifestly incapable of exclusive appropriation as a valid trade-mark, and its registration as such could not in itself give it validity."

If, then, the name have validity as a registered trade-mark, it is by virtue of the provisions of section 5 of Trade-Mark Act, Feb. 20, 1905, c. 592, 33 Stat, 725 (U. S. Comp. St. Supp. 1909, p. 1278). This section is printed in full in the footnote, and the ten year clause thereof, upon which the complainant relies, follows:

> "And provided further, that nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several states, or with Indian tribes, which was in actual and exclusive use as a trade-mark of the applicant or his predecessors from whom he derived title for ten years next preceding the passage of this act."

The complainant bases its claim upon this provision and alleges specifically that the name in question

was a mark which had been actually and exclusively used by it and its predecessors as a trade-mark for more than ten years next preceding the passage of the act.

The first question, then, is whether a name must be valid, as a technical trade mark to come within the ten-year clause. If this be so, the clause has no force or effect. Technical trade-marks are entitled to be registered under the act regardless of length of use. The owner of a valid common-law trade-mark may register it any time, and he has no greater or less privilege on account of its long use.

There is no necessity for thus construing the ten-year clause so as to render it ineffective. In our opinion there is a distinction between the words "mark" and "trade-mark" as used in the clause. It provides that nothing shall prevent the registration of any "mark" used as a "trade-mark" for more than ten years. The evident purpose is to permit the registration of marks not amounting to technical trade-marks but which have been long used as such. This is indicated not only by the language of the clause itself, but by the history of the passage of the act through Congress. We fully approve the following language of the Court of Appeals of the District of Columbia in the case *In re* Cahn, Belt & Co., 27 App. Cas. (D. C.) 173, 177:

> "While this act provided generally for the registration of trade marks, the fifth section expressly prohibited the registration as trade-marks of immoral or scandalous matter and public insignia. The last proviso of this section which was in the bill when it passed the House of Representatives was amended in the Senate by twice substituting the word 'mark' for the word 'trade-mark' and in inserting in lieu of 'and lawful' the word 'exclusive'. It is clear to us that these changes were made for the purpose of permitting the registration of marks which were not trade-marks, but which had been actually used as trade-marks by the applicants or their predecessors, from whom they derived title, and in which the

> user had acquired property rights for more than ten years next preceding the passage of the act.
>
> "The last proviso of section 5, as amended and passed, was not intended to provide for the registration of technical trade-marks, for such marks had been cared for elsewhere in this act."

See, also *In re* American Glue Co., 27 App. Cas. (D. C.) 391. Looking at the question from another point of view, it would seem that Congress in the ten-year clause recognized the principle, so often stated by the courts, that words which through association with products have acquired secondary meanings will be protected although not amounting to technical trade-marks, and intended to permit their registration under certain conditions.

The act makes a mark actually and exclusively used the requisite period entitled to registration as a trade-mark. And if it is entitled to registration it is entitled to protection. We are unable to appreciate the distinction sought to be drawn by the defendant between the right to register a trade mark and the right to protect it.

If then we are considering the name "Davids" in relation to the ten-year clause alone, it would seem clear that it comes within its provisions. The name is not a valid common-law trade-mark; but the bill alleges that it is a mark which has for many years been actually and exclusively used by the complainant as a trade-mark. The ten-year clause cannot, however, be separated from the other provisions of the fifth section, which prohibit the registration of certain classes of marks. One possible interpretation of the clause is, therefore, obvious. It may authorize the registration of marks used for the ten-year period provided they are not marks the registration of which is prohibited by other clauses of section 5. This seems to have been the interpretation placed upon the clause in the Cahn case already referred to. The Court said:

> "The section had prohibited the registration of immoral or scandalous matter and

public insignia as trade-marks, no matter how long the same had been before registered, and the proviso only extended the right of registration to marks not within either of the prohibited classes, if such marks had been in actual and exclusive use as a trade-mark during the ten years next preceding the passage of the act.

"The ten-year proviso in no wise relates to the applicant's trade mark for whisky, for the proviso relates only to marks which are not technical trade-marks. Among such marks, the two classes prohibited by the section were not saved by the proviso, and only such marks not prohibited by the section as were in actual and exclusive use for ten years as a trade-mark were to be admitted to registration.

"The act permitted the registration of all trade marks not within the prohibited classes. It is plain this proviso in extending to marks not technical trade-marks the right to registration, intended to confine the marks permitted registration to such as would be legitimate trade-marks under this section."

Now a proviso of Section 5 prior to the ten-year clause is as follows:

> "Provided, that no mark which consists merely in the name of an individual, firm, corporation or association not written, printed, impressed or woven in some particular or distinctive manner * * * shall be registered under the terms of this act"

In view of the numerous decisions holding that a surname cannot be a valid trade-mark—of which law this proviso seems to be declaratory—we see no ground for the contention that it refers only to the full name of an individual or firm. If then the Cahn decision be followed and broadly applied, it would result that the registration of the name "Davids'," being prohibited by the proviso of section 5, was not entitled to registration under the ten-year clause. And were it possible to give any practical effect to the ten-year clause by so doing,

we should be strongly inclined to this conclusion. The difficulty is that such interpretation of the section gives practically no effect to such clause.

As already shown, the clause is ineffective when applied to technical trade-marks because they are entitled to registration irrespective of the length of use. As will be shown, it is practically ineffective if it is applied only to marks used as trade-marks the registry of which is not prohibited by the different provisos in Section 5. This section provides that the following marks shall not be registered: (*a*) Marks comprising immoral or scandalous matter; (*b*) marks simulating flags and coat of arms; (*c*) trade-marks identical with or resembling those used by other; (*d*) marks consisting of the names of individuals, firms, etc., when not printed in a distinctive manner; (*e*) marks descriptive of the character or quality of the goods with which they are used; (*f*) marks consisting of geographical names or terms.

With the exception of the first three classes, this seems to be a fairly complete list of those marks which manufacturers and dealers use in connection with the sale of their goods and which the courts have held not to constitute technical trade-marks. Manifestly if the ten-year clause does not apply to any of these classes of marks, there is practically nothing left for it to operate upon.

In our opinion, any interpretation of the act which renders the ten-year clause of no practical effect should be avoided unless absolutely necessary. Undoubtedly public policy would prevent the registration as trade-marks of marks consisting of immoral or scandalous matter or of flags or coats of arms. It may well be that the same principle would prevent the registration of trade-marks simulating those used by others. But with respect to names, descriptive words, and geographical terms, we are of the opinion that the proviso prevents their registration if they have been in use for less than ten years, but that the ten-year clause entitles

them to registration if they have been actually and exclusively used for more than that period before the passage of the act.

For these reasons we are unable to broadly apply the language of the Cahn decision to the present case. The bill follows the language of the statute and expressly alleges the actual and exclusive use of the mark for the required period. These allegations standing as true upon the demurrer, we reach the conclusion that it is not well founded. We also reach the same result with respect to the special demurrer to the prayers for relief.

Of course the complainant is not entitled to recover the damages prescribed by the trade-mark act unless it has given notice of the registration as required by the act. But this is a suit in equity in which the damages claimed are merely incidental to the equitable relief demanded, and we are not prepared to hold that it would be impossible, under any circumstances, to grant some measure of relief by way of damages under the complaint as it stands.

With respect to the other ground of demurrer to the prayer for relief, it is sufficient to say that, while upon final hearing the Court may not grant such broad relief as is demanded, we cannot say that it is wholly unwarranted by the allegations of the bill.

The decree of the Circuit Court is reversed, with costs, and the cause remanded, with instructions to overrule the demurrers and thereupon proceed in accordance with the rules and practice in equity.

Exhibit B.

CIRCUIT COURT OF THE UNITED STATES

SOUTHERN DISTRICT OF NEW YORK.

THADDEUS DAVIDS COMPANY,
Complainant,

vs.

CORTLANDT I. DAVIDS *et al*,
trading as the DAVIDS MANUFACTURING COMPANY,
Defendants.

FINAL HEARING IN EQUITY.

Mr. PREBLE for complainant;
Mr. NEWELL for defendants.

HOUGH, *D. J.*

The bill herein is in the main for infringement of complainant's registered trademark "Davids'" as applied to "writing inks of all varieties, hectograph ink, show-card indelible and stamping ink and stamp-pads".

United with this cause of action however are allegations of "unfair and unlawful competition on the part of defendants" although all parties to the litigation are residents of this State and district. It is therefore necessary to dismiss from consideration all allegations and evidence relating to unfair competition and to regard the matter not only as one of trademark law alone; (*National Casket Co.* vs. *New York & Brooklyn Casket Co.*, 185 Fed. Rep., 533) but as a trademark case in which juris-

diction depends solely on registration under the Act of February 20, 1905.

A demurrer herein was before the Circuit Court of Appeals in 178 Fed. Rep., 801. The bill of complaint is there sufficiently summarized. The scope of that decision is vitally important now that the cause has come on for hearing upon evidence.

It is understood that that decision held that "Davids'", being the name of the founder of complainant's business, could not be "a valid common law trademark", but it might be a "mark used as a trademark", and might therefore be registered under Section 5 of the Trademark Act of February 20, 1905. It was also declared that the act made "a *mark* actually and exclusively used for the requisite period (ten years) entitled to registration as a trademark"; and finally it was asserted that if it be "entitled to registration it is entitled to protection". It is not declared that the "mark" which is an invalid common law trademark shall be entitled to protection only as a mark; but it is said that "we are unable to appreciate the distinction sought to be drawn by the defendant between the right to register a trademark and the right to protect it." It follows from the language of the higher Court that since the "mark" may be registered as a trademark and is entitled to protection, it is entitled to protection as a trademark, which is equivalent to saying that it becomes a valid trademark by registration. This seems to be the congressional intention, for Section 5 was amended on February 11, 1911, by adding the proviso

> "that nothing herein shall prevent the registration of a trademark otherwise registerable because of its being the name of the applicant or a portion thereof";

and it is also important that the original act in Sec. 29 declares that

> "The term "trade-mark" includes any mark which is entitled to registration under

> the terms of this Act and whether registered or not and a trade-mark shall be deemed to be "affixed" to an article when it is placed in any manner in or upon either the article itself or the receptacle or package or upon the envelope or other thing in, by, or with which the goods are packed or inclosed or otherwise prepared for sale or distribution."

The question presented by this litigation is therefore this,—to what measure of relief is one entitled, who owns as a valid trademark a word which before registration under the statute he could not protect at law, without invoking the doctrine of unfair competition?

It is to be regretted that sharp distinction was ever drawn between that trespass on property rights called trademark infringement, and the exactly similar trespass commonly spoken of as unfair competition,—but since the distinction has not only become well known, but been made a basis for limiting jurisdiction, it is necessary here to find infringement of trademark according to strict rules, if complainant is to be entitled to any relief.

Trademark infringement is the use by defendant,—for trading purposes,—and in connection with goods of the kind as to which complainant's exclusive right exists,—of a mark identical with complainant's or colorably resembling it. The wrongful imitation need not be exact or perfect, but may be limited or partial. *McLean* vs. *Fleming*, 96 U. S., 245; *Saxlehner* vs. *Eisner, etc. Co.*, 179 U. S., 19. Within these familiar rules it would seem that any use of the word "Davids" in connection with inks would be infringement, and very interesting questions would arise did the bill seek to enjoin any and every use of defendant's own names in conjunction with the manufacture of an article which is free for all. The bill, however, asks only that defendants be enjoined from the use of the complainant's trademark in their trade name of "Davids Manufacturing Company", and also from the use of the word

"Davids" at the top of their labels in connection with the business of making and selling inks, etc.

Since it has been held that a proper name can under the circumstances here existing become a valid trademark, then such trademark must receive the same kind and extent of protection as would be accorded to an arbitrary or fanciful name selected for euphony or quaintness, and associated with a particular kind of goods made by a particular person. Thus, if complainant's trademark were not "Davids", but "Davyne" (an actual word at present wholly unrelated to ink), defendants would plainly not be permitted to sell, advertise or mark inks as those of the "Davyne Manufacturing Company", nor to use the word "Davyne" prominently upon their labels. Undoubtedly this statute as construed limits some rights heretofore thought to have been secured to all men in respect of the use of their own names, yet such in my judgment is the logical result of the decision first referred to, and the legislative intent as shown by recent amendment.

The evidence herein conclusively shows that defendants do display the word "Davids" very prominently at the top of their labels and elsewhere, and transact all their business under the trade name of "Davids Manufacturing Company". From these acts (in relation to inks) let them be restrained according to the prayer of the bill, which is for an injunction only and not for an accounting.

June 22, 1911.

NOTE.

Three defences are urged that will merely be noted:

1st. It is said that complainant has long so misled the public in respect of its products that its trademark is not deserving of protection within such cases as *Worden* vs. *California Fig Syrup Co.*, 187 U. S., 282. The trademark is the single word

"Davids". How that single word can convey or be used to convey any false impression to the public is difficult to see; but entirely apart from this, I am of opinion that the complaints made by the defendants are without merit if they are not frivolous, viz: that "Electro-chemical Writing Fluid" is not prepared by any electrical process; that "Oriental Carmine Ink" does not come from the Orient, and is not based on extract of cochineal, and that "Silk Filtered Ink" is no longer silk filtered, although it once was.

2d. The registration of complainant's trade-mark is said to be invalid because complainant and its predecessors had not had exclusive use thereof for the statutory period. The only evidence to support this contention is that an imposter named Davis sold "Davis Inks" to people who thought they were buying Davids' ink. The exclusive use of a trademark means rightfully exclusive use, and is not disturbed by an unsuccessful effort to steal the same, nor even by furtive and partial success in making some profit out of the attempted theft.

3d. Complainant's trademark has not been used in interstate or foreign commerce. This is plainly disproved by the evidence.

The contention as to Gum Arabic, Gum Ghatti or Gum Senegal is not noticed,—jurisdiction depends on registration and the trademark registered has to do with inks only—not mucilage or paste.

Exhibit C.

UNITED STATES CIRCUIT COURT OF APPEALS,

FOR THE SECOND CIRCUIT.

THE THADDEUS DAVIDS COMPANY,
Complainant-Appellee

AGAINST

CORTLANDT I. DAVIDS and WALTER I. DAVIDS, trading as DAVIDS MANUFACTURING COMPANY,
Defendants-Appellants

ON APPEAL from a decree of the Circuit Court for the Southern District of New York restraining the defendants from infringing the complainant's registered trade-mark "Davids".

Before

COXE, WARD and NOYES,
Circuit Judges.

COXE, *J.:*

We have held that the surname "Davids was a valid trade-mark under the ten-year clause of the Act of 1905. *Davids* v. *Davids*, 178 Fed. 801. The question now to be considered is—Do the defendants infringe? We see no reason why the defendant, Cortlandt I. Davids, who is a lineal descendant of the original Davids, who established the complainant's business, may not engage in the manufacture and sale of inks and use his own name in the business. He has the same right to use his own name as if it were Jones or Smith. *Howe Scale Co.* v. *Wyckoff*, 198 U. S. 118. Indeed, this right is expressly conceded by the bill. The contention of the complainant is that though the defendant may use

his name, Cortlandt I. Davids, on the label, he has no right to use it at the top of his label, which, in all other important respects, is dissimilar to the complainant's labels. It must be remembered, however, that we are not dealing with a case of unfair competition, but with the case of a registered trade-mark pure and simple, the trade-mark consisting of the single word '*DAVIDS*'." The use of this word is not limited to any particular position on the label and it is impossible to conceive that its position at the top of the label will be an infringement and its use at the bottom, or in the middle of the label, will not infringe. It follows, therefore, that the conceded right of the defendant to use his name cannot be unlawful if used at the top of his label. If he has a right to use his own name in business he has a right to use it anywhere. He has a right to place it where the proof shows it is generally placed by the manufacturers of ink, namely, at the top of his label. The location of the trade-mark is not an element, especially where no mention of the location is made in the statement or declaration. The "statement" says upon this point that:

> "It is customary to print the mark upon the labels which are attached to the receptacles containing the goods."

The use by the defendants of the words "Davids Manufacturing Company" at the bottom of their label is not, in our judgment, an infringement of the registered trade-mark. The complainant has, we think, confused his right of action which is for infringement of its trade-mark with an action for unfair competition. We have no jurisdiction of the latter action as the parties are all citizens of the State of New York. If the complainant is satisfied that it can maintain an action for unfair competition, it should present it to the courts of New York which alone have jurisdiction.

The decree is reversed with costs.

Exhibit D.

NOYES, Circuit Judge (dissenting):

We have held that the complainant has a valid registered trade mark in the name "Davids." This requires us to hold, as it seems to me, that the prominent use of the same name in the same business by the defendants should be enjoined. If the decision of the majority be well founded, we meant little in saying in our original opinion in this case that if a mark "is entitled to registration it is entitled to protection." It must now be accepted that while surnames may become valid registered trade-marks, they are infringed by the use of the very name and nothing besides; there is no latitude in protecting them.

3 184

No. [redacted]

FILED.

FEB 6 1912

JAMES H. McKENNEY

Supreme Court of the United States.

OCTOBER TERM, 1911.

No.

THADDEUS DAVIDS COMPANY,

Petitioner,

vs.

CORTLANDT I. DAVIDS AND WALTER I. DAVIDS, TRADING AS DAVIDS MANUFACTURING CO.,

Defendant.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

W. P. PREBLE,

Attorney and Counsel for Petitioner.

THE EVENING POST JOB PRINTING OFFICE, 210 FULTON ST., N. Y.

Supreme Court of the United States.

OCTOBER TERM, 1911.

No.

THADDEUS DAVIDS COMPANY, Petitioner *in re* Petition for writ of *certiorari*, requiring the Circuit Court of Appeals in and for the Second Circuit, to certify to the Supreme Court for review and determination the case of the Thaddeus Davids Company,
Complainant-Appellee,

v.

CORTLANDT I. DAVIDS & WALTER I. DAVIDS, trading as DAVIDS MANUFACTURING CO.,
Defendants-Appellants.

BRIEF.

MAY IT PLEASE THE COURT:

We come frankly before this Honorable Court with a plain direct question:

Is not a personal name, when registered as a trade-mark and held valid by the Courts, entitled to

the same protection as other valid registered trade-marks?

A majority (two judges) of the Circuit Court of Appeals for the Second Circuit has answered this question in the negative.

A minority (one judge) of said Court together with the judge who presided at the Circuit, have answered this question in the affirmative.

In this case of divided authority, petitioner respectfully asks your Honors to take the matter up and decide it for yourselves and for all the manufacturers of the United States in view of the vital importance to them of this question.

Incidentally the petitioner, Thaddeus Davids Co., of New York, after manufacturing ink for over eighty years, and having acquired a very high reputation for its inks, under its recognized trade mark, "Davids," has had its trade mark struck down, not on the ground of invalidity, but on the ground that it is not infringed by the use of the same name "Davids," in the same prominent place on defendants' labels, used in the same business.

Crushing as this blow is to this long established concern, it is not merely on its account that this petition has been filed.

Almost every trade throughout the United States will be affected by the decision sought to be reviewed, if it is allowed to stand. There is hardly a trade in which many of the commodities are not known by the surname of the manufacturer. While your Honors would readily think of many such instances, we venture to suggest a few:

The following list of one hundred names is a sample of the well known surnames which have become identified with their respective articles of manufacture:

Adams (Tutti-frutti); Allcock (Porous Plaster); Armour (Beef); Ayers (Sarsaparilla); Baker (Chocolate); Baldwin (Locomotive); Barber (Asphalt Pavement); Bass (Ale); Borden (Condensed Milk); Boyn-

ton (Furnace); Brewster (Buggy); Buick (Automobile); Butterick (Patterns); Cadillac (Automobiles); Chesebrough (Vaseline); Chickering (Piano); Clark (Thread); Colgate (Soap); Corliss (Engine); Crawford (Shoe); Crompton (Looms); DeBarres (Automobiles); DeDion (Automobiles); Deere (Harvester); DeLong (Hooks); Demorest (Pattern): Devoe (Paints); Disston (Saws); Ditson (Music); Dougherty (Playing Cards); Douglass (Shoe); Dupont (Powder); Duryea (Starch); Eastman (Kodak): Edison (Phonograph); Easterbrook (Pens); Faber (Pencil); Fairbanks (Scales); Ford (Automobiles); Forsythe (Shirts); Fownes (Gloves); Franklin (Stove); Gillette (Razor); Glidden (Automobile); Goodyear (Rubber); Gorham (Silverware); Guinness (Stout); Hall (Safes); Haviland (China); Heinz (Pickles); Henderson (Seeds); Hennessy (Brandy); Henry (Rifle); Hoe (Printing Press); Hoffman (Cigars); Hood (Sarsaparilla); Horton (Ice cream); Hostetter (Bitters); Howe (Scales); Humphrey (Medicine); Huyler (Candy); Johnson (Liniment); Knabe (Piano); Knowles (Pumps); Knox (Hats); Lamson (Cash Carrier); LePage (Glue); Liebig (Beef Extract); Maxwell (Automobile); McCormick (Reapers); Mellen (Infants' food); Mergenthaler (Linotype); Miller (Car Platform); Nestle (Food); Olds (Automobile); Oliver (Typewriter); Otis (Elevator); Pabst (Beer); Packard (Automobile); Panhard (Automobile); Pillsbury (Flour); Pilsner (Beer); Pitcher (Castoria); Prang (Chromo); Remington (Typewriter); Renault (Automobile); Roebuck (Weatherstrip); Schlitz (Beer); Singer (Sewing Machine); Sohmer (Piano); Spaulding (Sporting Goods), Stearns (Automobile); Steinway (Piano); Swift (Beef); Tarrant (Seltzer); Thorburn (Seeds); Tiffany (Watches); Underwood (Typewriter); Vantine (Japanese Goods); Vaughan (Seeds); Washburn (Mower); Waterman (Fountain Pens); Welsbach (Mantles); Westinghouse (Air Brake); Winchester (Rifle).

In the class of inks, we have Antoine's Ink, Carter's Ink, Davids' Ink, Paul's Ink, Pomeroy's Ink, Sanford's Ink, Stafford's Ink, Thomas's Ink, and

others less known. All of these inks are known to the public by the surname of the manufacturer.

It has seemed best on the whole to make this brief in support of the petition very short. We realize that this Honorable Court is very busy and is more or less flooded with motions for writs of *certiorari*, and that it would be an imposition upon your Honors to present to the Court a long detailed exposition of all the facts and evidence in the case and of the many minor reasons why it is important that this writ should be granted in the present case. As usual, there are a great many minor details in the case which account for the length of time which it has been pending, to wit, about five years, but there is only

One Issue Presented.

This honorable Court has, so far as we know, never indicated that one kind of trade-mark was to be treated with any less liberality than another.

His Honor Judge Hough (in Exhibit B), was correct at the time of his decision, when he said:

> "Since it has been held that a proper name can, under the circumstances here existing, become a valid trade-mark, then such trade-mark must receive the same kind and extent of protection as would be accorded to an arbitrary or fanciful name."

If registered trade-marks on personal names are *not* to receive the same kind and extent of protection as arbitrary and fanciful names, that fact should be established by a decision higher and more convincing than the one now sought to be reviewed, which, with all due respect to the Court which made it, has two vital defects for a decision which takes on the character of a pioneer decision.

a. It is only a majority decision instead of unanimous.

b. It is at variance with its own prior decision on demurrer.

We are wholly unable to see how a court having overruled a demurrer which raised the point that the placing of the word "Davids" at the top of the label was not an infringement, can afterwards sustain that same point when raised on the merits.

That particular point would seem to have been *res judicata* as to that Court and it is quite an anomaly to have a majority opinion thus set aside the previous unanimous opinion of the same Court.

If trade-marks are to be divided into those which are to be treated liberally and those which are to be treated illiberally, or, if the Court will pardon the simile in view of its aptness, if sheep among the registered trade-marks are to be separated from the goats, it is, we submit, of the highest importance that the line of separation should be drawn by the highest Court of the land and not by one of nine intermediate courts, each endowed with the same powers and each entitled to its individual opinion and reason.

That is where we stand in this case.

We are not here as a disappointed litigant, to magnify our individual wrongs and therefore, we have touched very lightly upon the hardship of losing protection after eighty years of undisputed trade-mark use.

We are here to call the attention of this Honorable Court to the fact that, if the opinion of the majority of the Circuit Court of Appeals in this case holds, the army of manufacturers who use their surnames as the means of popularizing their goods will find the registration of those surnames a mere shell, without powder or ball; a shadow without a substance.

There is such an army, as your Honors are well aware, and the importance of that army is indicated by the list of one hundred names given above.

The dissenting opinion of his Honor Judge Noyes

is so concise, well worded, and, we respectfully submit, founded upon such a clear and correct understanding of the law and of the province of a court of equity that we take the liberty of quoting it *in toto* as the most effective brief we can present:

> "We have held that the complainant has a valid registered trade-mark in the name 'Davids.' This requires us to hold, as it seems to me, that the prominent use of the same name in the same business by the defendants should be enjoined. If the decision of the majority be well founded, we meant little in saying in our original opinion in this case that if a mark 'is entitled to registration it is entitled to protection.' It must now be accepted, that while surnames may become valid registered trade-marks, they are infringed by the use of the very name and nothing besides; there is no latitude in protecting them."

This is too important a question, we respectfully submit, not to be passed upon by this Honorable Court.

Respectfully submitted,

W. P. PREBLE,
Of Counsel for Petitioner.

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Discussion of the ten-year clause of the Trade-mark Act of February 20, 1905, with extracts from the Congressional Records during the debate and passage of said act.

LIST OF CASES REFERRED TO.

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Supreme Court of the United States,

OCTOBER TERM, 1913.

No. 184.

THADDEUS DAVIDS CO.,
Petitioner,

vs.

CORDTLAND I. DAVIDS, and WALTER I. DAVIDS, trading as DAVIDS MANUFACTURING CO.,
Respondents.

ON WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

BRIEF FOR PETITIONER.

MAY IT PLEASE THE COURT:

As stated at the beginning of our brief in support of the petition for writ of *certiorari*, we come frankly before this Honorable Court with a plain direct question:

Is not a personal name, when registered as a trade-mark, and held valid by the Courts, entitled to the same protection as other valid trade-marks?

The trade-mark involved here is the word:

DAVIDS'

registered January 22, 1907, No. 59,898, for Inks and Stamp Pads, under the ten-year clause of the Act of February 20, 1905.

This word was first adopted by Thaddeus Davids in 1825. At that time the population of New York City was somewhat less than 203,000. By the census of 1913, Manhattan Borough, New York City, has a population of almost 2,500,000. During these eighty-eight years, the ink business of the Thaddeus Davids Co. and its predecessors has continued without interruption, and the word "DAVIDS'" when seen upon its ink bottles has been the mark of origin of the contents of the bottle.

Of course, we concede at the start that, in view of the way trade-marks are interpreted to-day it would have been better if Thaddeus Davids, when he began to make and sell inks on the New York market eighty-eight years ago, had adopted some purely arbitrary, striking or fantastic symbol, or a coined word instead of taking his own surname.

But we must not forget that in 1825 all industries in the United States were "Infant Industries" and could not foresee the phenomenal expanse and growth of these United States during the succeeding eighty-eight years.

Not only has the population risen from approximately eleven millions to over ninety-six millions, but the actual territory of the United States for trading purposes has expanded, even more rapidly.

A very curious change, probably unique in the history of the world, has taken place in the matter of trade-mark rights as the result of the enormous trade expansion of the United States.

A NEW TRADE-MARK RIGHT.

Prior to the year 1905, there was only one trade-mark right known in the United States; the right at common law.

By the act of February 20th, 1905, a new right of trade-mark came into existence in this country by act of Congress.

Little appreciated at first, this new right has grown to be vastly more valuable than the common law right of trade-mark. This new right is the right to use trade marks in *interstate commerce*.

The first recognition of this right was given by the Circuit Court of Appeals for the Second Circuit in the present case on demurrer (178 Fed., 801), a copy of which decision may also be found on page 10 of the little grey covered book containing the Notice of Motion and Petition for Writ of *Certiorari*. This decision was given April 18, 1910, and the editors of the *Trade-Mark Reporter* (Volume 1, p. 219), in a foot note, say: "This case furnishes the first definite and satisfactory construction of the so called ten year clause of the trade-mark act. The view of the Circuit Court of Appeals as remarked upon in the text, and followed in this decision, is the only view that does not entirely nullify the clause in question."

On April 1st, 1912, the Court of Appeals for the District of Columbia seems to have recognized this ten-year doctrine in H. Becker & Co. *vs.* C. A. Gambrill Manufacturing Co. (2 Trade-mark Reporter, 338) as to the words "Orange Grove", as applied to flour.

Subsequently, on July 18, 1912, in New York Mackintosh Co. *vs.* Flam (198 Fed., 571), the Court extended this ten-year protection to the word "Bestyette", as applied to rain-capes.

Subsequently, in the Coca-Cola cases (200 Fed., 105, 107, 153, and 157), this right was recognized for the trade-mark Coca-Cola and held to be infringed by the term "Extract of Coca and Kola."

Subsequently, in Hughes *vs.* Alfred H. Smith Co. (205 Fed., 302), April 9, 1913, the protection afforded by the ten-year clause was extended to the word "Ideal", as applied to hairbrushes.

So far as we have been able to find, the first de-

cision of the Circuit Court of Appeals in the present case (178, f. 801), though often noticed by the courts in later cases, has never been disputed. No attempt was made by defendants to bring the matter up to this Honorable Court.

Under these circumstances we assume that the matter is *res judicata* between the parties hereto, and we will, therefore, assume that the validity of the trade-mark "DAVIDS" is established.

COURTESY *v.* RIGHT.

Every State of the United States, being a sovereign and independent State, as to all the natural or usual rights to life, liberty and happiness of its citizens, has undisputed authority within its own territorial limits, except in so far as limitations are imposed by that contract or treaty to which we all owe allegiance, the Constitution of the United States.

Whatever trade-mark protection a manufacturer in one State may receive in another State is a matter of courtesy and not a matter of right. His right of trade-mark at common law ceases when his goods reach the boundaries of his own State. Outside of those boundaries he has *no* right at common law.

Massachusetts may extend the courtesy of protecting trade-marks to New York; Pennsylvania to California; Maryland to Texas, but it remains a courtesy.

While we were separate colonies it was usual to refuse these courtesies; after the adoption of the constitution it became the rule to extend them.

Congress, however, by the act of February 20, 1905, through its power of regulating interstate commerce, created a new right, which is no longer a *courtesy* but a *right*. Not a common law right, but a statutory right co-extensive with the entire United States. As this question was a very interesting one at the time of the original argument, March 22, 1910, we take the liberty of annexing to this brief as a sort of appendix that portion of our

brief which was used before the Circuit Court of Appeals at that time showing how Congress came to create this new trade-mark right.

SURNAMES.

Thaddeus Davids was not the only trader who indicated the origin of his goods by adopting his surname as the "Mark by which the goods of the owner of the mark may be distinguished from other goods of the same class" (to quote the statute). Almost all the most prominent early manufacturers of ink did the same thing. In addition to Davids' ink, the public is well acquainted with Antoine's ink, Carter's ink, Caw's ink, Sanford's ink, Stafford's ink, Thomas' ink, and so on. With great uniformity of practice the place selected for this surname was the top of the label as the place where it would first direct the eye. While not universal, this position came to be looked upon as a natural place for the word. Out of twenty-one labels used by the petitioner as inserted at pages 63 to 75 of the transcript of record, eighteen have the word "DAVIDS'" alone at the top, such as

Davids' Chemical Writing Fluid, page 63.
Davids' Brilliant Scarlet Ink, page 63.
Davids' Combined Writing and Copying Ink, page 64.
Davids' Oriental Red Ink, page 64.
Davids' Superior Unchangeable Blue Ink, page 65.
Davids' Excelsior Violet Ink, page 65.
Davids' Chemical Copying Ink, page 66.
Davids' U. S. Copying Ink, page 66.
Davids' Marking Ink, page 67.
Davids' Magic Black, page 68.
Davids' New York School Ink, page 68.
Davids' Oriental Carmine Ink, page 69.
Davids' Electro Chemical Writing Fluid, page 70.
Davids' Excelsior Stamping Ink, page 72.
Davids' Non-Copying Carmine Ink, page 72.
Davids' Fountain Pen Ink, page 73.
Davids' Brilliant Carmine Ink, page 73.
Davids' Brilliant Green Ink, page 74.

Red,—white,—and blue,—gray,—orange,—yellow,—violet,—purple,—green,—and black;—coats of arms, rosettes,—scrolls,—discs,—globes,—dippers,—star and crescent,—leaves,—flowers,—thunder storms,—and cities. But all the time the word DAVIDS' at the top.

When defendants left the employ of petitioners and started up the manufacture of inks for themselves, they also put the word DAVIDS' at the top of their labels, in evident recognition of the fact that there was where the Davids' mark would be looked for.

But not Davids' alone, not the ink business alone, but manufacturers and dealers in great varieties of merchandise and scattered all over the United States, are deeply interested in this question of the extent of protection to be afforded to a surname when *registered* as a *valid trade-mark*.

We take the liberty of reproducing here from our brief in support of the motion for the writ, a list of something over one hundred surnames under which well know articles of merchandise are sold in different parts of the country. This list is only typical of the wide-spread business which will be affected by your Honors' decision in this case.

Adams (Tutti-frutti); Allcock (Porous Plaster); Armour (Beef); Ayers (Sarsaparilla); Baker (Chocolate); Baldwin (Locomotive); Barber (Asphalt Pavement); Bass (Ale); Borden (Condensed Milk); Boynton (Furnace); Brewster (Buggy); Buick (Automobile); Butterick (Patterns); Cadillac (Automobiles); Chesebrough (Vaseline); Chickering (Piano); Clark (Thread); Colgate (Soap); Corliss (Engine); Crawford (Shoe); Crompton (Looms); DeBarres (Automobiles); De Dion (Automobiles); Deere (Harvester); De Long (Hooks); Demorest (Pattern); Devoe (Paints); Disston (Saws); Ditson (Music); Dougherty (Playing Cards); Douglass (Shoe); Dupont (Powder); Duryea (Starch); Eastman (Kodak); Edison (Phonograph); Easterbrook (Pens); Faber (Pencil); Fairbanks (Scales); Ford (Automobiles); Forsythe

(Shirts); Fownes (Gloves); Franklin (Stove); Gillette (Razor); Glidden (Automobile); Goodyear (Rubber); Gorham (Silverware); Guinness (Stout); Hall (Safes); Haviland (China); Heinz (Pickles); Henderson (Seeds); Hennessy (Brandy); Henry (Rifle); Hoe (Printing Press); Hoffman (Cigars); Hood (Scrsaparilla); Horton (Ice cream); Hostetter (Bitters); Howe (Scales); Humphrey (Medicine); Huyler (Candy); Johnson (Liniment); Knabe (Piano); Knowles (Pumps); Knox (Hats); Lamson (Cash Carrier); Le Page (Glue); Liebeg (Beef Extract); Maxwell (Automobile); McCormick (Reapers); Mellen (Infants' Food); Mergenthaler (Linotype); Miller (Car Platform); Nestle (Food); Olds (Automobile); Oliver (Typewriter); Otis (Elevator); Pabst (Beer); Packard (Automobile); Panhard (Automobile); Pillsbury (Flour); Pilsner (Beer); Pitcher (Castoria); Prang (Chromo); Remington (Typewriter); Renault (Automobile); Roebuck (Weatherstrip); Schlitz (Beer); Singer (Sewing Machine); Sohmer (Piano); Spaulding (Sporting Goods); Stearns (Automobile); Steinway (Piano); Swift (Beef); Tarrant (Seltzer); Thorburn (Seeds); Tiffany (Watches); Underwood (Typewriter); Vantine (Japanese Goods); Vaughan (Seeds); Washburn (Mower); Waterman (Fountain Pens); Welsbach (Mantles); Westinghouse (Air Brake); Winchester (Rifle).

Facts of Case.

From our point of view the facts involved in this case are few and simple: Plaintiff's trade-mark (p. 77) No. 59,898, was registered January 22, 1907, for inks and stamp pads under the ten year clause as appears from the declaration at the top of page 77.

This trade-mark consists, as shown in the drawing, of the word "DAVIDS'" (all capitals and with the apostrophe). Defendants, Cortlandt I. Davids and Walter I. Davids, left complainant's employ and started an ink business in New York City, putting the name C. I. DAVIDS' (all capitals and with the apostrophe), at the top of their labels, and the name Davids Manufacturing Co. at the bottom.

The amended bill of complaint was filed March 30, 1908. The specific act complained of as an infringement of the registered trade-mark (see p. 5, paragraph 13) is setting that word "DAVIDS" *in prominent type* at the top of the label. The other matters set up in the bill come within unfair competition and are no longer important in this case. Specimens of defendants' label are before the Court. The only issue is whether the word "DAVIDS'" (all capitals and with the apostrophe) at the top of defendants' label infringes the word DAVIDS' (all capitals and with the apostrophe) registered as a trade-mark and usually set at the top of complainant's label.

Much has been claimed against us by defendants' counsel and the Court, because we generously stated in paragraph 13 of the bill, "The orator having no objection to the mere use of the name Davids on defendants' goods." To a avoid similar misadventure here we think this a good place to define exactly what we meant by this generous concession.

We do *not* desire to prevent defendants from using the surname "Davids" in any legitimate and proper way in connection with the sale of their goods, but we *do* desire to prevent the use of that surname *as a trade-mark*. In other words, we desire to prevent defendants from using the surname "Davids" (as registered by us) as a "mark of origin" of their goods, because we claim that we are the only people who have the right to use that surname as the mark of origin of the goods. We respectfully but emphatically protest against the apparent theory of the Court below that the concession that defendants can use the name of one of the defendants in the business, but *not* set the word "Davids" (part of that name) *in prominent type* is equivalent to a concession that they *may* use the name *as printed in prominent type*, or, in other words, as an almost Chinese copy of petitioner's registered trade-mark. The history of the litigation, beginning with the

filing of the amended bill on March 30, 1908, is briefly as follows:

Defendants interposed several demurrers which were sustained by Judge Ray on December 15, 1908 (165 Fed., 702). This decision was reversed on appeal, April 18, 1910 (178 Fed., 801), and the cause remanded "With instructions to overrule the demurrers (plural) and thereupon proceed in accordance with the rules and practice in equity." Defendants' answer was filed May 28, 1910 (page 28, Transcript of Record). On June 21, 1911, Judge Hough (190 Fed., 285) sustained the trade-mark and found infringement. His decision is on page 104, Transcript of Record, and the decree thereunder on page 107.

On January 8, 1912, the Circuit Court of Appeals by the decision sought to be reviewed (192 Fed., 915) reversed Judge Hough by a majority decision (Judges Coxe and Ward) and his Honor Judge Noyes dissenting (see pages 111 and 112 of Transcript of Record).

The same two specimens of defendants' labels *and no others* were before the courts at all four hearings, that is the two on demurrer and the two on the merits.

There is no dispute as to the few facts *above stated*, and they seem to us to present in a clear and direct manner the only issues which can arise in these proceedings. If we understand correctly the new rules of practice in equity 75, 76 and 77, such extraneous matters as appear in the printed proofs may be disregarded.

For instance, the personal relations of the parties; —the operations of an arrant swindler under the name of a fictitious Davis Manufacturing Co. of St. Louis, Mo.; minor criticisms of some of complainant's labels for ink and mucilage; postal cards and other things showing actual confusion in the trade;—together with a faint criticism as to the proof of use in interstate commerce.

None of these matters carried any weight with Judge Hough or with the Circuit Court of Appeals

in the decision sought to be reviewed and, therefore, unless the Court desires, we will not take up its time by showing at length the futility of these minor matters.

The Sole Question.

The sole question presented here is the question of infringement.

This question presents itself under two aspects; one, as affecting merely the parties to this case, the other as affecting the general law of trade-marks which would apply to every manufacturer and dealer in the United States.

To take up first the aspect of the question as affecting the parties alone.

We place here side by side the trade-mark "Davids'" as registered, and the word "Davids'" as used by defefendants.

DAVIDS' **DAVIDS'**

Evidently the latter is almost identical in size and character of the letters with the former.

His Honor Judge Hough (p. 105, Transcript of Record) says:

> "Trade-mark infringement is the use by defendant,—for trading purposes,—and in connection with goods of the kind as to which complainant's exclusive right exists,—of a mark identical with complainant's or colorably resembling it. The wrongful imitation need not be exact or perfect, but may be limited or partial * * * the evidence herein conclusive shows that the defendants do display the word 'Davids' very prominently at the top of their labels and elsewhere, and transact all their business under the trade name of Davids Manufacturing Co. From these acts (in relation to inks) let them be restrained according to the prayer of the bill, which is for an injunction only and not for an accounting."

The decree reads (p. 107, Transcript of Record):

> "Ordered, adjudged and decreed that United States registered trade-mark No. 59,898, issued to complainant herein on the 22 of January, 1907, is a good and valid trade-mark; that the defendants have infringed the same by selling, advertising and marking their inks, as those of the Davids Manufacturing Co., and by using the word 'Davids' prominently upon their labels."

The majority decision of the Circuit Court of Appeals to be reviewed (p. 111, Transcript of Record) is so short that it may save this Court trouble if we quote it here in full.

> COXE, *J.:*
>
> "We have held that the surname 'Davids' was a valid trade mark under the ten year clause of the Act of 1905, Davids *v.* Davids, 178 Fed. 801. The question now to be considered is—Do the defendants infringe? We see no reason why the Defendant, Cortlandt I. Davids, who is a lineal descendant of the original Davids, who established the complainant's business, may not engage in the manufacture and sale of ink and use his own name in the business. He has the same right to use his own name, as if it were Jones or Smith. Howe Scales Co. *v.* Wyckoff, 198 U. S. 118. Indeed, this right is expressly conceded by the bill. The contention of the complainant is that though the defendant may use his name, Cortlandt I. Davids, on the label, he has no right to use it at the top of his label, which, in all other important respects, is dissimilar to the complainant's labels. It must be remembered, however, that we are not dealing with a case of unfair competition, but with the case of a registered trade-mark pure and simple, the trade-mark consisting of the single word "Davids". The use of this word is not limited to any particular position on the label and it is impossible to conceive that its position at the top of the label will be an infringement and its use at the bottom, or in the middle of the label, will not infringe. It follows, therefore, that the

> conceded right of the defendant to use his name cannot be unlawful if used at the top of his label. If he has a right to use his own name in business he has a right to use it anywhere. He has a right to place it where the proof shows it is generally placed by the manufacturers of ink, namely, at the top of his label. The location of the trade-mark is not an element, especially where no mention of the location is made in the statement or declaration. The 'statement' says upon this point that:
>
> "'It is customary to print the mark upon the labels which are attached to the receptacles containing the goods.'
>
> "The use by the defendants of the words 'Davids Manufacturing Company' at the bottom of their label is not, in our judgment, an infringement of the registered trade-mark. The complaint has, we think, confused his right of action which is for infringement of its trade-mark with an action for unfair competition. We have no jurisdiction of the latter action as the parties are all citizens of the State of New York. If the complainant is satisfied that it can maintain an action for unfair competition, it should present it to the courts of New York which alone have jurisdiction.
>
> "The decree is reversed with costs."

We respectfully submit that this is a very illiberal decision. If the trade-mark shown in the drawing of trade-mark No. 59,898 (p. 109, Transcript of Record), being a word of six letters, of solid color, all capitals, and an apostrophe, is not infringed by the near facsimile copy on defendants' labels, to wit, the same word of six letters, of solid color, all capitals, and with the apostrophe, it is difficult to see how infringement could arise. Even the type is so closely copied that it requires a good eye to see any difference. His Honor Judge Coxe seems (we respectfully submit) to have misstated our position. We do not deny for a moment the right of Cortlandt I. Davids to engage in the manufacture and sale of ink and use his own name in the business. We *do*,

however, deny that he has the same right to use his own name as if it were Jones or Smith, because Jones or Smith could hardly be made to look like Davids and we have a trade-mark on the word "Davids" and, therefore, we claim that defendants' right to use his own name is restricted by the limitation that he must not use it *as a trade-mark.*

Petitioner was the first in the field and has built up the popularity of his business by using the word "Davids" *as a trade mark* and not simply by using the word "Davids" *in his business.*

When his honor says "This right is expressly conceded by the bill" he extends our concession beyond its letter or spirit. There is no mention in the bill of Jones or Smith but merely the concession of the right "To the *mere* use of the name C. I. Davids (not all capitals and without the apostrophe) on defendants' goods."

When his Honor Judge Coxe says that we concede that defendant may use his name, Cortlandt I. Davids on the label, but not at the top, his Honor again mistakes our position. We did not say "label", we said "goods", and we did not say Cortlandt I. Davids, but C. I. Davids. While possibly the word "goods" in our concession might be inferred to include labels because glass bottles are quite as likely to have the manufacturer's name on the label instead of moulded in the glass, we think the concession should be interpreted literally and not expansively. However, that may be, it is not the location of the word "Davids" so much as the appearance which we object to. His Honor does not pay any attention to the limitation which we imposed upon that concession to wit, that said word "Davids" must *not be* "*in prominent type*".

We may readily conceive that if the name Cortlandt I. Davids had the appearance of that gentleman's full signature we might not object to it wherever it was

Our claim to infringement of the registered trademark is based *not* upon the *mere* use of the defend-

ant Cortlandt I. Davids' own name in business, but in that unusual and unauthorized use of the word "Davids" (part of the name) *as a trade-mark*.

If the defendants put the word Eagle or Solar or Ethiopian or any other striking word or symbol at the top of their label as a trade-mark and confined their use of their own name to business uses other than trade-mark uses, we would have no cause to complaln.

His Honor Judge Coxe does us injustice when he says, "The complainant has, we think, confused his right of action, which is for infringeme[illegible] of its trade-mark, with an action for unfair [illegible]etition."

We are guilty of no such confusion.

It is true the bill of complaint (as drawn) included charges of unfair competition with the claim for infringement of a registered trade-mark. We frankly admit that we did, as many other lawyers had done before, make the mistake of supposing that a Federal court would take ancillary jurisdiction of unfair competition, when its jurisdiction of the registered trade-mark was established, to avoid multiplicity of suits. But as soon as our attention was called to the fact that the Federal Courts had held that it was without jurisdiction as to such ancillary matters, we dropped all claim, so far as the Federal Courts were concerned, to any rights arising from unfair competition, and confined ourselves absolutely to the claim of infringement of registered trade-mark. His Honor's suggestion that we should present to the courts of New York an action for unfair competition does not meet the situation, as we understand it, at all.

The Thaddeus Davids Co. and its predecessors have been accustomed to meet all sorts of competition ever since they have been in business (a period of nearly a century), and are somewhat accustomed to acts of unfairness on the part of some of their competitors. It is doubtful if the petitioner would think, in its present state of high reputation, that

any mere unfair competition, however gross, was worth the expense of litigation.

But the registered trade-mark under which petitioner and its predecessors have operated ever since the year 1825 is itself at stake.

It is because the mark of origin of its goods, the one word by which its inks have become known and popular, the word "Davids", has been tampered with by a competitor, whom otherwise we would ignore, that this suit was started and has been persistently prosecuted until we come here to-day before the highest tribual of the land on what we consider a perfectly justifiable and meritorious errand, namely:

To ask this Court to protect our valid registered trade-mark in interstate commerce.

To make our position absolutely plain, we ask the indulgence of the Court for a glance at the labels inserted at pages 63 to 75 of the transcript of record.

There are many words, symbols and designs there which might be the subject of registered trade-marks, for instance, the monogram U. S. on page 66, the marking pot on page 67, the word Magic on page 68, the streamer Oriental crossing the star and crescent at page 69, the wreath on page 72, and the escutcheon on page 75.

But if they were registered as trade-marks and if they were infringed by even so gross an infringement as fac-simile representation, the injury done to petitioner's business would be infinitessimal compared with the present infringement, which strikes at the very root of petitioner's established business.

We venture to assert that it was because defendants learned the vital importance of the word "Davids" while in the employ of the complainant company and because of anger at what defendants considered unjust treatment received from Edwin W. Davids, then secretary of the company (see p. 85, Transcript of Record), that having been discharged they selected the word "Davids" (and nothing else) as the weapon by which they could inflict the

greatest injury upon their former employer. When the respondents' counsel, as appears on page 88 Transcript of Record, advised Cortlandt I. Davids that it could use his own name at the top of the label without infringement, we do counsel the justice to assume that he was not aware either of the motives behind the desire to use the name in that place, or the intention to copy so closely the type and appearance of the word "Davids" as registered.

C. I. Davids is not (according to the authorities) the name of Cortlandt I. Davids in law. His name is Cortlandt Davids. The I. is not, we believe, in law a part of his name but an identifying adjunct, and the initial C is not his name but a business convenience. If Cortlandt I. Davids had used his name as Cortlandt I. Davids and not as C. I. Davids, and had not sought to make the word "Davids" the prominent feature or mark of origin, this suit would probably never have been brought.

The Real Point.

But after all, the real point which we desire to urge upon this Honorable Court is not whether the Thaddeus Davids Co. shall be protected against infringement of its trade-mark arising from this particular use of the word "Davids" by the particular defendants, but the broad question:

Whether the surname "Davids" and *all other surnames which have become valid registered trade-marks*, are entitled to the same liberal protection which the courts afford to other valid and registered trade-marks.

This brings us to the second aspect of this question of infringement; the one which affects in one way or another a large minority, if not majority, of all the manufacturers, traders, and dealers in the United States.

We have set out in full the majority decision to be

reviewed. Let us contrast with that the concise and admirably worded dissenting opinion of his Honor, Judge Noyes.

Noyes, Circuit Judge (dissenting):

> "We have held that the complainant has a valid registered trade-mark in the name 'Davids.' This requires us to hold, as it seems to me, that the prominent use of the same name in the same business by the defendants should be enjoined. If the decision of the majority be well founded, we meant little in saying in our original opinion in this case that if a mark 'is entitled to registration it is entitled to protection.' It must now be accepted, that while surnames may become valid registered trade-marks, they are infringed only by the use of the name standing by itself; there is no latitude in protecting them and they can be practically appropriated with impunity."

Although your Honors are very familiar with the reported cases in which protection has been afforded to words used as trade-marks (more familiar than the counsel now addressing the Court) it will do no harm to mention a few of the striking instances of recent date.

Messmate was held to infringe Shipmate (200 Fed., 324); Radames to infringe Rameses (199 Fed., 451); French to infringe Paris (198 Fed., 959); Knoxall to infringe Beats-All (181 Fed., 178); Certosa to infringe Ceresota (177 Fed., 786); Killiblues to infringe Billikens (174 Fed., 829); Sapono to infringe Sapolio (152 Fed., 690).

Why should not a surname, *when valid*, receive similar liberal treatment?

Is there any getting away from the decision of his Honor Judge Noyes, where it says: "We have held that the complainant has a valid registered trade-mark in the name "Davids". This requires us to hold, as it seems to me, that the prominent use of the same name in the same business by the defendant should be enjoined,"?

Or, if such act is to be held as not amounting to

an infringement of the registered trade-mark, but to be relegated to that vast prairie of unfair competition, how escape from the illogical, but most unfortunate, conclusion that "While surnames may become valid registered trade-marks, they are infringed only by the use of the name standing by itself; there is no latitude in protecting them and they can be practically appropriated with impunity."? (A curious thing happened in regard to this opinion which will be explained orally at the argument.)

Such a limitation of the protection afforded to surnames is obviously to rob the registered trade-mark on a surname of every bit of its value.

When the Circuit Court ot Appeals sustained the trade-mark "DAVIDS'" (178 Fed., 801) it said:

> "And if it is entitled to registration it is entitled to protection. We are unable to appreciate the distinction sought to be drawn by the defendant between the right to register a trade-mark and the right to protect it."

Having sustained the trade-mark on appeal on demurrer, and having stated that it was entitled to protection, a majority of the Circuit Court of Appeals on the second appeal (which was after final hearing) denied that protection to which it had said the trade-mark was entitled.

As his Honor Judge Noyes (as above quoted) well said:

> "If the decision of the majority be well founded, we meant little in saying in our original opinion that if a mark is entitled to registration it is entitled to protection; * * * and they can be practically appro priated with impunity."

His Honor Judge Hough (p. 104, Transcript of Record) thus discusses the first decision of the Circuit Court of Appeals (178 Fed., 801):

> "The bill of complaint is there sufficiently summarized. The scope of that decision is vitally important now that the cause has come on for hearing upon evidence.

"It is understood that that decision held that 'Davids,' being the name of the founder of complainant's business, could not be 'a valid common law trade mark,' but it might be a 'mark used as a trade-mark,' and might therefore be registered under Section 5 of the Trade-mark Act of February 20, 1905. It was also declared that the act made 'a mark actually and exclusively used for the requisite period (ten years) entitled to registration as a trade-mark;' and finally it was asserted that if it be 'entitled to registration it is entitled to protection.' It is not declared that the 'mark' which is an invalid common law trade-mark, shall be entitled to protection only as a mark; but it is said that 'we are unable to appreciate the distinction sought to be drawn by the defendant between the right to register a trade-mark and the right to protect it.' It follows from the language of the higher Court that since the 'mark' may be registered as a trade-mark and is entitled to protection, it is entitled to protection as a trade-mark, which is equivalent to saying that it becomes a valid trade-mark by registration."

His Honor goes on to say:

"The question presented by this litigation is therefore this,—To what measure of relief is one entitled, who owns as a valid trade-mark a word which before registration under the statute he could not protect at law, without invoking the doctrine of unfair competition. * * * Since it has been held that a proper name can, under the circumstances here existing, become a valid trade-mark, then such trade-mark must receive the same kind and extent of protection as would be accorded to an arbitrary or fanciful name selected for euphony or quaintness, and associated with a particular kind of goods made by a particular person. Thus, if complainant's trade-mark were not 'Davids' but 'Davyne' (an actual word at present wholly unrelated to ink), defendants would plainly not be permitted * * * to use the word 'Davyne' prominently upon their labels * * * The

> evidence herein conclusively shows that defendants do display the word 'Davids' very prominently at the top of their labels * * *. From these acts (in relation to inks) let them be restrained according to the prayer of the bill".

In one of the Coca-Cola cases (200 Fed., 157), on January 8, 1912, his Honor, Judge Sanford, says: "Section 5 of the Act of 1905, clearly contemplates that except in the prohibited cases, a mark by which the goods of the owner of the mark may be distinguished from other goods of the same class, may be admitted to registration *as a trade-mark*. This necessarily implies that the mark, when registered, shall constitute a trade-mark. And Section 29 specifically defines the term 'trade-mark' as including any mark which is entitled to registration under the terms of the act." His Honor then cites with approval from the Davids' case (178 Fed., 801), the statement of the Circuit Court of Appeals: "And if it is entitled to registration, it is entitled to protection," and holds that the trade-mark "Coca-Cola" was not "merely the right to the exclusive use of the mark Coca-Cola in its script form and not a trade-mark in the use of the name Coca-Cola when otherwise written," and found that defendant had infringed by having the name "Coca-Cola" printed on its labels, "Although not in script and in an unhyphenated form, and accompanied by the word 'Fletcher's' and containing other printed matter different from that contained in complainant's label". Commenting upon this case, his Honor Judge Lacombe, on October 7, 1912, in another Coca-Cola case (200 Fed., 107), says:

> "The only question left is whether in undertaking to afford relief against the use by others of a similar term, the Court should enjoin the defendants from selling the preparation which the defendant Syndicate makes under the term 'Extract of Coca and Kola.' It is no substantial departure from the term

> 'Coca-Cola' to spell either or both words with a K, or to substitute for the hyphen the conjunction 'and' or an ampersand, and it seems not to be a sufficient differentiation to call the compound an extract, or an elixir, or a decoction."

In Hughes *vs.* Alfred H. Smith Co. (205 Fed., 301, 315), on April 9, 1913, his Honor Judge Ray, who had originally sustained the demurrers in the Davids case, quotes the decision on appeal (178 Fed., 801) where the Court held "And if it is entitled to registration it is entitled to protection" and, acting thereon, extended protection to the word "Ideal" as applied to hair-brushes.

Importance of the Question.

As we said in our brief in support of the petition the question involved in this case is too important, in our opinion, not to be passed upon by this honorable Court. If your Honors should decide that a *surname* when properly and legally registered *as a trade-mark* is not entitled to as much protection as a fancy name or other trade-marks, that will be, naturally, the law of the land.

But until such pronouncement, we respectfully insist that the Circuit Court of Appeals for the Second Circuit in the decision to be reviewed is wrong in not giving protection to a "mark registered as a trade-mark" which it had previously held was entitled to protection.

To hold, as that Court did (178 Fed., 801) that "The Act makes a mark actually and exclusively used the requisite period entitled to registration as a trade-mark. And if it is entitled to registration, it is entitled to protection." And then for a majority of the same Court to say: (192 Fed., 915) "We have held that the surname "Davids" was a valid trade-mark under the ten-year clause of the Act of 1905" and then proceed to refuse protection which, without question, it would have afforded had the trade-

mark not been a *surname*, is evidently a *non-sequitur*.

On the other hand the logical (or *sequitur*) conclusion would be that stated by his Honor Judge Noyes in dissenting:

> "We have held that complainant had a valid registered trade-mark in the name 'Davids'. This requires us to hold, as it seems to me, that the prominent use of the same name in the same business by the defendants should be enjoined".

To put these two positions in the somewhat old fashioned form of alternative syllogism:

The word "Davids" is entitled to protection against imitation.

Defendants' use of the word is an imitation of the words "Davids".

Therefore, the word "Davids" $\{^{\text{is}}_{\text{is not}}\}$ entitled to protection against defendants' use of the word.

After careful and we hope, thorough, study of the decision sought to be reviewed, together with all the circumstances and subsequent decisions as above stated, we are able to find only one theory on which said decision can be sustained.

We venture to express our earnest belief that this Honorable Court will not adopt that theory.

That theory is that trade-marks, like plants, fishes, birds, and animals are divisible into Families, Genera, Species, and Varieties.

We respectfully submit that a trade-mark is a trade-mark. A trade-mark in One. It is *sui generis*, and not subject to divisional classification.

We know of no distinction ever drawn at common law between trade-marks which are entitled to complete (family) protection; those entitled to general (generic) protection; those entitled to special (specific) protection, and finally those entitled to very little (variety) protection.

Nor did we ever have before, so far as we have been able to discover, any such division attempted

to be made by the Federal courts. The division of all marks, words, pictures, devices, and symbols used in trade is between those which *can* acquire a title to protection as trade-marks, and those which *cannot*.

There is no division which we have heard of as to the *degree* of protection to which different trade-marks are entitled.

We respectfully submit that until this Honorable Court shall hold otherwise, a trade-mark which is entitled to *any* protection is entitled to *full* protection.

Congress, by the Act of 1905, transferred certain marks from the unprotected division (at common law) to the protected division (in interstate commerce).

In so doing Congress uses the word "mark" as distinguished from "trade-mark" seventeen times in the Act of February 20, 1905, and off-sets one against the other by saying no *mark* shall be refused registration as a *trade-mark;* may register the *mark* as a *trade-mark*, etc.

Before registration it was a mark. Upon registration it became a trade-mark.

As a trade-mark it is entitled, we respectfully submit, to the same protection as any other trade-mark.

The Majority Decision.

Simply that we may not be thought (from its omission from the present brief) that we waive the point made in our brief in support of the motion that it was *ultra vires* for two Judges alone to overrule or reverse the previous decision of their full bench, we will simply state here that we prefer to discuss that question orally at the argument instead of elaborating it in the brief.

Conclusion.

With full appreciation of the value of the time of the Court, and the arduous character of the mental labor required of your Honors in passing upon more complicated questions in other cases, we have tried to make this brief as short and concise as possible.

Therefore, in conclusion, we will content ourselves with stating again in somewhat different language what we consider the main, if not only contention in this case:

A surname, when once validly registered as a trade-mark, should not be denied the same protection as a trade-mark which was not a surname.

The decision to be reviewed has denied us that protection.

We, therefore, respectfully ask that the majority decision of the Court below be reversed and the cause remanded with instructions to affirm the decree for injunction rendered by his Honor Judge Hough in accordance with his able opinion (pp. 104 to 107, Transcript of Record) and in accordance with the concise and convincing dissenting opinion of his Honor Judge Noyes.

Respectfully submitted,

W. P. PREBLE,
Of Counsel for Petitioner.

New York, December 5, 1913.

EXCERPT

from our brief before the Circuit Court of Appeals for the Second Circuit (178 Fed., 801).

The common law right of trademark is, in the nature of things, limited to the State in which the trade is carried on. A trader in New York State cannot, at common law, acquire a trademark which is valid in the sovereign and independent State of Massachusetts. Massachusetts could, by statute, extend trading privileges within her boundaries to the citizens of New York, but that would be by statute. So with all other states.

Congress, on the other hand, under its constitutional power to regulate commerce among the several states, can create a statutory right of trademark to be used in interstate commerce, which is quite distinct from the common law trademark rights which may arise in the different states.

The Act of February 20, 1905, was not intended to create, enlarge or diminish the common law rights of trademark which any trader acquired in his own State by doing business in his own State. It was, however, intended to create a *new right* of trademark, a right which applied to interstate commerce, which is exclusively within the control of Congress.

In creating this new right Congress had the power to say whether every trademark recognized by a State should be recognized by Congress and also whether any marks not recognized by the State should be recognized in interstate commerce.

(*f*) Time and again, before the Act of February 20, 1905, was passed, the Courts had recognized a sort of proprietary interest in marks which were not technically trademarks, but which, through long continued use, had acquired the right to pro-

tection, which came pretty close to being a trademark right. Among recent cases may be cited:

Standard Varnish Works *v.* Fisher, 153 Fed., 928; May 13, 1907;

Lowe Bros. Co. *v.* Toledo Varnish Co., 168 Fed., 627; Mar. 22, 1909.

(*g*) Although this act was passed so as to take effect in April, 1905, there has been, apparently, only one case in which the effect of the ten year clause has been considered. This case, cited by the Court below, was *in re* American Glue Co. (123 Off. Gazette, 999). The decision was rendered in the District of Columbia, and involved, not a mere family surname, but the seal of the United States. A question of public policy, therefore, arose in that case, which distinguishes it from the present case.

THE ACT OF 1905.

Section 5 of the Trademark Act of February 20th, 1905 (or so much thereof as need be quoted here), reads as follows:

"That no *mark* by which the goods of the owner of the *mark* may be distinguished from other goods of the same class shall be refused registration as a trademark on account of the nature of such *mark*, unless such *mark* * * * and provided further that nothing herein shall prevent the registration of any *mark* * * * which was in actual and exclusive use as a trademark of the applicant or his predecessors, from whom he derived title for ten years next preceding the passage of this act."

Complainant's contention is that this section entitles it to register "as a trademark" the *mark* which it and its predecessors had actually and exclusively used as a *mark* which distinguished its inks, mucilage and paste from other goods of the same class for eighty years next preceding the passage of said act, in spite of the fact that said *mark* may not be a technical trademark (if it is

to be regarded as a surname), and therefore might be excluded from registration were it not for the proviso above quoted and commonly known as the ten-year clause.

Defendant seems to contend that neither the ten-year clause nor any other part of the act of February 20th, 1905, permits the registration of anything except technical trademarks recognized as such at common law, and more particularly that surnames are expressly refused registration.

The Court below seems to adopt this theory.

Hence the appeal.

To determine which view is correct it is necessary to analyze the act as a whole so far as the question of what may or what may not be registered by the Patent Office and sustained by the courts.

As before stated, this does not seem to have been done in any case, except the Glue case, as to the seal of the United States, and the matter is therefore practically unbroken ground.

It is eminently fitting that the real meaning and effect of this act should be first determined by the Circuit Court of Appeals for that Circuit which contains the most important trade interests of the country and which witnesses the greatest amount of patent and trademark litigation.

Mark *v.* Trademark.

The key to the Act of February 20, 1905, lies in the difference between the two words—Mark and Trademark. The correct disposal of cases like the present depends upon an appreciation of this difference.

We respectfully submit that the Court below is entirely wrong in its interpretation of Section 5 of this Act.

This act calls some things "marks" and other things "trademarks." Congress not only uses these two terms in the Act but in most instances carefully distinguishes between them.

The learned Judge of the Court below ignores the difference between these two terms and treats them as synonyms.

They are not synonyms.

A "trademark" is a mark used in trade, and of such a character as is recognized at common law as a lawful trademark.

A "mark" is a mark used in trade and of such a character as is *not* recognized at common law as a lawful trademark.

It is evident from the decision of the Court below that the learned Judge reads the words mark and trademark as they occur in Section 5 of the Act of February 20th, 1905, as if they meant exactly the same thing.

This is to destroy absolutely the effect of the ten-year clause, and with it the intent of Congress.

To bring this out clearly let us read the ten year-clause substituting the word "trademark" for the word "mark" therein. It will then read as follows:

"And provided further, that nothing herein shall prevent the registration of any trademark used by the applicant or his predecessors, or by those from whom title to the trademark is derived, in commerce with foreign nations and among the several States or with Indian tribes which was in actual and exclusive use as a trademark of the applicant or his predecessors from whom he derived title for ten years next preceding the passage of this act."

Had that been what Congress meant to incorporate into the law, the provision would have been meaningless, because the law had already provided in its first clause that the owner of a *trademark* used in such commerce was entitled to registration irrespective of the length of use.

It would seem conclusive therefore, that when Congress substituted the word "mark" for "trademark" it meant to authorize the registration *as trademarks* of *marks* which were *not trademarks* but which had been actually and exclusively used

as trademarks for ten years or more before the passage of the Act.

When therefore his Honor, Judge Ray, says (page 41, line 1), "It must have been a trademark and a lawful trademark recognized as such by the law prior to the passage of the Act. * * * The proviso means that nothing in the Act is to prevent the registration of a trademark theretofore valid as such if it had been in use, etc., ten years. It does not purport to validate anything as a trademark, or to make a valid trademark out of a surname not before constituting a valid trademark," he deliberately makes nugatory the one saving clause of the Act which was evidently designed to prevent the spoliation of manufacturers whose goods have become known through long-continuous, uninterfered-with, use under a designation, the original adoption of which was unwise in that such designation did not *per se* constitute a lawful trademark under the common law.

Unwise in its inception does not necessarily mean unlawful in its adoption.

Congress has carefully distinguished, in Section 5, those marks unwisely adopted which it would be against public policy to make valid by long use from those unwisely adopted marks which do not contravene public policy.

Congress has singled out for refusal immoral and scandalous marks and those which contain the American flag or other insignia. But Congress nowhere says that a surname unwisely adopted ten years or more ago and actually and exclusively used as a trademark for that length of time cannot be registered under the act.

Congress stood upon the common sense ground that some marks are so distinguishing at the start that a very short use entitles them to protection, while other marks are not originally so distinguishing and require a long use to become so and to become entitled to protection.

Common law concerns State rights and recognizes

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only the former marks. Congress is concerned with interstate commerce and recognizes both kinds of marks.

Section 5 does not begin "that no *trademark*," etc., but begins "that no *mark*."

If Congress had intended by this act of February 20th, 1905, to authorize the registration of valid trademarks only and not the registration as trademarks of other marks, that is, of marks which were not lawful trademarks at common law under certain conditions, Section 5 would have read as follows, at the beginning:

"That no trademark by which the goods of the owner of the trademark may be distinguished from other goods of the same class shall be refused registration as a trademark on account of the nature of such trademark, unless such trademark," etc.

That is not what Congress said, and why should the Court below read what Congress did say as if it had said *that?*

In the first four sections of the act, Congress sets out who may register trademarks and how.

The word "trademark" is used eighteen times in these four sections, and the word "mark" three times.

But these three times when the word "mark" is used refer to marks which are used abroad, thus clearly showing that Congress had in mind the fact that foreign countries might register as trademarks, marks which we might not regard as lawful trademarks if originating here.

Having thus, in four sections, shown what "trademarks" may be registered and how, Congress proceeds, in Section 5, to set forth what "marks" which are *not* trademarks may be registered "as trademarks."

Could anything be clearer?

With all the lawyers in Congress—with all the other experienced senatore and representatives—would Congress have suddenly shifted to the word

"mark" if it had not intended something different from "trademark"?

Especially as it says: That no *mark* * * * shall be refused registration "*as a trademark.*"

What right, we respectfully ask, had the Court below to read "trademark" where Congress wrote "mark"?

Courts are organized to interpret the laws, not to alter them?

Congress may be safely presumed to have known what it was doing when it drew a distinction between technical trademarks which are entitled to registration as such if used in certain commerce, and marks, not technical trademarks, some of which are also entitled to registration as trademarks, if used in the same commerce.

But that is not all:

The word "trademark" is used fifty-nine times in the twenty-five subsequent sections of the Act, while the word "mark" is used fourteen times.

These fourteen uses are: 3 in Sec. 6, 4 in the third clause of Sec. 7, 2 in Sec. 10, 2 in Sec. 13, 1 in Sec. 21, 1 in Sec. 27, and 1 in Sec. 29.

In the entire Act, therefore, the word "trademark" is used 83 times, and the word "mark" 24 times.

By comparing the context in which these two words occur, it becomes almost too plain for argument that, by the Act of February 20, 1905, Congress intended that two classes of marks should be submitted to, and registered by the Patent Office as Trademarks, for Interstate and International Commerce.

After registration the mark is a trademark, whatever it was before.

Before registration the mark may *or may not* have been a trademark at common law.

Registration can be refused only in case the mark, whether valid at common law or not, comes within the prohibited classes of Section 5.

To make this perfectly plain:

Section 5, says no "mark" shall be refused registration "as a trademark."

The last proviso of that section says nothing shall prevent the registration of any "mark" which was in use "as a trademark."

Section 7, third paragraph, says "or may register the mark as a trademark."

Three times, therefore, the Act places these two words in direct opposition to each other.

Before registration it was a mark. Upon registration it became a trademark.

Section 6 provides that the "mark" for which registration is desired is to be published in the Official Gazette and that any person who believes he will be damaged by the registration of a "mark" may oppose it, filing his opposition within thirty days after the publication of the "mark saught to be registered."

Section 7, third paragraph, provides that the commissioner may refuse to "register the mark" or "both of two interfering marks, or may register the mark, as a trademark, for the person first to adopt and use the mark."

Section 10 begins, "That every registered trademark and every mark for the registration of which application has been made" shall be assignable in connection with the good will of the business in which the "mark" is used.

Section 13 provides that after a trademark has been registered anybody who shall deem himself injured by such registration may apply to have it cancelled and prove either that the one who registered was not entitled to the use of the "mark" or or that the "mark" is no longer used by him.

Section 29, in giving definitions, says, "the term trademark includes any mark which is entitled to registration under the terms of this act."

How could anything be clearer than these repeated uses of the word "mark" as the thing to be registered, published and protected to show that it was the intent of Congress to make the registration

of a "mark" dependent, not upon the question of whether that "mark" was a valid trademark at common law, but whether the mark, so offered, conformed to the requirements specifically prescribed by the act itself.

As another instance Section 2 provides that when the applicant for registration resides or is located in a foreign country the trademark must have been registered or application for registration made in that foreigh country, but that the use of the "mark" in the United States need not be alleged.

In other words, in the case of foreign marks home registration rather than use here is made the test. Obviously, as common law means the common law of England and the United States, and is unknown in other foreign countries, a requirement that the "mark" offered for registration by a foreigner should be a valid trademark at common law would be absurd.

We therefore respectfully submit that Congress has carefully distinguished between a registered trademark, a trademark at common law, and those marks which are entitled to registration as trademarks whether common law trademarks or not.

Either of these two classes can be registered as "trademarks" if they fulfil the requirements of the act. Neither of them can be registered if they do not fulfil the requirements of the Act.

We submit that the Act of Feb. 20, 1905, clearly shows, taken as a whole, that every mark, whether a technical trademark or not, which *actually distinguishes* the goods to which it is applied from other goods of the same class is entitled to registration *as a trademark* upon compliance with the requirements set forth in the first four sections of the Act unless such mark comes within the prohibited classes named in Section 5.

Also, that no mark whether a technical trademark or not is entitled to registration as a trademark for

interstate and international commerce if it comes within the positive prohibitions of Section 5.

Upon this question of registering or refusing to register a mark offered for registration as a trademark for the purposes of interstate and international commerce, Section 5 contains four limitations by way of proviso:

Conflicting trademarks should not be registered for obvious reasons, as the object of a trademark is to distinguish goods, not to confuse them.

Mere names of individuals, firms, corporations and associations, descriptive terms and merely geographical names or terms are not ordinarily to be registered.

Portraits of living individuals require the consent in writing of the individual.

But if any mark has been in actual and exclusive use a trademark by the applicant or his assignors for ten years or more, before February 20, 1905, *that* mark is entitled to be received and registered for use in interstate commerce.

Such are the four provisos of Section 5.

It is not necessary to consider the hypothetical question of whether immoral or scandalous marks would have been allowed an actual and exclusive use for ten years anywhere nor whether such actual and exclusive use for ten years prior to February 20, 1905, could be predicated of the national flag, or a state flag or the other insignia mentioned in clause (*b*).

It is hardly likely that the Court will ever be faced with either of those propositions. Should such a case arise it might be that the Court could infer from the emphatic mention of those two classes of marks, (*a*) and (*b*), that the fourth proviso or ten year clause was not intended by Congress to reach back to them.

It is also reasonably evident that the fourth proviso was not intended to authorize the registration of conflicting marks mentioned in the first proviso.

But, we respectfully submit that unless the fourth

proviso is absolutely nugatory, it must be read as authorizing and requiring the registration, as a trademark, for use in commerce with foreign nations and among the several states, of such names of individuals, firms, corporations, and associations, and such descriptive and geographical terms and such portraits of living individuals as were *in actual and exclusive use* as trademarks of the applicant or his predecessors from whom he derived title for ten years next preceding February 20, 1905.

We fail to see how any other interpretation of this fourth proviso is tenable.

If Congress had meant to exclude the marks named in the second and third provisos from the benefit of the ten-year proviso, it would have said "prevent the registration or any *other* mark," instead of "any mark."

If Congress had meant that only common law trademarks could be registered it would not have repeatedly used the phrase, "mark, as a trademark."

Common law trademarks did not require ten years use to entitle them to registration,—any time would do.

Besides all which, if Congress had meant by this fourth proviso only to refer to lawful trademarks it would have said "in lawful use" instead of "actual use."

Congresional Record.

If there remains any doubt in the mind of the Court that the proper interpretation of the fifth section of this Act is that "mark" means something different from technical trademark, the Court is repectfully asked to take judicial notice of what the Congressional Record, Volume 39, reports as to the proceedings of Congress when this act was still a bill under discussion.

We venture to insert here the following citations from that volume:

Congressional Record, Vol. 39:

Page 292, the Bill, H. R. 16,560, which afterwards became (with a few admendments) the Act of February 20, 1905, was first introduced in the House of Representatives, on December 14, 1904, by Mr. Bonynge of the Committee on Patents, and was referred to the Committee on Patents.

Page 421, December, 19, 1904, reported back by Mr. Bonynge without amendment, and referred to the House Calendar.

Pages 884 to 887, January 14, 1905, Mr. Bonynge asked unanimous consent for the consideration of the bill; Mr. Williams of Mississippi, asked for some explanation of the bill. Part of the debate was as follows:

Mr. BONYNGE: Mr. Speaker, this is a bill which has been prepared by the Committee on Patents, revising the trademark laws of the United States. The present trademark law does not cover the registration of trademarks used in interstate commerce; it only applies to trademarks used in foreign commerce and in commerce with the Indian tribes.

* * * * * *

(P. 885):

Mr. WILLIAMS, of Mississippi: Does it simply extend the rules now existing as to the registry of trademarks used in foreign commerce to interstate commerce?

Mr. BONYNGE: No; it goes much further than that. It changes the method of procedure for the registration of trademarks. There has been, under the present law, no way by which an appeal could be taken from the decision of the Commissioner of Patents upon the question whether a mark was entitled to be registered or not or upon any other question. This bill provides for such an appeal to the Court of Appeals of the District of Columbia, the same as in

patent cases, and the procedure for the registration of trademarks is modeled after the procedure for the obtaining of a patent. It provides fees for all the proceedings. It changes the life of a certificate of registration of a trademark from thirty years to twenty years, to agree with the term fixed by the International Union, and in many other respects amends the present law as to make it conform to treaty stipulations that the United States Government has entered into from time to time with different foreign nations. It prescribes remedies both at law and in equity for the infringement of registered trademarks. *It provides specifically the character of a trademark that can be registered* under the law, and in many other respects changes and modifies existing law in reference to trademarks. It has in its favor the unanimous report of the Committee on Patents. We had elaborate hearings before that committee on the bill, and all interests that appeared before the committee have united in favor of the bill that has been reported by the committee. If there are any other gentlemen who desire to ask any questions respecting the bill, I shall be very glad, as far as I am able, to answer them.

THE SPEAKER: Is there objection to the present consideration of the bill? (After a pause). The Chair hears none. The Clerk will report the bill."

The bill was then read and passed.

(The bill thus passed was just like the Act of 1905, except for a few amendments, which will appear later.

Page 903—January 16, 1905, the bill as passed by the House was introduced in the Senate and referred to the Committee on Patents.

Page 1297—January 24, 1905, the bill was reported back from the Committee on Patents by Mr. Kittredge, with amendments.

Page 1398—January 26, 1905, the bill was called up thus:

Mr. KITTREDGE: I ask unanimous consent for the present consideration of the bill (H. R., 16,500) to

authorize the registration of trademarks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same, and that the unfinished business be temporarily laid aside for that purpose.

Mr. BEVERIDGE: That, I will say, is entirely agreeable to those who are in charge of the unfinished business. The understanding is that the bill called up will provoke no discussion. It ought not, certainly. It is very meritorious.

The PRESIDENT *pro tempore:* The Senator from South Dakota asks unanimous consent for the consideration of a bill, which will be read to the Senate for its information.

The Secretary proceeded to read the bill.

Mr. TELLER: I should like to know what this bill is. I cannot hear.

Mr. BEVERIDGE: A trademark bill.

Mr. TELLER: I should like to know what committee it comes from. I should like to know something about the bill. As I cannot hear the bill as it is being read, I should like to know who stands back of it, at least.

Mr. KITTREDGE: It comes from the Committee on Patents.

Mr. TELLER: I think we are entitled to hear what it is.

The Secretary resumed and concluded the reading of the bill.

THE PRESIDING OFFICER (Mr. Perkins in the Chair). Is there objection to the present consideration of the bill?

Mr. CLAY: Does the Senator from South Dakota desire to place the bill on its passage this evening? The bill embraces twenty-odd pages and thirty sections. It was called up by unanimous consent, and Senators have not had time to examine it. I have been trying to run through it. I have had a dozen letters in regard to this measure. It may have merit; probably it has. I do not know that I have any objection to it.

Mr. MARTIN: The letters were in favor of it?

Mr. CLAY: No; some were not in favor of it. It does strike me that the Senator ought to be willing to let the bill go over for a day or two that we may have time to look into it.

Mr. KITTREDGE: I am entirely willing that the bill shall go over until such time as suits the Senator's convenience, with this proviso: I should like to have the committee amendments acted upon.

Mr. CLAY: I have no objection in the world to that course, but I have not had time to read the bill.

Mr. KITTREDGE: After the amendments have been acted upon I shall have no objection to its going over.

There being no objection, the Senate, as in Committee of the Whole, proceeded to consider the bill, which had been reported from the Committee on Patents with amendments.

The first amendment was in Section 2, page 3, line 3, after the word "and" to strike out "facsimile" and insert "drawing," so as to read:

That such trade-mark is used in commerce among the several States, or with foreign nations, or with Indian tribes, and that the description and drawing presented truly represent the trademark sought to be registered.

The amendment was agreed to.

The next amendment was in Section 5, page 6, line 12, after the word "any," to strike out the word "trademark" and insert "mark"; in line 13, after the word "the," to strike out "trademark" and insert "mark"; and in line 16, after the word "actual" to strike out "and lawful," so as to read:

AND PROVIDED FURTHER: That nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several States, or with Indian tribes, which was in actual use as a

trademark of the applicant or his predecessors from whom he derived title for ten years prior to the passage of this act.

The amendment was agreed to.

The next amendment was in Section 14, page 12, line 13, before the word "dollars" to strike out "five" and insert "ten," so as to make the paragraph read:

On filing each application for renewal of the registration of a trademark, $10.

The amendment was agreed to.

The next amendment was, in Section 30, page 20, line 18, after the word "effect" to strike out "upon its passage" and insert "April 1, 1905," so as to make the section read:

Sec. 30. That this act shall be in force and take effect April 1, 1905. All acts and parts of acts inconsistent with this act are hereby repealed, except so far as the same may apply to certificates of registration issued under the act of Congress approved March 3, 1881, entitled "An act to authorize the registration of trademarks and protest the same," or under the act approved August 5, 1882, entitled "An act relating to the registration of trademarks."

The amendment was agreed to.

The PRESIDING OFFICER: The amendments proposed by the committee have been agreed to, and without prejudice the bill will go over by request of the Senator from South Dakota (Mr. Kittredge).

Page 1452, Jan. 27, 1905, bill read and passed with the amendments.

Page 1751, Feb. 1, 1905, the House, without any debate, on motion of Mr. Bonynge, non concurred in the amendments and asked for a conference, naming a committee.

Page 1758, Feb. 2, 1905, the Senate, without any debate, on motion of Mr. Kittredge, insisted on its amendments and acceded to request for conference, naming a committee.

Page 2052, Feb. 7, 1905, the conference report was presented in the House by Mr. Currier, and was ordered printed.

Page 2145, February 9, 1905, the conference report was presented in the Senate by Mr. Kittredge, and agreed to.

Page 2412, February 11, 1905, the conference report was brought up in the House as follows:

Mr. CURRIER: Mr. Speaker, I call up the conference report on the bill (H. R. 16560) to authorize the registration of trademarks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same, and I ask unanimous consent that the statement be read in lieu of the report.

The SPEAKER: The gentleman from New Hampshire calls up the conference report on the bill H. R. 16560, and asks that the statement be read in lieu of the report. Is there objection?

There was no objection.

The conference report and statement are as follows:

The committee of conference on the disagreeing votes of the two Houses on the amendments of the Senate to the bill (H. R. 16560) to authorize the registration of trademarks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same, having met, after full and free conference have agreed to recommend and do recommend to their respective Houses as follows:

That the House recede from its disagreement to the amendments of the Senate numbered 1, 2, 3, 5 and 6.

That the House recede from its disagreement to the amendment of the Senate numbered 4, and agree to the same with an amendment as follows: In lieu of matter inserted by the said amendment insert the following: "and exclusive," and strike

out the words "prior to" in line 17, on page 6, and insert in lieu thereof the words "next preceding," and the Senate agree to the same.

FRANK D. CURRIER,
ROBT. W. BONYNGE,
E. Y. WEBB,
Managers on the part of the House.

A. B. KITTREDGE,
LOUIS E. MCCOMAS,
S. R. MALLORY,
Managers on the part of the Senate.

The Clerk read the statement, as follows:

Statement of the managers on the part of the House.

The managers on the part of the House at the conference on the disagreeing votes of the two Houses on the amendments of the Senate to the bill (H. R. 16560) to authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same, submit the following written statement in explanation of the effect of the action agreed upon, and recommended in the accompanying conference report as to each of the Senate amendments:

On amendment No. 1: The word "drawing" is substituted by the Senate amendment for the word "facsimile" as the bill passed the House, and is self-explanatory.

On amendments Nos. 2 and 3: The word "mark" is substituted in each instance for the word "trade-mark" in the bill as it passed the House for the reason that the use of the word "trademark" in this connection would not have accomplished the purposes of the proviso of the section in question.

On amendment No. 4: The words "and lawful" were stricken out by the Senate amendment, and by the conference report it is recommended that the words "and exclusive" be substituted therefor.

The purpose of this amendment is to prohibit the registration of any marks which are not technical trademarks unless the applicant has used such mark exclusively for the period of ten years. The words "next preceding" are inserted in place of the words "prior to" the passage of the act, so as to require the exclusive use of the mark for the ten years immediately preceding the passage of this act.

On amendment No. 5: The fee for renewal of registration is increased from $5 to $10.

On amendment No. 6: The date when the act is to take effect is made April 1, 1905, instead of upon its passage.

FRANK D. CURRIER,
ROBT. W. BONYNGE,
E. Y. WEBB,
Managers on the part of the House.

Mr. CURRIER: Mr. Speaker, I move that the House agree to the conference report.

The question was taken, and the conference report was agreed to.

On motion of Mr. CURRIER, a motion to reconsider the last vote was laid on the table.

Pages 2595, Feb. 14, 1905, the bill as enrolled was examined in the House and signed by the Speaker. *pro tem.*

Page 2601, Feb. 14, 1905, the bill as enrolled was examined in the Senate and signed by the President.

Page 2762, Feb. 16, 1905, the bill was presented to the President of the United States for approval.

Page 2954, Feb. 20, 1905, the bill was approved by the President.

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FILED
JAN 8 1914
JAMES D. MAHER

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1913.

No. 184.

THADDEUS DAVIDS COMPANY,
Complainant-Petitioner,

v.

CORTLANDT I. DAVIDS and WALTER I. DAVIDS, Trading as DAVIDS MANUFACTURING COMPANY,
Defendants-Respondents.

On Writ of Certiorari to the United States Circuit Court of Appeals for the Second Circuit.

Brief for Defendants-Respondents.

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Justin Seubert *v.* Santanella, 36 App. D. C., 520;

Becker *v.* Gambrill, 38 App. D. C., 585;

Wright *v.* Taylor, 33 App. D. C., 510;

Ex parte L. & A. Scharff, 128 Official Gazette, U. S. Patent Office, 2531 (1907 C. D., 172).

Supreme Court of the United States.

October Term, 1912.

THADDEUS DAVIDS COMPANY, Complainant-Petitioner, v. CORTLANDT I. DAVIDS and WALTER I. DAVIDS, Trading as DAVIDS MANUFACTURING COMPANY, Defendants-Respondents.	No. 184.

BRIEF FOR DEFENDANTS.

This cause, according to the amended bill of complaint (pp. 1-7), is an action under the trademark statute of February 20, 1905, as amended March 2, 1907, for alleged infringement of complainant's registered trademark "Davids," and also for alleged unfair competition because of alleged similarity of labels in the arrangement of the printed matter thereon.

Petitioner's position is that its registered trademark (pp. 76-77) has been infringed by the use of the labels on the bottles entitled Complainant's Exhibits 'Specimen of Defendants' Black Ink" and "Specimen of Defendants' Red Ink."

In the District Court, Judge Hough (Opinion,

pp. 104-106) sustained the bill of complaint and decreed that the trademark had been infringed (Decree, p. 107). On appeal to the Circuit Court of Appeals this decree was reversed (Opinion, pp. 111-112).

Court Cannot Take Jurisdiction of Unfair Competition.

The only question of which the lower Court (or this Court) can take jurisdiction is as to whether or not the registration of the trademark is valid and the trademark has been infringed. The Court has no jurisdiction whatever of any question of alleged unfair competition or mere similarity of labels, because complainant and both defendants are citizens of the same State, viz., the State of New York (Preamble to Bill of Complaint, p. 1). Notice of this lack of jurisdiction as to any such matters was given both during complainant's proofs and defendants' proofs (two-thirds the way down p. 51, and nearly the middle of p. 90).

The Court had no jurisdiction of any unfair competition matter.

> "This was a bill in equity for an injunction and accounting, the complainant alleging that defendant had infringed its technical trademark applied to shirts and also was guilty of unfair competition. As complainant is a corporation of the State of New York and defendant is a citizen of the same State, the Court's jurisdiction extends only to the use of the registered trademark in commerce between the States, with foreigin nations, and the Indian tribes."
>
> *Hutchinson, Pierce & Co.* v. *Loewy*, 217 U. S., 457 (838 L. Ed.).

Elgin v. *Illinois,* 179 U. S., 665 (672-677, L. Ed.).

Leschen v. *Broderick,* 201 U. S., 166, 167, L. Ed.

Hutchinson, Pierce & Co. v. *Loewy,* 163 Fed. Rep., 42.

Burt v. *Smith,* 71 Fed. Rep., 161.

National Casket Co. v. *N. Y. & B'klyn Casket Co.,* 185 Fed Rep., 533.

Diedrich v. *Schneider,* 195 Fed. Rep., 35.

As stated by the Court of Appeals for the Second Circuit in *Burt* v. *Smith,* above:

> "The complainants and defendants are all citizens of the same State. The Federal Court can take jurisdiction, therefore, only of the question whether the registered trademark declared upon has been infringed, and that trademark solely for the two letters S B, without any designation of style of type, position on the cover, or association with other elements of dress or decoration."

According to its brief the petitioner, Thaddeus Davids Company, does not now urge any alleged unfair competition matters.

Therefore the only question which this Court can consider is as to whether or not the registered trademark "Davids" is valid and has been infringed by the name "C. I. Davids" used on defendants' labels.

Defendants Have a Right to Use Their Own Name.

C. I. Davids is the grandson, and W. I. Davids is the great-grandson, of the original Thaddeus Davids, who founded the complainant company

(Q1-4, p. 84). C. I. Davids used to be in the business of manufacturing sealing wax, but sold out to Carl T. Kuehler, C. I. Davids agreeing not to go into the sealing wax business (RDQ106-108, p. 91). He had no other trade (Q31, p. 86). Walter Davids was only 16 years old at that time.

Subsequently, David F. Davids, who was then *President of the complainant company*, came to Walter Davids (Q3-6, p. 92), and requested him to go into the employ of the complainant company, saying that there was no young blood in the company and *asked him to learn the business from top to bottom* (Q8-11, p. 93). According to this request, Walter Davids entered the complainant's employ and did learn all he could about the business of manufacturing inks and other articles, although (Q34, p. 86), the ingredients and general method of manufacture of the inks, mucilage and paste of the complainant company were practically the same as had been generally known to ink manufacturers for a great many years. C. I. Davids was also employed by the complainant.

The defendants remained in the employ of the complainant company until after Mr. David F. Davids, the then President, died. In March, 1906, Edwin W. Davids, the Secretary of the company, in a fit of drunken rage discharged the two defendants merely because he accused C. I. Davids of calling him a "sucker" (Q15-25, p. 85 and Q12-14, p. 93).

The defendants were then turned out on the world, C. I. Davids over 40 years old, and his son about 20 years old, without any trade by which they could earn their living except the business of manufacturing inks, mucilage and paste. Naturally they went into this business, for they knew no

other. They got up the present labels used by them (on bottles entitled Complainant's Exhibits "Specimen of Defendants' Black Ink" and "Specimen of Defendants' Red Ink") which obviously are not similar in any respect to the complainant's labels, except for the name "C. I. Davids." This is admitted by the President, Mr. Merckle, of the complainant company (XQ60, p. 19). They obtained the advice of counsel before they adopted the labels (Q61-63, p. 88). They do not sell their goods as the complainant's goods, nor do they wish to (XQ92, p. 90).

The defendants are here with "clean hands." They were virtually forced into this business by the action of complainant's officers.

The Acts Complained Of Are Mere Alleged Similarity of Labels.

The registered trademark is the mere word "Davids," not "Thaddeus Davids Company," nor the general appearance of complaiant's labels. No mention is made in the registration of any special manner of arrangement or use.

As stated by the Court of Appeals for the Second Circuit in *Burt* v. *Smith*, above cited (bracketed portion mine):

> "The complainant and defendants are all citizens of the same State. The Federal Court can take jurisidiction, therefore, only of the question whether the registered trademark declared upon has been infringed, and that trademark solely for the two letters S B [in our case the word "Davids"], without any designation of style of type, position on the cover, or association with other elements of dress or decoration."

The question here is infringement of the registered trademark "Davids." This word is used near the top of defendants' label, together with the initials of the elder defendant, viz., "C. I. Davids" and if this use is not an infringement, then there is no infringement at all.

The bill of complaint concedes that this is no infringement, for it has been specifically waived therein. Paragraph (13) of the bill (p. 5) reads as follows (italics mine):

> "13. That the specific act of infringement herein complained of as affecting your Orator's said registered trademark consisted, *not* in the mere use of the word 'Davids' without otherwise labelling their goods to produce confusion (*your orator having no objection to the mere use of the name C. I. Davids on defendants' goods*), but in setting said word 'Davids' in prominent type at the *top* of the label, the word 'Ink,' 'Paste' or 'Mucilage' also in prominent type near the *middle* of the label, and the arbitrary adopted trade name of 'Davids Mfg. Co.' in imitation of your orator's trade name, Thaddeus Davids Co., at the *bottom* of the label."

Complainant states specifically that it has "no objection to the mere use of the name 'C. I. Davids' on defendants' goods, but what it does complain of is, legally, only alleged unfair competition in the arrangement on the label. This latter the Court has no jurisdiction of as heretofore pointed out, even if there were any ground for complaint on that score, which we consider there is not. The name "Davids" is the sole cause of any confusion which there may be. As stated by Mr. Merckle, President of the complainant company (p. 19):

"XQ59. What I mean is, if the name at the top were 'G. I. Smiths' instead of 'C. I. Davids' and the name at the bottom were 'Smiths Mfg. Co.' instead of 'Davids Mfg. Co.' on the defendants' labels, there would then be no cause for complaint by your company, would there?

"A. I don't see how there could be.

"XQ60. It is the name 'Davids' which is the sole cause of the confusion as you consider it between the labels of the defendants and the complainant's manner of marking its goods. That is correct, is it not?

"A. That is correct."

Immediately following he states that other ink manufacturers have for at least the last 21 years been accustomed to put their name at the top, the word "ink" at the middle and the name of the company at the bottom.

In view of the waiver in Paragraph 13 of the bill of complaint and the above testimony, we think that the acts alleged are acts of alleged infringement of a *common-law right merely*, of which this Court has no jurisdiction, and that the Court of Appeals was right in its decision for the reasons expressed therein, even without taking into consideration any other matters.

One Interpretation of the Statute.

While we believe that there has been no infringement for the reasons given under both of the previous headings, this cause is an important one under the Trademark Law as it was, I believe, the first to bring up for interpretation the so-called "ten-year clause" of the statute, and it is important to the public at large that this matter be passed upon by this Honorable Court in order

that the correct interpretation be settled once for all. For this reason defendants did not oppose the petition for the writ of certiorari. Even though we believe that the present bill must fail for other reasons, we wish to know whether or not under the statute we are right in using our name "C. I. Davids" in order that the matter need not be again brought before the Courts.

Obviously the only right to register a surname under the Trademark Statute must be found, if at all, under the last "Provided" clause of Section 5 of the Trade Mark Act, as it stood in 1908 when the bill was filed. That section read as follows:

> "*Sec.* 5. That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trademark on account of the nature of such mark unless such mark—
>
> "(a) Consists of or comprises immoral or scandalous matter.
>
> "(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or any simulation thereof, or of any State, or municipality, or of any foreign nation, or of any design or picture that has been or may hereafter be adopted by any fraternal society as its emblem; *Provided*, That trademarks which are identical with a registered or known trademark owned and in use by another, and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trademark owned and in use by another, and appropriated to merchandise of the same descriptive properties, as to be likely to cause confusion or mistake in the mind of the pub-

lic, or to deceive purchasers, shall not be registered: *Provided*, That no mark which consists merely in the name of an individual, firm, corporation, or association, not written, printed, impressed, or woven in some particular or distinctive manner or in association with a portrait of the individual or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this act: *Provided further*, That no portrait of a living individual may be registered as a trademark, except by the consent of such individual, evidenced by an instrument in writing: *And provided further*, That nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several States, or with Indian tribes, which was in actual and exclusive use as a trademark of the applicant or his predecessors from whom he derived title for ten years next preceding the passage of this act.*"

This last clause is commonly termed the "ten-year clause."

Except for this clause, the Statute does not give the right to register any mark unless it is a trademark capable of exclusive ownership under the common-law.

Sec. 1 of the Statute reads as follows (italics mine):

"Be it enacted by the Senate and House of Representatives of the United States of Amer-

* On Feb. 18, 1911, this clause was added:
"Provided further, That nothing herein shall prevent the registration of a trade-mark otherwise registrable because of its being the name of the applicant or a portion thereof."
The bill of complaint was filed in 1908 (discussed *post* p. 18).

> ica in Congress assembled, that the *owner* of a trademark used in commerce with foreign nations or among the several States, or with Indian tribes, provided such *owner* shall be domiciled within the territory of the United States * * * may obtain registration for such trademark by complying with the following requirements. * * *"

Obviously *before* there is a right to registration the applicant must be the "owner." He cannot become the owner except according to the common-law. According to the common-law no one can be an "owner" of a mere surname to the exclusion of others of that name.

> *Howe Scale Co.* v. *Wyckoff, Seamans & Benedict*, 198 U. S., 134, and cases cited.

Therefore, except for the 10-year clause under Section 5, a valid registration may not be obtained unless previously to such registration the mark is such as to be capable of exclusive ownership and is actually owned. Consequently a mere surname, not being capable of exclusive ownership under the common law, cannot be registered under Section 1.

The 10-year clause, however, apparently gives the right to *register* the mark if it has been in "exclusive use as a trademark * * * for ten years next preceding the passage of this act." The words "exclusive use" mean a use by the applicant or his predecessors solely.

> *In re Cahn Belt & Co.*, 27 App. D. C., 177.
> *Wrigley* v. *Norris*, 34 App. D. C., 138.
> *Worcester Brewing Co.* v. *Reuter*, 30 App. D. C., 428.

We will assume for the purpose of the present interpretation under consideration, that the com-

plainant company had used this word "Davids" exclusively in this sense for the required ten years.

It will be observed that the 10-year clause does not confer any right of ownership. It merely confers right of registration. In fact there is nothing in the entire trademark Statute which *grants* to a registrant thereunder any right of ownership. The Patent Office by registration of a mark, even a technical common-law trademark, does not by its certificate of registration grant any right. The Court will search the Statute and the registration here at issue (p. 76, Record) in vain to find any grant of ownership in the trademark.

Even when we come to Sections 16 and 19 in regard to suits for infringement, we find that ownership is a prerequisite to the maintenance of such a suit. The material portions of these sections read as follows (italics mine):

> "Sec. 16. That the registration of a trademark under the provisions of this act shall be *prima facie* evidence of ownership. Any person who shall without the consent of the *owner* thereof reproduce * * * such trademark and shall use or shall have used such reproduction * * * in commerce among the several States * * * shall be liable to an action for damages therefor at the suit of the *owner* thereof * * *"

> "Sec. 19. That the several courts vested with jurisdiction of cases arising under the present act shall have power to grant injunctions according to the course and principles of equity to prevent the violation of any right of the *owner* of a trademark registered under this act * * *"

These sections specify the "owner," not the "registrant" merely. The first clause of Section 16 emphasizes this.

Therefore in order to obtain damages or an injunction under this act the registrant must be the actual "owner" of the mark. But the Statute does not confer right of ownership in any case, and especially is this true under the 10-year clause which merely in words grants the right of registration.

Therefore, according to the Section 1 of the Statute, exclusive ownership of a mark is a prerequisite to registration, which limits such right of registration to a common law trademark; but the 10-year clause grants a right of *registration* merely, to an exclusive user for the requisite 10 years of a non-technical trademark, of which exclusive ownership cannot be obtained. Sections 16 and 19, however, require, as a prerequisite to the maintenance of a suit for damages, profits or an injunction, that the registrant shall be the "owner."

Consequently, an injunction, profits or damages cannot be awarded in this cause to the complainant, as it is not an "owner."

This was one of the points brought up by the present defendants before the Court of Appeals for the Second Circuit on the demurrer to the former bill of complaint and on which the Court rendered its first decision, which may be found in 178 Fed. Rep., 801. This was a decision on demurrer before proofs, and not on the present amended bill of complaint. The Court said (bracketed portion mine):

> "And if it [the trademark] is entitled to registration it is entitled to protection. We are unable to appreciate the distinction sought to be drawn by the defendant between the right to register a trademark and the right to protect it."

The point we tried to make before that Court was that Sections 16 and 19 permit suits to be brought only by one who is an "owner" of a registered trademark, and that complainant is not an owner. This is not inconsistent with the provisions of the 10-year clause. That clause allows registration whether the registrant is the actual owner or not. Congress seems to have intended that the exclusive user of a non-technical trademark may register it under the 10-year clause, but cannot maintain a suit for an injunction or damages under the Trademark Act unless he is an "owner." It seems to have intended such registration to be merely a record, as it were, of a claim to ownership, for the purpose of notifying the public of a claimed right therein (in the same way that the record in the Patent Office of an assignment of a patent is a notice to the world of a claimed right to that patent, but is not the grant of any right), leaving it to the Court to determine whether or not the registrant was the "owner" under the common law.

If this line of reasoning is correct, the petitioner here may have had a right to register its surname, but, not being the exclusive "owner" of it, it cannot maintain a suit under the Trademark Act for profits, damages or an injunction. If this is so, then this cause must fail for that reason alone.

The distinction between the right to register and the right to maintain a suit is brought out by Section 21 of the Act. According to it, even though a mark is registered a suit cannot be maintained if the mark falls within any of the classes specified in that section.

Interpretation by the Court of Appeals of the District of Columbia.

It will be observed that Section 5 provides:

> "That no mark by which the goods of the *owner* of the mark may be distinguished from other goods of the same class shall be refused registration as a trademark on account of the nature of such mark unless such mark * * *"

then follows certain prohibitions, two of which are that no

> "flag or coat-of-arms or other insignia of the United States or any simulation thereof or of any State or municipality shall be registered,"

and

> "provided that no mark which consists merely in the name of an individual * * * shall be registered under the terms of this act."

The ten year clause follows under an "And Provided Further" caption. This clause uses the words "any mark," but the Court of Appeals for the District of Columbia in *In re Cahn Belt & Company* (27 App. D. C., 177), held that

> "the proviso [of the ten year clause] only extended the right of registration to marks not within either of the prohibited classes,"

and held that a mark consisting of a simulation of the arms or seal of the State of Maryland was not entitled to registration even under the ten year clause. The Court also said:

> "It is plain this proviso in extending to marks not technical trademarks the right to

registration, intended to confine the marks permitted registration to such as would be legitimate trademarks under this section. The fifth section, taken in its entirety, which prohibited the registration of technical trademarks when such were scandalous, or immoral, or simulations of public insignia, did not at the same time permit marks in actual and exclusive use for ten years to be registered as trademarks if such marks were either scandalous, or immoral, or simulations of publis insignia. To permit under this proviso to the section, the registration of a scandalous mark and to prohibit under the section the registration of a technical trademark which was scandalous, would be absurd. The proviso which was meant to be a saving clause for certain marks cannot be construed to make the marks thus saved a preferential class of marks to which the two prohibitions of the section do not apply."

The Court also said:

"The act of February 20, 1905 was intended to provide for the registration of marks already owned by traders. The last proviso to Section 5 was intended to refer only to marks owned by the applicants and in their actual and exclusive use for ten years."

If this line of reasoning is correct, then a "mark which consists merely in the name of an individual," which is prohibited equally with coats-of-arms of a State, or a scandalous or immoral mark, is not saved by the ten year clause, and consequently the name *Davids* was not registrable.

There seems to be a sound basis for this reasoning, because, if the Congress had intended to make an exception of the matter specified in the ten year clause, it would have used the words "*ex-*

cepting that nothing herein shall prevent," etc., instead of the words "*and provided further* that nothing herein shall prevent," etc.

It might be argued that such an interpretation would make the ten year clause a nullity, but this is not so. Obviously there are many marks which are not technical trademarks under the common law, and which fall outside of the prohibited classes, and yet which would be within the ten year clause, such, for example, as a catch phrase.

If the Cahn Belt & Company case is good law, then the present bill of complaint must fail.

Defendant's Interpretation.

The petitioner, however, contends that a surname registered under the ten-year clause becomes in effect the same as a non-technical trademark and entitled to exactly the same scope of protection. It seems to us that this cannot be so, because neither the statute nor the registration grants any right of ownership (*ante*, p. 10).

But, however that may be, let us see where such an interpretation would lead us.

The petitioner's brief at the bottom of page 12, states:

> "We do not deny for a moment the right of Cortlandt I. Davids to engage in the manufacture and sale of ink and use his own name in the business."

Again, at the middle of page 8 appears:

> "We do *not* desire to prevent defendants from using the surname 'Davids' in any legitimate and proper way in connection with the sale of their goods, but we *do* desire to prevent the use of that surname *as a trade-*

> *mark.* In other words, we desire to prevent defendants from using the surname 'Davids' (as registered by us) as a 'mark of origin' of their goods, * * *."

The words "trademark" and "mark of origin of their goods" are synonymous, because a trademark necessarily must be a "mark of origin." Therefore, according to petitioner's contention, any use of the name "Davids" in any way as an indication of where the goods come from would be a use as a trademark and should be enjoined.

But this would prevent the use of defendants' name in any way on its labels. They could not even say, for example, "Excelsior Ink, Manufactured by C. I. Davids," because according to complainant, that would be a use of the word "Davids" as a mark of origin, that is, as a trademark. Even the name "Davids Mfg. Co.," or any other use of the name "Davids" whether coupled with other matter or not, would still be a mark of origin. Consequently, with this interpretation defendants could never use their own names in any way to indicate that the ink was made by, or originated in, them. Defendants would be practically driven out of the business. As has been shown heretofore (*ante*, pp. 3-5), defendants are here with "clean hands," and it would be, it seems to us, a monstrous injustice to prevent them from using their own name on the labels. We cannot give to this statute such an interpretation as petitioner contends, for, without convicting Congress of an intention to permit the exclusive appropriation of a surname, with its obvious resultant injustice. It would be an interpretation absolutely opposed to every principle of the common law. As this ten-year clause is dia-

metrically opposed to the common law, obviously it must be strictly interpreted.

On February 18th, 1911 (some three years after the amended bill of complaint was filed) Congress added to Section 5 a proviso reading (italics mine):

> "That nothing *herein* shall prevent the registration of a trademark *otherwise registrable* because of its being the name of the applicant or a portion thereof."

My opponent may advance the argument that this is merely explanatory of Congress' original intention in wording the ten-year clause and that in effect it permits the registration of a surname broadly. This argument is fallacious because of the words italicized. If "herein" means the ten-year clause, then "otherwise registrable" must mean "registrable elsewhere than in the ten-year clause." But a surname is not registrable elsewhere, unless it is in some *distinctive* form, such for example as a signature. This interpretation therefore, would not aid complainant. But the evident intent was to allow the registration of a name provided it had some characteristic making it distinctive, such as a signature (covered in the second "provided" clause of Sec. 5) or *any other* such striking and distinctive form, and also to allow registration of a common law trademark even if it were the "name of the applicant or a portion thereof." An example of the latter would be the word "Eureka," used, we will say, by the "Eureka Company," the applicant for registration. Before this amendment was passed, the Eureka Company could not have registered the word "Eureka" *merely*, because of the second "pro-

vided" clause of Section 5, although it was a common law trademark. This was unjust. Evidently the above quoted proviso clause was not merely explanatory of the ten-year clause, but was intended to allow the registration of a name, only if it is capable of exclusive ownership under the common law.

Section 23 of the Act provides:

> "That nothing in this Act shall prevent, lessen or impeach or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trademark might have had if the provisions of this Act had not been passed."

If we adopt complainant's interpretation and give to complainant the exclusive right to the name "Davids," it apparently would prevent the defendants from enjoining any other person from appropriating defendants' full names, "Cortlandt I. Davids and Walter I. Davids," because, if they had no right to use the name "Davids" at all, it is difficult to see how they could recover, even against a pirate, in a court of equity. Their alleged right would be obtained from their *use* of their name, but that use would be illegal. They and the pirate would be in equal wrong. But Section 21 distinctly provides that they are not deprived of such right of action. Consequently we cannot interpret the Statute as complainant contends.

Another reason why this ten-year clause should be strictly construed is that it does not apply to any mark unless used exclusively for the ten years between February 20, 1895 and February 20, 1905. A non-common law trademark, *e. g.*,

Davids, would not be registrable, even under the statute as it stands at the present day, if used exclusively from March 1, 1895, clear up to the present time. Congress has chopped out, as it were, one separate ten year period and none other. We cannot here question the propriety of Congress' action in making that particular ten years a preferential term, but the above illustrations impose on us the necessity of construing the language strictly and not extending it one iota beyond the words used.

We cannot invalidate the ten-year clause on the ground of "public policy," because public policy is defined by the statutes and Court decisions, and not by any belief by the Court as to what would be to the best interest of the people. That would be legislation by the Court. But public policy as determined by the statutes and the decisions of the Courts should be a guide as to the intention of the Congress in using the words contained in this law. Now, the public policy, as determined by the federal statutes and decisions of this Court heretofore, so far as surnames are concerned, is that they are not entitled to exclusive appropriation. Consequently, as the statute does not clearly indicate that this policy is to be overturned, we must not give it complainant's radical interpretation. If there is an interpretation of it consistent with the words used, and also not radically opposed to the public policy as to surnames heretofore expressed in the federal laws and the decisions of this Court, that interpretation should control. One such interpretation has been given in pages 7 to 13 *ante*.

We believe that the proper interpretation of the

statute, so far as the ten-year clause is concerned, is that such clause allows the *registration* of a surname (or other elsewhere-prohibited mark) when used for the requisite period and under the conditions specified therein; that it is then entitled to some protection, but not with the same scope as would be accorded to a common law technical trademark; but that the scope of protection afforded to it must be limited, so far as possible, to accord with the public policy set forth in the decisions in this respect by this and other Courts of the United States heretofore.

Take the present case for example, and assume that complainant's mark "Davids" was properly registrable under the 10-year clause. It would be an obvious injustice to defendants under the present circumstances to prevent the use of their own name. But if we concede to complainant the exclusive right to use the word "Davids" *alone* (as it does use it, see labels, pp. 63-67), in other words to limit its exclusive right to the use of the word "Davids" *without any other qualifying matter*, complainant will have all that it can justly ask and it will not interfere with the rights of other persons named Davids to use their own names properly in the same business.

The argument may be advanced that this does not give complainant the scope of protection which would be accorded to a trademark ownable under the common law, but the answer to that is that it is complainant's own fault. It adopted the bare name "Davids" as its trademark, with full knowledge (it must be assumed) of the common law rule that any other Davids has an inherent right to use his name and that surnames are not exclusively appropriatable, and if now its exclusive rights are limited to

its own manner of use it has only itself to blame. These principles are discussed in detail in *Howe Scale Co.* v. *Wyckoff, Seamans & Benedict*, 198 U. S., 135, above cited, and the Court in this respect quotes from *Singer Mfg. Co.* v. *June*, 163 U. S., 169. In the present case defendants certainly have an inherent right to use their own name, and as this Court said in the Howe Scale Co. case (italics mine):

> "Neither of them was paid for the use of his name, and neither of them had parted with the right to that use. Having the right to that use, Courts will not interfere where the only confusion, if any, results from a *similarity of the names*, and not from the manner of the use."

That case was on a surname registered under the prior trademark act.

In the present case also the "similarity of the names" is the only cause of complaint (see quotation from the Record, *ante*, p. 7).

And this does not deprive a person of any common law right of action, for the Statute takes away no such right from him. See Section 23.

Defendant's interpretation would, in the present case, result in a decree of non-infringement, but this is only equitable. Defendants, as explained heretofore (pp. 3-5 *ante*) are descendants of the original Davids. They *have a right* to use their name, even though registered by another, as this Court held in the Howe Scale Company case above cited. They were taken into the complainant company by the request of its former President, and at his request learned the business. They were discharged by the next President, and knowing no other business, commenced the manufacture of

ink. It would be a monstrous injustice to prevent the use of their own name. The bill of complaint and petitioner's brief concede their right to use the name "C. I. Davids." An interpretation of the Statute as above set forth under the present circumstances gives full effect to the words of the Statute, concedes the right to sue upon a registration under the ten-year clause, even though Sections 16 and 19 in words do limit the right to an "owner," and does not radically overturn the public policy as to surnames set forth by the Federal laws and the decisions of this Court heretofore. Such an interpretation is reasonable, and the only one who objects to it is one who has adopted a mark which would not be a trademark by the common law. If one who has adopted a descriptive word or a surname, or any other mark otherwise open to the public to use, or a scandalous or immoral mark, complains because he is not given the scope of protection which would be accorded to an arbitrary trademark capable of exclusive ownership under the common law, the answer is that Congress did not give it, and he ought not to have such scope of protection for he had no reason to expect it.

Judge Noyes' dissenting opinion (pp. 112-113, Record) seems to be founded on the erroneous assumption that the Statute deprives a user of some right he had before. It does not. Anyone who has a common law right, even under the principles of unfair competition, is not deprived of that right. He may still sue in the proper forum.

Defendant's interpretation gives to the Statute a reasonable construction. It does not limit the word "owner" in Sections 16 and 19 to an owner strictly according to the common law (which

would exclude any surname). It gives the registrant of a surname protection, but only limits the scope of the protection accorded such mark to the mark as *actually* used. So far as we can see, this interpretation is consistent with the words of the Statute and, so far as possible, with public policy. If this interpretation is adopted, obviously there is no infringement.

Complainant's False Statements.

The record shows that the complainant has made material false statements in regard to its products for several years past, and is still continuing the same. Defendants' Exhibit "Complainant's Price List" shows labels now and for years past used by the complainant. On page 16 thereof is shown the "Oriental Carmine Ink" label (see also, top p. 69, Transcript). There was nothing oriental about this ink, for it was manufactured right here in New York (Q35-37, p. 86; Q22, p. 94; Q8, p. 98, corroborated by Merckle, XQs48-49, p. 40, who is the President of the complainant company, Q1, p. 13). That the word "Oriental" means or would mean to anyone that the ink was made in the Orient, is evident. This is also corroborated by Mr. Williamson, a witness for complainant (XQ35, p. 45).

"Carmine" in the ink trade does not mean a *color*. It means an extract from the cochineal bug. This is genuine carmine. This "Oriental carmine" ink is not made of carmine by the complainant, although it originally was, but is now made from an aniline color or dye (all admitted by Merckle, Complainant's President, XQ48, 55, p. 40). An aniline dye makes an ink which is inferior to that made from genuine carmine (Q41, p. 96, cor-

roborated by Merckle, XQ53 to 55, p. 40, and Complainant's Witness Williamson, XQ20-23, p. 44). Complainant makes a point to a customer that its ink shown on page 12 of the Exhibit Price List is "*genuine* carmine" (XQ26, p. 44).

The word "carmine" is false. It does not mean a color, because, as shown by the label at the bottom of page 13 of the price list, when complainant means carmine *color*, it says so in so many words; but "carmine" means to the trade an extract of the cochineal bug, which is much superior to an aniline dye. This label, therefore, contains a material false statement.

Substantially the same is true in regard to the "Non-Copying Carmine" ink label shown at the top of page 13 of the price list. This is not made from genuine carmine, but from an aniline dye (Q38 to 40, p. 95). This is corroborated by the witnesses for complainant (Williamson, XQ30, p. 45, and Merckle, the President, XQ59, p. 40). This ink label is therefore false and misleading.

On page 28 of the Exhibit Price List (and top p. 73, Trans.), is shown a label for "Silk-Filtered fountain pen ink." This is precisely the same ink as the "electro-chemical writing fluid" shown on page 3, and is not "silk-filtered" (Q13 to 18, p. 98). It is of a distinct advantage that fountain pen ink should be filtered through silk, in order to remove all possible sediment so that it will flow more freely through the pen (RDQ109, p. 91 and Q37, p. 95). This is corroborated by the complainant's witnesses. Mr. Merckle, the President of the complainant company, states (XQ63 to 67, p. 41) that they did silk-filter the fountain pen ink years ago, but haven't done it for some time, and

that silk-filtered fountain pen ink would produce a better ink if it were so filtered.

This label is therefore false and misleading.

These words "Carmine" and "Silk-Filtered" on the labels are material false statements. They mislead the trade. They are not immaterial as was the case of Jacobs *v.* Beecham, 221 U. S.

The complainant has therefore come into this Court with hands not clean, but, on the contrary, dripping with the filth of false and misleading statements on its labels and advertising matter. Under the decisions it will not be heard to complain of any alleged inequity.

This Court several times has refused relief to a falsifying complainant in trademark cases.

> *Manhattan Medicine Co.* v. *Wood*, 108 U. S., 706, 708 (L. Ed.).

The Court commented on the fact that the complainant's labels were false in their statements, and referred to several cases both in this country and in Great Britain as upholding the doctrine, and said:

> "The doctrine enunciated in all these cases is founded in honesty and good sense; it rebukes fraud and encourages fair dealing with the public. In conformity with it, this case has no standing before a court of equity."

In *Holzapfel* v. *Rahtjen*, 183 U. S., 53 (L. Ed.), the Court said:

> "A symbol or label claimed as a trademark so constituted or worded as to make or contain a distinct assertion which is false will not be recognized, nor can any right to its exclusive use be maintained."

and cited the above Manhattan *v.* Wood case and several others.

In *Worden* v. *California Fig-Syrup Company*, 187 U. S., 282, 288-289 (L. Ed.), the Court discussed a number of cases with the same conclusion and stated (italics mine):

> "Any material misrepresentation in a label or trademark as to the person by whom the article is manufactured, or as to the *place* where manufactured, or as to the *materials* composing it, or *any other* material false representation, deprives a party of the right to relief in equity. The Courts do not, in such cases, take into consideration the attitude of the defendant. And, although the false article is as good as the true one, the privilege of deceiving the public, even for their own benefit, is not a legitimate subject of commerce."

Sec. 21 of the Trademark Law specifies:

> "21. That no action or suit shall be maintained under the provisions of this act in any case when the trademark is used in unlawful business, or upon any article injurious in itself, or which mark has been *used with the design of deceiving the public* in the purchase of merchandise, or has been abandoned, or upon any certificate of registration fraudulently obtained."

The false statements need not appear in the actual trademark. It is enough that they appear on the labels, or even any way in connection with the business.

The complainant should not prevail because of its glaring dishonesty and fraud.

Registration Invalid.

The only way this trademark could have been registered legally was under the so-called "ten year clause," which states:

> "That nothing herein shall prevent the registration of any mark * * * which was in actual and *exclusive* use as a trademark of the applicant or his predecessors from whom he derived title for ten years next preceding the passage of this act" in 1905.

In other words, the use by anyone at any time between February 20, 1895, and February 20, 1905, of a mark legally the same prevents a valid registration.

The proofs show, not only by the testimony but by stipulation (middle p. 102), that the *Davis* Ink Company has been selling ink in bottles bearing labels the same as that on the bottle marked Defendants' Exhibit "Davis Ink Company Label" since before the year 1905. "Davis" is not identical with "Davids," but it is the same in the eye of the law. It is so similar thereto that the ordinary purchasers have confused the two (bottom p. 103). This is corroborated by the testimony of Mr. Merckle for the complainant. He describes how a friend of his thought the Davis Ink was that of the complainant, and in cross examination (XQ30 to 36, pp. 38 and 39) he shows that the public was deceived, and ends with the following:

> "XQ36. Then you think that the word 'Davis' is substantially the same as the trademark 'Davids'? Is that what you mean?
> "A. Yes, I do."

Williamson (the sales manager of the complainant company) in XQ46 to 49 on page 46 emphasizes this. That the trade confused "Davis" and "Davids" is shown by the Complainant's Exhibit Letters (see Postals Nos. 2 and 3 on p. 52, Polatshek Order, p. 55, and the two letters at the top of

p. 57, all of which were intended for the complainant but are addressed by the word "Davis").

In other words, the words "Davis" and "Davids" are legally the same and are confusing to the public, for the public does not distinguish between them. The evident intention of the 10-year clause was to prevent the registration of any mark when there had been in use within those ten years a mark so similar thereto as to deceive the ordinary purchaser. That in the eye of the law "Davids" and "Davis" are the same because they are so similar as to deceive the ordinary purchaser, and that this was the intention of the statute, is clear:

> "Two trademarks are substantially *the same in legal contemplation* if the resemblance is such as to deceive an ordinary purchaser giving such attention to the same as such a purchaser usually gives, and to cause him to purchase the one supposing it to be the other."
>
> *McLean* v. *Fleming*, 96 U. S., 828, 832, L. Ed.

This has been followed with relation to the "10-year clause" itself. In Kentucky Distillers & Warehouse Co. *v.* Old Lexington Club Distilling Co., decided by the Court of Appeals for the District of Columbia (31 App. D. C., 223, and 1908 C. D., 417, 420), the two marks were "Lexington Club" and "Old Lexington Club." The Court said:

> "Where two marks are so nearly identical as to tend to confuse and mislead the public, neither is entitled to registration, even under the ten-year clause of the Act of 1905. We are, therefore, of the opinion that, under the statute, there has been *no such exclusive use*

of the mark in question by appellee as would entitle it to registration."

See, also,

Justin Seubert *v.* Santanella, 36 App. D. C., 520 (166 O. G., 987)

and

Becker *v.* Gambrill, 38 App. D. C., 585.

Also,

In re Wright *v.* Taylor, 33 App. D. C., 510

and

Ex parte L. & A. Scharff, 128 Official Gazette, 2531 (1907 C. D., 172).

In this latter case the two trademarks were "Spring Hill" and "Spring Valley." It was attempted to register the former under the ten-year clause, but the Commissioner held that they were so similar that they would deceive an ordinary purchaser, and that, therefore, they were legally the same, and as the latter name was in use there was no "exclusive use" of the former in the sense meant by the ten-year clause.

That which would infringe if later, anticipates if earlier.

The same is true in the present case. In the eye of the law, "Davis" and "Davids" are the same. They have actually deceived ordinary purchasers, and the President of the complainant company considers that they are practically identical. They are, therefore, in the eye of the law, the same mark, and as the Davis Company has,

according to the record, been using their label during the ten years specified in the ten-year clause, there was no "exclusive use" by the complainant of the registered trademark during said ten years. Consequently the registration was invalid or there is no infringement here.

There is an additional reason why the registration is invalid. This Court in the Howe Scale Company case, above cited, said (italics mine):

> "But it is well settled that a personal name cannot be exclusively appropriated by anyone as against others having a right to use it; and as the name 'Remington' is an ordinary family surname, it was manifestly *incapable of exclusive appropriation* as a valid trademark, and its registration as such could not in itself give it validity."

This being so, the name "Davids" was equally "incapable of exclusive appropriation," and as the ten-year clause states that the mark must have been in "exclusive use," it would seem to follow, the same as in that case, that "its registration as such could not in itself give it validity."

For either of the above reasons we believe that the registration was invalid, and consequently that this bill of complaint must fail.

No Unfair Competition Even if Court Could Take Jurisdiction of the Same.

Although it is believed that this Court has no jurisdiction of any unfair competition matters, the proof shows that there was no unfair competition. The only alleged unfair competition is in the arrangement on the labels. As Mr. Merekle, the President of the complainant company, states (XQ60, p. 26):

> "It is the name Davids which is the sole cause of the confusion * * * between the labels of the defendants and the complainant's manner of marking its goods."

The use of the name "C. I. Davids" has been stated in the bill of complaint to be unobjectionable, and Mr. Merckle states (XQ66, p. 27), that there is no imitation of the name of Thaddeus Davids Company, except for the word "Davids." This full name of the company is not the trademark.

As stated by Judge Lacombe in deciding this case when he denied the preliminary injunction:

> "In view of the decision in the Remington Typwriter Co. case (Howe Scale *v.* Wyckoff, Seamans & Benedict, 198 U. S., 119), I do not see how the Court can enjoin the defendants from the use of their own names when they do not otherwise label their goods to produce confusion."

This decision is not in the printed record, but I think it will not be denied, and my opponent has gone far outside the transcript in his introduction of the Congressional record on pages 35 to 43 of his brief.

The labels alleged to infringe in that motion were the same as the labels now alleged to infringe.

In this connection attention is called to the great mass of hearsay and otherwise secondary evidence introduced by the complainant in spite of objection (*e. g.*, bottom p. 8, middle p. 21, and twice on p. 22). The witness Buckham, for example, testifies at great length as to matters which he knows nothing about, except what he says some persons told him. In spite of the ob-

jections by counsel for defendants this course was persisted in. Obviously such testimony should be disregarded.

No Use by Defendants as Required by the Statute.

One of the prerequisites of infringement, according to Section 16, is that the alleged infringer

> "shall use or shall have used such reproduction, counterfeit, copy or colorable imitation in commerce among the several States or with a foreign nation or with Indian tribes."

This is a prerequisite because the trademark statute was passed under the interstate or foreign commerce clause of the Constitution, which, in Section 8 of Article 1, gives Congress power "to regulate commerce with foreign nations and among the several States and with Indian tribes." Obviously Congress has power to legislate only in regard to such matters as are delegated to it by the Constitution. Therefore, the rights under this statute can extend only to such commerce. Anything else would be *ultra vires*. The statute itself distinctly limits its operation to trademarks used by the defendant in such commerce.

> *Hutchinson, Pierce & Co.* v. *Lowry*, 217 U. S., 838 (L. Ed.).
>
> *Warner* v. *Searle*, 191 U. S., 145, 147 (L. Ed.).

Consequently there can be no infringement until defendants have used the alleged infringing mark in such commerce. There is no such proof in the record.

The proof of defendant's use is in the admission on page 11, following the answer to Q24 (see, also Q22). This does not admit use as required by the statute. No other use is proved.

Therefore, complainant's case must fail for this reason alone.

Certificate of Registration Not Produced.

Section 11 of the Trademark Law comprises the following:

> "That certificates of registration of trademarks shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Commissioner of Patents, and a record thereof, together with printed copies of the drawing and statement of the applicant, shall be kept in books for that purpose."

The original certificate of registration, if there was any, has not been produced. The only thing produced was a printed Patent Office copy as reproduced on pages 76 and 77 of the record. This was introduced in the last paragraph at the bottom of page 7. In the first paragraph at the top of page 8 defendant objected to the exhibit as secondary evidence and called for the original certificate of registration. The original was not produced nor was its absence explained in any way. Obviously the exhibit is secondary evidence and inadmissible. It does not appear that any certificate was "issued in the name of the United States of America," nor "under the seal of the Patent Office," nor that it was "signed by the Commissioner of Patents" or by any other officer. In other words, there is no proof that any cer-

tificate ever properly issued. Paragraph 3 of the bill of complaint alleges the issue of a certificate. Paragraph 5 (p. 79) denies that the same was "issued in due form of law or that said registration was legally granted." The exhibit is not even a certified copy. Even if it had been certified, it would be secondary evidence under the same principle as that a certified copy of an assignment of a patent is not sufficient proof of the execution thereof without adequate explanation of why the original was not produced (*Payne* v. *Trask*, 56 F. R., 233; *Mayor* v. *American*, 60 F. R., 1016; *American* v. *Leeds*, 140 F. R., 981).

As stated in Marsh *v.* Nichols, 128 U. S., 538, 541, letters patent for inventions must be signed by the proper officers and sealed, and the omission of any such prerequisite is fatal.

The same principle applies here.

We do not wish to be technical, but we suspect that there is something vitally defective in the original certificate.

Resume.

Defendants in the present case have a right to use their name as they have done. They were forced into this business by complainant's action and are here with clean hands.

The bill of complaint and petitioner's brief concede defendants' right to use the name "*C. I. Davids*" on their goods. The acts complained of are mere acts of alleged similarity of labels, of which this Court has no jurisdiction. The Court of Appeals in the majority opinion was right in holding that there was no infringement.

Complainant's bill here must fail in any case—

first, because of complainant's material false statements on its labels (*ante* pp. 24 to 27), second, because there has been no use by defendant in commerce as required by the statute (*ante* p. 33), third, because the original certificate of registration was not produced (*ante* p. 34), and fourth, because the registration is invalid (*ante* pp. 27 to 31).

Nevertheless, we earnestly ask this Honorable Court to interpret this ten-year clause and inform the public what its proper meaning is and what the scope of protection, if any, is accorded by the statute to a non-common-law mark registered under it.

It is believed that the decree of the Circuit Court of Appeals for the Second Circuit should be affirmed.

Respectfully submitted,

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